140-184

TRANSCRIPT OF RECORD.

SUPREME COURT OF THE UNITED STATES.

OCTOBER TERM, 1887.

No. ~~1307.~~ ~~963~~ 635 329

THE ST. PAUL PLOW WORKS, PLAINTIFF IN ERROR,

vs.

WILLIAM STARLING.

IN ERROR TO THE CIRCUIT COURT OF THE UNITED STATES FOR THE DISTRICT OF MINNESOTA.

FILED FEBRUARY 20, 1888.

SUPREME COURT OF THE UNITED STATES.

OCTOBER TERM, 1887.

No. 1367.

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JUDD & DETWEILER, PRINTERS, WASHINGTON, FEBRUARY 28, 1888.

1 United States Circuit Court, District of Minnesota.

Pleas before the honorable the judges of the circuit court of the United States of America for the district of Minnesota, for the December term of said court, held in the city of St. Paul, in said district, in the year of our Lord one thousand eight hundred and eighty-six and of our Independence the 111th year.

WILLIAM STARLING, Plaintiff,

vs.

ST. PAUL PLOW WORKS, Defendant.

Be it remembered that on this 19th day of November, 1885, came the plaintiff above named, by Frackelton and Careins, his solicitors, and filed in the clerk's office of said court his bill of complaint in the words and figures — follows, viz:

Bill of Complaint.

2 Circuit Court of the United States for the District of Minnesota.

WILLIAM STARLING, Plaintiff,

vs.

ST. PAUL PLOW WORKS, Defendant.

The complaint of the plaintiff above named in this action shows to this court and states—

1st. That said plaintiff is a citizen and resident of the United States and of the State of Nebraska, residing at Belvidere therein; that said defendant is a corporation duly organized, existing, and doing business under and by the laws of the State of Minnesota, at St. Paul, in said State.

2nd. That said plaintiff, being a citizen of the United States and being the original and first inventor of a new and useful improvement in sulky plows, fully described in the letters patent issued to him therefor, as hereinafter stated, and which was not known or used in this country and not patented or described in any printed publication in this or in any foreign country before his invention thereof, and was not in public use or on sale more than two years prior to his application for letters patent of the United States therefor; and, being a citizen of the United States and having made due application, did obtain letters patent therefor, issued in due form of law to him in the name of the United States of America and under the seal of the Patent Office of the United States, signed by the acting Secretary of the Interior and countersigned by the

3 Commissioner of Patents, bearing date the 18th day of August, 1874, and numbered 154,293, whereby was granted and secured, according to law, to plaintiff, his heirs or assigns, for the term of seventeen years from said date, the exclusive right to make,

use, and vend the said invention throughout the United States and the territories thereof.

3rd. That thereafter defendant, being desirous of obtaining a license to manufacture and sell the said sulky plow, opened negotiations with plaintiff in that behalf, and that, on the 17th day of December, 1877, on good and sufficient consideration, plaintiff and defendant executed, delivered, and entered into a contract in writing, a copy of which is hereto attached, marked Exhibit "A," and made a part of this complaint.

4th. That by said contract plaintiff granted to the defendant the right to make and sell the said sulky plow for and during the then unexpired portion of said term of seventeen years in and throughout the territory therein named; that defendant therein and thereby agreed to manufacture the said sulky plow for and during the whole of said unexpired term in said territory.

That defendant further agreed to so make said plows in a good and workman-like manner, and to advertise and sell the same in said territory for and during the whole of said unexpired term, and in the usual manner so both to advertise and sell the same, and to render an account to plaintiff on the first day of January and July of eath year during said unexpired term of all said plows sold
4 prior to said dates on which royalty, as hereinafter stated, had not been paid.

And to pay to plaintiff a royalty of two and fifty one-hundredths dollars for each and every one of said plows sold by defendant, said royalty to be paid on the first day of January and July of each year upon all said plows sold by defendant prior thereto on which said royalty had not been paid; and said defendant agreed in and by said contract to do other matters and things as in said contract contained.

5th. That defendant has failed to do and perform the things so agreed by it to be performed, to wit, that defendant has recently desisted entirely from making and selling said plows; that defendant has at all times failed to make said plows in a good and workmanlike manner; that defendant has failed to advertise the same in the usual manner or in any manner whatsoever; that defendant has failed to sell said plows in the usual manner; that defendant has failed to render an account to plaintiff of all the plows made by defendant, as agreed in said contract; that defendant has never rendered but two accounts to plaintiff of plows made by defendant under said contract, the first thereof being in the month of July, 1878, and the last thereof in the month of January, 1879, and has never paid plaintiff any royalty as agreed in said contract, except on the plows so reported in said accounts to plaintiff.

Yet defendant has made and sold great numbers of said
5 sulky plows since the date of said contract, for which defendant has never accounted to plaintiff nor paid to plaintiff the royalty therefor as required by said contract, nor any sum whatever, and [illegible] a portion of the sulky plows made by defendant under said contract being so made and sold under the name of "Starling [illegible]," by which name plaintiff's said plow so patented was

known prior to and at the date of said contract, and the greater portion whereof were so made and sold under the name of "Star sulky plow," with slight and immaterial modifications of construction from that of the said Starling sulky plow, but which embodied and were in truth and fact plaintiff's said plow, the making and selling whereof were so licensed to defendant as aforesaid, defendant falsely alleging the same not to be plaintiff's said plow for the purpose of cheating and defrauding plaintiff of his said royalty; and other acts and things defendant has done and suffered contrary to the said contract.

6th. That by the acts and omissions of defendant and things aforesaid plaintiff has been damaged in the sum of ten thousand dollars.

Wherefore plaintiff demands judgment against said defendant for the sum of ten thousand dollars ($10,000) damages and for plaintiff's costs and disbursements in this behalf sustained, and for such other and further relief as plaintiff may be entitled to.

FRACKELTON & CAREINS,
Attorneys for Plaintiff, Minneapolis, Minn.

6 EXHIBIT "A."

This indenture, made on this 17th day of December, A. D. 1877, between Wm. Starling, of the town of Princeton, Bureau Co., Illinois, of the first part, and the St. Paul Plow Works, of St. Paul, Minnesota, of the second part, witnesseth:

That the party of the first part does hereby grant to the party of the second part the right to make and sell the Starling sulky plow under patent number 154,293, dated August 18th, 1874, in the following territory, viz: Wisconsin, Minnesota, Dakota, and all that part of Iowa north of the Northwestern railway and all that territory west and north of above-described territory. In consideration of the above grant the party of the second part agrees to make said sulky plows in a good and workman-like manner and advertise and sell them in the usual manner and at a price not to exceed the usual price of this class of implements sold by other manufacturers, and render an account on the first day of January and July of each year of all plows sold prior to those dates on which the royalty has not been paid, and pay to the party of the first part, his heirs or assigns, two and fifty one-hundredths dollars for each and every plow sold, said royalty for spring sales to be paid July 1st, and for fall sales Jan. 1st of each year.

The party of the first part also granted to the party of the second part the right to make and sell the improvement in whiffletrees under patent 151,804, in consideration of which the party of the second part agrees to pay the party of the first part, at the time of
7 the payment of the royalty for the sulky plows and in the same manner, the sum of one cent for every pound of said iron used or sold.

In witness whereof the said parties have hereto affixed their signatures the day and year above written.

ST. PAUL PLOW WORKS,
P'r H. E. MANN, *Sec'y & Treas.*
WILLIAM STARLING.

Witness:
JAS. J. PAYNE.

STATE OF MINNESOTA, *County of Hennepin,* } ss:

Charles S. Careins came before me personally, and, being duly sworn, doth say he is one of the said plaintiff's attorneys in the above-entitled action; that the foregoing pleading is true, to the best of his knowledge, information, and belief, and that the reason why this affidavit of verification is not made by said plaintiff, Wm. Starling, is that said plaintiff Starling is absent from the county of Hennepin, State of Minnesota, wherein resides affiant, one of said plaintiff's attorneys.

And further saith not.

CHARLES S. CAREINS.

Subscribed and sworn to before me on this 19th day of November, A. D. 1885.

[SEAL OF N. P.] JOHN F. BYERS,
Notary Public, Hennepin Co., Minn.

Endorsed: Filed Nov. 19, 1885. Oscar B. Hillis, clerk.

8 And on the same day, to wit, Nov. 19th, 1885, a summons was issued out of this court; which said summons and marshal's return of service attached thereto are in the words and figures following, viz:

Summons & Marshal's Return of Service.

UNITED STATES OF AMERICA, *State of Minnesota,* } ss:

In the Circuit Court of the United States for the District of Minnesota.

WILLIAM STARLING, Plaintiff,

vs.

ST. PAUL PLOW WORKS, Defendant.

Summons.

The President of the United States of America to the defendant above named, Greeting:

You are hereby summoned and required to answer the complaint in this action, which has been filed in the office of the clerk of this

court, in Saint Paul, county of Ramsey and State of Minnesota, and file your answer in said clerk's office within twenty days after the service hereof, excluding the day of such service; and if you fail to answer the complaint as aforesaid the plaintiff will have the amount he is entitled to recover ascertained by the court or under its direction and take judgment against you for the amount so ascertained to be due, besides the costs and disbursements of this action.

For the marshal of the district of Minnesota to execute.

Witness the Honorable Morrison R. Waite, Chief Justice of
9 the Supreme Court of the United States of America, the 19th day of November, 1885.

Issued at my office, in the city of St. Paul, under the seal of said circuit court, the day and year last aforesaid.

[SEAL U. S. C. C.] OSCAR B. HILLIS, *Clerk.*

FRACKELTON & CAREINS,
Plaintiff's Attorneys.

Endorsed: Filed Nov. 20th, 1885. Oscar B. Hillis, clerk, by L. P. Richardson, deputy.

Marshal's Return of Service.

UNITED STATES OF AMERICA, *District of Minnesota,* } *ss:*

I hereby certify that I have served the annexed summons on the herein-named defendant, St. Paul Plow Works, personally by handing to and leaving with C. Lunn, president of said St. Paul Plow Works, a true copy thereof at St. Paul, in said district, on the 20th day of November, 1885.

H. R. DENNY, *U. S. Marshal,*
A. B. BRACKETT, *Deputy.*

Marshal's fees, $3.70.

10 And afterwards, to wit, on the 27th day of November, 1886, the following stipulation concerning the filing of an amended answer was filed in this cause, said stipulation being in the words and figures following:

Stipulation.

11 United States Circuit Court, District of Minnesota.

WILLIAM STARLING *vs.* ST. PAUL PLOW WORKS.

It is hereby stipulated by and between the parties to this action that the amended answer of the defendant, dated July 2nd, 1886, may be filed in that case with the clerk of this court, and from henceforth shall stand as the defendant's answer herein, upon which

this case shall proceed as though said amended answer had been filed as the original answer herein.

FRACKELTON & CAREINS.
Plaintiff's Attorneys.
JOHN B. AND W. H. SANBORN,
Defendant's Attorneys.

Endorsed: Filed November 27, 1886. Oscar B. Hillis, clerk.

12 And on the same day, to wit, the 27th day of November, 1886, an amended answer was filed in this cause; which said answer is in the words and figures following:

Amended Answer.

13 Circuit Court United States, Eighth Circuit, District of Minnesota.

WILLIAM STARLING, Plaintiff,
vs.
ST. PAUL PLOW WORKS, Defendant.

And now comes the defendant, and for an amended answer to the complaint in the above-entitled action—

1st. It admits that said defendant is a corporation duly organized, existing, and doing business under and by virtue of the laws of the State of Minnesota, at St. Paul, in said State.

2nd. The defendant denies that the said plaintiff was the original or first inventor of any new or useful improvement in sulky plows as fully or otherwise described in the letters patent issued to him therefor or otherwise, and avers that such alleged improvement was known in this country and patented and described in printed publications in this and foreign countries before his pretended invention thereof, and avers that said alleged improvement was well known and had long since been in use in this country before the plaintiff's said pretended invention thereof, and had been in public use and on sale more than two years prior to the plaintiff's application for letters patent to the United States therefor, and that said pretended letters patent are void in law, and give neither the plaintiff nor his assigns any monopoly in the manufacture of said sulky plows, and denies that the said letters patent secured to the plaintiff, his heirs or assigns, for the term of seventeen years or any other time
14 the exclusive right or any right which they did not before have to make or use or vend the said invention throughout the United States or its territories or elsewhere, and it avers that said pretended improvement was utterly useless and without value.

And it avers that the alleged improvement of the plaintiff in his pretended letters patent referred to had, prior to the date of his pretended letters patent, been described in and patented to the various patentees below named by letters patent of the United States numbered and dated as below stated, to wit:

Letters patent number 116,956, dated July 11, 1871, to W. Hay and T. B. Freeman.

Letters patent number 120,560, dated October 31, 1871, to Warrel & Ryerson.

Letters patent number 123,505, dated February 6, 1872, to C. N. Owen.

Letters patent number 132,772, dated November 5, 1872, to C. N. Owen.

Letters patent number 134,121, dated December 17, 1872, to J. Warrell.

Letters patent number 143,147, dated September 23, 1872, to J. D. Harrison.

And in various other letters patent, which this defendant cannot now name, but which it asks leave to present and prove when discovered.

3rd. The defendant admits that the agreement marked Exhibit "A" and made part of the plaintiff's complaint was made and executed and entered into between the plaintiff and defendant
15 on or about the 17th day of December, 1877, and avers that the plaintiff, to induce the defendant to make and enter into the same, represented and stated to the defendant that the alleged improvement described in said letters patent was novel and was his invention, and that it was of great utility and was popular with and salable to the agriculturalists of the Northwest, and that the same could be made and sold in the usual course of business in great numbers and at a great profit in the territory mentioned in said agreement, and that said letters patent gave the plaintiff a monopoly in the manufacture and sale thereof, all of which statements were false and fraudulent and the plaintiff well knew them so to be; but this defendant was ignorant regarding the matters so stated and believed them to be true, and was thereby induced to and did make said contract in reliance upon said statements and representations, which it would never have done had it not been for the same, and it avers that said contract was in all things fraudulent and void.

4th. It denies that by said contract plaintiff granted to defendant the right to make and sell said sulky plow for and during the unexpired portion of said term of 17 years in the territory named or for any definite time. It denies that it hereby or therein agreed to manufacture the said sulky plow for or during the whole of said unexpired term in said territory or during any definite time or term or any other time or term that such time or term as this defendant should find it practicable, possible, and profitable to so manufacture and sell the same or for any time or term whatever.

16 It denies that by said contract or otherwise it ever agreed to make said plows in a good and workman-like manner, or to advertise or sell any of the same in the usual manner or otherwise, or to render an account on the first day of January or July of each year, or to pay royalty on plows so manufactured, or to do anything for the unexpired portion of said term or for any other time or term than that above stated, and denies that said contract contained any other terms or contracts than those above admitted, and avers that the only contract effected between the parties was that the defendant should manufacture and sell some sulky plows according to the plan

of said plaintiff's patent in a good and workman-like manner, and advertise and sell the same in the usual manner and at usual prices, and render an account on the 1st day of J anuary and July of each year of all plows sold previous to those dates on which the royalty had not been paid, and to pay the plaintiff two and fifty one-hundredths dollars for every such plow sold by defendant, and that the plaintiff granted the defendant the right, which was not an exclusive right, in any part of said territory to manufacture and sell the plows described in said patent.

It denies that said contract contained any other or different provisions or any provisions binding the defendant to manufacture or sell said plow for any definite time or in any manner, number, or amount whatever.

5th. And this defendant avers that it has fully kept and performed all the provisions and terms of said contract by it to be kept and performed; that it has made said plows in a good and workman-like manner; that it has advertised the same in the usual manner;
17 that it has sold all said plows that could be sold in the usual manner and at the prices stipulated in said Exhibit "A;" that it has rendered account of every such plow made and sold by it, and has fully paid the plaintiff the royalty provided for in said agreement on every plow made and sold by it under said agreement or under said plaintiff's patent.

And the defendant denies that it has made or sold a great number or any number of said sulky plows since the date of said contract for which it has not accounted to the plaintiff and for which it has not paid to plaintiff the royalty therefor, as required by said contract, under the name of Starling sulky plow or any name whatever.

The defendant admits that it has made and sold a sulky plow, under the name of the Star sulky plow, manufactured in accordance with the method described in patent 225,207, dated on the 9th day of March, 1880, issued by the Commissioner of Patents to one Louis Berthiaume in due form of law, and avers that the said Star sulky plow is constructed upon an entirely different principle from that described and covered by the pretended invention of and patent to the plaintiff, and which the defendant manufactured under a license from the said Berthiaume, patentee, or as his assignee, for the sole purpose of meeting the demands of the trade and avoiding the loss that it must necessarily incur by continuing to manufacture under the plaintiff's license, for the reason that no plows so manufactured or constructed could be sold after the year 1878, and it de-
nies that it ever manufactured or sold said Star sulky plows
18 or did any other act or thing for the purpose of cheating or defrauding the plaintiff.

Further answering, this defendant avers that it made extraordinary efforts to introduce and sell in the territory named in said contract the said sulky plow referred to in plaintiff's patent and in said contract, and did sell a few thereof, for which it accounted and paid the plaintiff royalty, but that most of the plows so sold were returned by the purchasers as worthless, and as soon as they had been thoroughly tried by the farmers and dealers they became ut-

terly unsalable and this defendant could not sell or dispose of them at all.

That, in fact, said plows, when constructed according to said patent, were utterly useless, worthless, and unsalable, and they could not be used, sold, or disposed of in said territory at all after their character became known, and this defendant avers that it did not desist from the manufacture and sale of said plows until it had made every effort to sell the same and the above facts had been conclusively demonstrated by actual trial.

6th. The defendant denies that by reason of any of its acts or omissions or things alleged in said complaint of the plaintiff *that* said plaintiff has been damaged in the sum of $10,000.00 or any sum or amount whatever.

7th. For a further answer to the plaintiff's said complaint the defendant avers that heretofore, on or about the 5th day of December, 1878, the defendant corporation gave to the plaintiff due written notice that the construction of said sulky plow under plaintiff's pretended patent was unsatisfactory and useless, and that a large proportion of those manufactured and sold had been returned
19 to the defendant as unserviceable, and that after the best efforts of the defendant to manufacture, sell, and introduce said plows it was impossible to dispose of the same at any price, and that said defendant was unable to use the castings for said plows which it had on hand prepared for their manufacture, and offered said plaintiff a large commission to dispose of the same, and at the same time gave the plaintiff due and proper notice that said defendant corporation would thereafter manufacture a sulky plow of its own design and renounce its license and all claim of right to construct plows in accordance with the pretended invention and patent of said plaintiff, and would construct and sell no more, and since that date has not manufactured, constructed, or sold any plows under said license or in accordance with the design and alleged invention of the plaintiff. Wherefore the defendant prays that the plaintiff take nothing by this action and for its costs and disbursements herein.

Dated July 2nd, 1886.

JOHN B. & W. H. SANBORN,
Defendant's Attorneys.

Endorsed: "Filed Nov. 27th, 1886. Oscar B. Hillis, clerk."

20 *Reply.*

Circuit Court of the United States for the District of Minnesota.

WILLIAM STARLING, Plaintiff,
vs.
ST. PAUL PLOW WORKS, Defendant.

The reply of the plaintiff above named to the answer of the defendant above named in this action shows to the court and states—

That plaintiff denies each and every allegation and every part thereof in the said answer contained, except as herein expressly admitted, stated, or qualified and except as alleged in said complaint.

That plaintiff admits that, in course of the correspondence between plaintiff and defendant relative to the said contract, at about the month of December, 1878, plaintiff received letters of defendant wherein defendant stated that it had decided not to continue manufacturing plaintiff's said plow, but denies that the reasons therefor in the said letters as well as those mentioned in the said answer are true, and denies that the same was due and proper notice and of any force and effect whatever, and alleges that any difficulty of defendant to sell and to introduce the plaintiff's said plow arose wholly from defendant's failure to perform the conditions of the said contract as in said complaint mentioned.

Wherefore plaintiff, reaffirming his said complaint, asks judgment as in said complaint prayed for.

FRACKELTON & CAREINS,
21 *Attorneys for Plaintiff, Minneapolis, Minn.*

STATE OF MINNESOTA, }
County of Hennepin, } *ss:*

Charles S. Careins came before me personally, and, being duly sworn, doth say he is one of the plaintiff's — in the above-entitled action; that the foregoing pleading is true, to the best of his knowledge, information, and belief, and that the reason why this affidavit of verification is not made by said plaintiff is that said plaintiff is absent from the county of Hennepin and State of Minnesota, wherein resides affiant, one of said plaintiff's attorneys.

And further saith not.

CHARLES S. CAREINS.

Subscribed and sworn to before me on this 27th day of January, A. D. 1886.

[NOTARIAL SEAL.] WAYLAND B. AUGER,
Notary Public, County of Hennepin, State of Minnesota.

Endorsed: "Filed Jan. 8, 1886. Oscar B. Hillis, clerk."

22 And afterwards, to wit, on the 19th day of January, A. D. 1887, the following waiver of jury trial was filed in this cause, viz:

Waiver of Jury Trial.

23 United States Circuit Court, District of Minnesota.

WILLIAM STARLING, Plaintiff,
vs.
ST. PAUL PLOW WORKS, Defendant.

In the above-entitled cause trial by jury is hereby waived and the same may be tried by the court.

Dated January 17th, 1887.

FRACKELTON & CAREINS,
Attorneys for Plaintiff.
JOHN B. & W. H. SANBORN,
Attorneys for Defendant.

Endorsed: Filed Jan. 19, 1887. Oscar B. Hillis, clerk.

24 And afterwards, to wit, on the 19th day of Jan., 1887, the following proceedings were had and entered of record in Term Minutes G, page 435:

Term Minutes.

December Term, A. D. 1886, January 19th, 1887.

WILLIAM STARLING *vs.* ST. PAUL PLOW WORKS.

This day come the parties herein, the plaintiff by his attorneys, Frackelton & Careins, and the defendant by its attorney, W. H. Sanborn, Esq.; thereupon said parties, by their said attorneys, file a stipulation waiving jury trial; thereupon the same is tried by the court as follows, to wit:

Mr. Careins opens the case for the plaintiff.

Documentary testimony offered in evidence on behalf of plaintiff.

Henry Berthiaume, Louis Berthiaume, Frank Varner, John H. Harris, and Osmon Lunn respectfully sworn and examined for plaintiff.

And the trial of said cause not being concluded at the hour of adjournment, it is ordered that further proceedings herein be, and they are hereby, postponed until to-morrow morning at 10 o'clock.

25 And afterwards, to wit, on the 20th day of Jan., 1887, the following further proceedings were had and entered of record in the words and figures as follows:

Term Minutes.

December Term, A. D. 1886, January 20th, 1887.

WILLIAM STARLING *vs.* SAINT PAUL PLOW WORKS.

This day again come the parties, by their respective attorneys; thereupon the trial of said cause is proceeded with as follows, to wit:

Osmon Lunn recalled and examined on behalf of plaintiff. Edward H. Mann, A. C. Baker, H. C. De Jonker, William Starling, and P. H. Gunckel respectfully sworn and examined for plaintiff.

And here the plaintiff rests.

Edward H. Mann recalled and examined for defendant.

And the trial of said cause not being concluded at the hour of adjournment, it is ordered that further proceedings herein be, and they are hereby, postponed until to-morrow morning at 10 o'clock.

26 And afterwards, to wit, on the 21st day of January, A. D. 1887, the following further proceedings were had and entered of record in Term Minutes G, page 439, in the words and figures following:

Term Minutes.

December Term, A. D. 1886, January 21st, 1887.

WILLIAM STARLING, Plaintiff,

vs.

ST. PAUL PLOW WORKS, Defendant.

This day again come the parties herein, by their respective attorneys, and the jury sworn to try this cause; thereupon the further trial of said cause is proceeded with as follows, to wit:

Alex. Wall, J. H. Burwell, William B. Dean, L. D. Wilkes, W. M. Bushnell, George F. Brakes, P. S. Carter, and George A. Carter, respectively, sworn and examined for the defendant.

H. R. Bartlett, by agreement of attorneys, is sworn and examined for plaintiff.

James Vandergrift sworn and examined for defendant.

Henry Berthiaume and C. N. Woodward recalled and examined for defendant.

And the trial of said cause not being concluded at the hour of adjournment, it is ordered that further proceedings herein be, and they are hereby, postponed until to-morrow morning at 10 o'clock.

27 And afterwards, to wit, on the 22nd day of January, 1887, the following further proceedings were had and entered of record in said cause in Term Minutes G, page 440, in the words and figures following:

Term Minutes.

December Term, A. D. 1886, January 22nd, 1887.

WILLIAM STARLING, Plaintiff,

vs.

SAINT PAUL PLOW WORKS, Defendant.

This day again come the parties herein, by their respective attorneys; thereupon the further trial of the same is proceeded with as follows to wit:

C. N. Woodward is further examined for defendant.

H. Houpt, Jr., sworn and examined for defendant.

John H. Harris, George A. Carter, Osmon Lunn, respectively, recalled and examined for defendant.

And here the defendant rests.

And the trial of said cause not being concluded at the hour of adjournment, it is ordered that further proceedings herein be, and they are hereby, postponed until Monday morning at 10 o'clock.

28 And afterwards, to wit, on the 24th day of Jan., 1887, the following further proceedings were had and entered of record in Term Minutes G, page 441, in the words and figures following, viz:

Term Minutes.

December Term, A. D. 1886, January 25th, 1887.

WILLIAM STARLING, Plaintiff,

vs.

ST. PAUL PLOW WORKS, Defendant.

This day again come the parties herein, by their respective attorneys; thereupon the further trial of the same is proceeded with as follows:

W. H. Fuller sworn and examined for plaintiff; deposition of Robert R. McCollough read in evidence for plaintiff; Patrick Gunckel recalled and examined for plaintiff; Edward H. Mann, same; F. E. Stocking sworn and examined for plaintiff; William Starling recalled and examined on his own behalf.

And the trial of said cause not being concluded at the hour of adjournment, it is ordered that further proceedings herein be, and they are hereby, postponed until to-morrow morning at 10 o'clock.

29 And afterwards, to wit, on the 25th day of Jan., 1887, the following further proceedings were had and entered of record in Term Minutes G, page 443, in the words and figures following:

Term Minutes.

December Term, A. D. 1886, Jan. 25th, 1887.

WILLIAM STARLING *vs.* ST. PAUL PLOW WORKS.

This day again come the parties herein, by their respective attorneys; thereupon the further trial of said cause is proceeded with as follows, to wit:

William Starling further examined on his own behalf; Jacob Christman sworn and examined for plaintiff.

And here the plaintiff rests.

Thereupon W. H. Sanborn sums up for defendant; C. S. Careins sums up for plaintiff.

And said cause is duly submitted and by the court taken under advisement.

30 And afterwards, to wit, on the 8th day of February, A. D. 1887, an opinion was filed in this cause; which said opinion and order pursuant thereto are in the words and figures following, viz:

31 *Opinion.*

United States Circuit Court, District of Minnesota, February, 1887.

WILLIAM STARLING, Plaintiff,

vs.

THE ST. PAUL PLOW WORKS, Defendant.

Frackelton & Careins, attorneys for plaintiff; J. B. & W. H. Sanborn, attorneys for defendant.

NELSON, *J.:*

This is a suit for a breach of contract. The plaintiff is a citizen of Nebraska, and the defendant of the State of Minnesota. The defendant is a naked licensee of a patent, No. 154,293, dated August 18, 1874, under a contract executed December 17, 1877, by which it is permitted to manufacture and sell the Starling sulky plow in the following territory, viz., "Wisconsin, Minnesota, and Dakota, and all that part of Iowa north of the Northwestern railway, and all that territory west and north of the above-described territory." A royalty of $2.50 per plow was exacted to be paid on accounts rendered July 1st and January 1st of each year. After the defendant had manufactured and sold between thirty-five and forty plows under the license, and on or about December 5th, 1878, written notice was given the plaintiff that the construction of the sulky plow was unsatisfactory and useless, and many had been returned as unserviceable, and that the defendant would thereafter manufacture a sulky plow of its own design, and renounced its license. The defendant, after the notice, rendered an account up to Jan. 1st, and since
32 then has manufactured about 960 plows called Star plow, designed by Berthiaume, and about 350 plows called the Harris plow. The plaintiff insists upon a breach of the contract of license. Issues are joined under the pleadings and, a jury being waived, the case is tried by the court.

Starling Invention, Authorized to be Manufactured and Sold by the Defendant.

In this, the plaintiff's, invention there is a crooked axle and a crank bar, bent twice at right angles, passing through a box bolted to the plow beam, toward the rear. The end of this bar nearest to the driver's seat or right wheel of the sulky rides upon the inner end of the journal of this wheel. The lower end of a spring lever, which projects upward along a curved bar on the right side of the driver's seat, is connected rigidly with this end of the crank bar. The

curved bar, with notches on the outer side to receive this upright lever, is attached to the axle and part of a brace running from the axle to the tongue, and thus the crank bar, bolted to the plow beam, can be held in any position to which the lever is adjusted. The plow is thus locked either in the ground at any desired depth or up at any desired height, and, in practical operation, when raising the plow up the point comes out of the ground first. To the front of the plow beam is attached a jointed or hinged foot lever, composed of a vertical bar, the upper end of which is jointed to a lever, upon which the foot of the driver may be placed, and the lower end is pivoted to the brace above mentioned, running from the axle to the
33 tongue, and also to the plow beam. A stop is fixed at the rear part of the tongue, so that when the foot-lever is raised the rear end strikes against it. The driver can also lock the forward end of the plow beam down by this lever. The manner in which the crank bar rides on the inner end of the journal and the lever is attached is distinctly pointed out in his drawing, figures three and four. "The first claim is for the combination of the crank-bar lever, plow beam, and axle for the purposes set forth, so as to enable the horses to pull the plow out of the ground." This is done by the adjustment of the lever in the notches of the curved bar. "The second claim is for a combination of the foot lever and stop with brace, tongue, and beam, as shown and described" in the specifications of the patent.

1st. I find that the defendant could not, without the consent of the plaintiff, terminate the rights conferred by the license, and there being no limitation on its face, the license continued until the expiration of the present letters patent.

2nd. The Starling plow is of utility and an operating machine, although it might work better in some soils than in others.

3rd. I find that the first claim of the plaintiff is manifestly infringed in the Berthiaume and Harris plows, so designated, and the mechanism used is only such mechanical change as increases the power of the lever from a single to a compound action, reversing its movement from a lever moving forward to one pulled towards the driver. In the Berthiaume plow a perforated segment
34 and a spring dog are used, in connection with which the lever operates to raise and lower the plow and beam, which are mechanical changes and equivalents only. In the Harris plow substantially the same device is used, while in the Berthiaume plow the device used for depressing the plow beam in front is unlike Starling's. The change in that particular would not defeat the right of plaintiff to an action for breach of contract.

4th. I have hesitated about going into the question of novelty, but there being in the contract of license no recital or admission that plaintiff had invented the improvement in sulky plows, and the plaintiff having joined issue on the defense of want of novelty set up in the answer and not pleaded an estoppel, I have reluctantly allowed the defendant to introduce evidence on that issue, and find that the plaintiff's improvement is not anticipated by any of the patents introduced in evidence.

1*st. Hay & Freeman's Patent, No.* 116,956, *Dated July* 11*th*, 1871.

In this patent for an improvement in cultivators there are two crank axles, on which the ground wheels run; one is attached to the upper side of the main axle, which supports the frame and its plows, while at the opposite end the other is attached to the under side. There are levers attached to each end of the axle with other devices described, so that an independent vertical adjustment of the wheels in relation to the axle is obtained, and thus the main axle is supported at any required height from the ground and with one end higher than the other, and by a locking device the lever will
35 hold the wheels at any height desired. This device is to regulate the depth of the furrow to be cut. A bar of inverted "U" form loosely secures the plow-frame to the axle with its ends pivoted to the main axle. When this bar is turned upward the frame and plows are raised upward and moved forward until the arms of the bar are carried forward a vertical point so as to support the frame and keep the plows out of the ground. This is done by a lever attached by a link to the frame. There is no mode of locking by the lever the plow in the ground at any required depth or raising the point of the plow by the lever and locking so that the horses can pull it out of the ground. The object of this invention in part was to mount the main wheels so as to be capable of independent vertical adjustment and arrange the main plow frame so that it may be raised or lowered.

2*nd. Worrell & Rynerson's Patent, No.* 120,560, *Dated Oct.* 31, 1871.

This patent plow has an axle raised in the middle, and, similar to the Hay & Freeman, has a transverse bar which is supported in the rear to the plow beam by a hinge, the swinging plate secured rigidly to the bar, the arms of which, extending forward, are pivoted to the vertical points of the axle. One arm extends forward and forms a foot rest. The beam is supported so that pressure on the foot rest elevates the beam and plows. The draft is upon the tongue, to which a curved rack and an elbow lever are pivoted. The short arm of this lever in the rear turns upon a transverse pin
36 which passes through a vertical loop to which the forward end of the plow beam is hung by an eye bolt. The teeth of the rack facing the lever enables the depth of the furrow to be regulated by raising the points of the plow. The plow is kept in place by the rack, which is made to engage with the transverse pin at the proper point of elevation. When the points of the plow are raised by this device it is not possible to lower by a reverse action of the lever. Should an attempt be made resistance would come from the tooth of the rack engaged. The object of the foot lever is to enable the driver to raise the plow entirely out of the furrow and out of contact with the ground, but as soon as his foot is removed the plow falls back. There is no device for locking the plow at any required depth, and the foot lever, which is an extension of the yoke or transverse bar, will not raise the point of the plow.

Owen's Patent No. 1, *No.* 123,505, *Dated February* 6, 1872.

In this sulky attachment for plows is a drop iron passing through the tongue and a "T" piece at the bottom over the forward part of the beam, with a device on the drop iron for regulating the depth at which the plow shall run by a pin passing through holes in the drop iron above the tongue and a sliding sleeve stop secured below in any desired position by a set screw. The driver, having secured the stop to the drop iron at the desired position and fixed the pin in the drop iron above the tongue, is enabled by treading on
37 the "T" piece to strike the front end of the beam and depress it so that it enters the ground to an extent limited by the pin. He then withdraws his feet and the stop strikes under the tongue. The driver does not operate this device while the plow is in motion. No jointed foot lever is used, as in the plaintiff's patent. Owen, by his device, controls the depth of furrow and keeps the plow in place. There is a foot rest upon the arm of the yoke or hanger which extends forward as in the last machine, and by placing his foot upon it the driver can employ his weight in elevating the plow. The axle is composed of two crank arms, and there is also a hand lever pivoted to the right crank arm, and on this pivot is a cog wheel, loosely mounted, gearing with another cog wheel attached to the arm of the yoke or hanger, and a ratchet wheel which is attached to and moves with the cog wheel pivoted to the crank arm. The hand lever has a spring pawl pivoted to it and a device by which the pawl will engage with the ratchet wheel. This device enables the driver seated above to raise the plow out of or off the ground by pulling the lever towards him. There is a latch pivoted to the axle extending rearward, and when the plow is elevated high enough the latch engages with a shoulder in the hanger or yoke and supports it. The driver with the foot rest can aid in raising the plow when he operates the lever. An arm projecting from the lever at a point near where it is pivoted downward in front operates as a stop by striking the axle, so that when the plow is raised to a desired height the driver can hold it by a foot rest and let the hand lever down in front until the stop
38 strikes the axle, and then, by engaging the pawl with the ratchet and releasing the pressure from the foot rest, the weight of the plow keeps the pawl locked. The plow can be held at a certain elevated position, but not locked in the ground; neither will the lever raise the point of the plow out of the ground, and the front device running through the tongue will prevent the tilting of the point of the plow when raising it out of the ground.

Owen's Patent No. 2, *No.* 132,772, *Patented Nov.* 5, 1872.

In this patent the plow, when elevated, may be locked to insure proper depth of furrow, but when a small falling and locking lever, which is pivoted to a pawl as a balance, is thrown back and the plow is lifted so that the pawl is withdrawn from the ratchet it will

drop to the ground. The lever used will lock the plow so as to prevent it from going deeper, but the point of the plow cannot be raised by the lever.

Worrell Patent, No. 134,121, *Dated December* 17, 1872.

There is no locking lever described in this patent as in Starling's, and no device like his for raising the point of the plow or locking the plow in the ground.

Harrison Patent, No. 143,147, *Dated Sept.* 23, 1873.

This invention has a device attached to the hub of the right wheel, by means of which the plow is raised out of the ground by the power of the team, but no hand or foot lever arrangement for raising the plow out of the ground.

39 Neither of these patents have the combination of the plaintiff for the purposes described in his patent, and do not anticipate the invention.

The conclusion is that the plaintiff is entitled to a royalty on 1,310 plows at $2.50 each, making the amount of $3,275.00, for which sum judgment is ordered.

Endorsed: Filed Feb. 8th, 1887. Oscar B. Hillis, clerk.

40 *Order Pursuant to Opinion.*

United States Circuit Court for the District of Minnesota. December Term, A. D. 1886, February 8th, 1887.

WILLIAM STARLING *vs.* ST. PAUL PLOW WORKS.

Term minutes.

The jury having been duly waived by the parties in the above-entitled cause, and said action having been heretofore tried by the court, and, after being fully argued by the attorneys for the respective parties, duly submitted and by the court taken under advisement:

Now, the court, after due consideration thereof and being fully advised in the premises, files its written decision and findings in favor of the plaintiff and against the defendant, viz., "that the plaintiff is entitled to the royalty on 1,310 plows, at $2.50 each, making the amount of $3,275.00."

Thereupon, upon motion of W. H. Sanborn, Esq., defendant's attorney, it is ordered that the entry of judgment upon the above findings be, and the same is hereby, stayed for a period of forty days from date hereof.

41 And afterwards, to wit, on the 14th day of March, A. D. 1887, a petition for a new trial was filed in this cause; which said petition and order of the judge allowing filing of same are in the words and figures following:

Petition for a New Trial.

42 United States Circuit Court, District of Minnesota.

WILLIAM STARLING, Plaintiff,

vs.

THE SAINT PAUL PLOW WORKS, Defendant.

To the circuit court of the United States for the district of Minnesota:

The undersigned, your petitioner, respectfully represents and avers that it should have a new trial of the action above entitled upon the following grounds:

First. On account of accident and surprise, which ordinary prudence could not have guarded against.

Second. On the ground that the decision is not justified by the evidence and is contrary to law.

Third. On the ground *that* newly-discovered evidence, material for the petitioner, which it could not with reasonable diligence have discovered and produced at the trial.

Fourth. On account of error in law occurring at the trial and excepted to by the petitioner.

Your petitioner represents and avers that in the trial of said cause it was the victim of surprise, against which ordinary prudence could not have guarded, in this, that the method of fastening the plow at any desired height in the ground by the use of a locking lever, both when the plow was in operation and otherwise, was a well-known device which had been used upon sulky plows and shown in printed publications and patents for many years before the plaintiff obtained his patent, and the use of such locking lever for
43 such purpose was not and is not claimed by the plaintiff in the claims to his patent and specifications as novel, and your petitioner was advised by his attorney that the same could not be claimed as novel under said patent, and that it was unnecessary to plead or procure the printed publications and patents which showed that device, because the plaintiff did not claim it as novel in his specifications or claims; and that when it was insisted upon at said trial your petitioner was unable in the midst of said trial and could not, though he diligently sought to do so, present the patents and publications which showed the prior use of said locking lever; but your petitioner avers that the same is shown and fully described and set forth in the patent to William Haslup, G. G. Haslup, Sr., and R. B. Haslup, No. 127,878, patented June 11th, 1872, a copy and the specifications of which are herewith presented; and your petitioner avers that he has discovered said patent and descriptions since the trial of said action, and that it could not and did not anticipate its

importance before said trial, but in view of the opinion of the court it is most material for the defendant herein; and your petitioner avers that it was the victim of surprise in this, that it is in no way stated in the plans or specifications of Starling's patent that the horses are made to raise the plow out of the ground by the tilting of the plow point upward, as was claimed upon the trial, nor is it anywhere stated in the specifications or claims in what way the
44 horses are made to raise the plow out of the ground, and it appeared from the drawings in said Starling patent, and your petitioner was advised by his attorney, that it was by the raising of the arched axle where it is attached to the plow beam to a height above its pivotal points so that the draft of the horses would pull it over forward, and your petitioner caused such to be made and found the anticipating patents in evidence which show this construction and effect, and it first learned upon the trial that the tilting of the point upward was claimed to be the method by which the horses assisted in raising the plow, and it was unable after such discovery during said trial to discover further evidence showing the anticipating of this device, but it avers that it has since discovered that the same device, operating in the same way, is shown in said patent 127,878; and it avers that the locking-lever device and the tilting of the plow by the use of the lever in taking it out of the ground were both old, had been used for many years before Starling's invention, and not claimed as novel in his specifications or patents specifically in Starling's specifications or claims, and your petitioner was surprised that they were claimed as novel upon the trial, and that the court rests its decision upon these two points, and it therefore prays that a new trial be ordered and it may be permitted to show the prior use and publications of said device; and your petitioner claims and represents there was error in law at the trial of said cause in each of the various rulings of the court specified and excepted to in the bill of exceptions, which has been settled and allowed herein, which
45 is hereby referred to for greater certainty herein.

And that there was error in the conclusion of the court that the defendant could not without the consent of the plaintiff terminate the rights conferred by the license, and that the license continued until the expiration of the present letters patent.

That there is error in the conclusion of the court that the defendant is liable, on the license for the manufacture of the Harris and the Berthiaume plows, for the royalty mentioned in the license, when the same was entirely different from the Starling plow model and from the plow described in the patent, and when the evidence showed that in the district covered by the license the plow manufactured like the Starling was utterly useless and inoperative, while the Harris and Berthiaume were perfect and operative; and your petitioner insists that the plaintiff could not recover even if the defendant infringed the first claim of plaintiff's patent, upon the license, but only in a suit for infringement.

That there is error in the finding of the court that the plaintiff's first claim is not anticipated by the patents offered in evidence by the defendant, and so your petitioner avers that the decision in this

case and the judgment ordered are not justified by the evidence and are not in accordance with the law.

Your petitioner further avers that the decision and order for judgment in this case were first filed on February 8th, 1887, and an order was made on that day staying proceedings, before said judgment was entered, for twenty days, and another order staying
46 proceedings for forty-two days, but, notwithstanding said orders, the judgment was entered herein on February 8th, but your petitioner first learned that fact on March 11th, 1887; that your petitioner, in the case for new trial herein — is denied, desires to obtain a writ of error from the Supreme Court of the United States to reverse the judgment herein and to file a supersedeas bond upon said writ of error, but the time for your petitioner to do this under the statute will expire long before the first of May, 1887, and in order to protect itself in said writ of error, unless said judgment is vacated and set aside, your petitioner will be obliged to remove this cause to the Supreme Court before a hearing can be had upon this petition.

Your petitioner offers ample security herewith to protect the plaintiff from any loss and to insure the giving of said supersedeas bond in case this petition for a new trial should not be granted.

And your petitioner prays that the judgment entered herein be vacated, annulled, and set aside and stand for naught; that upon the giving of the bond herewith presented and approved all proceedings in this action be stayed until after the hearing and decision upon this petition for a new trial, and that a new trial for this action be granted.

JOHN B. & W. H. SANBORN,
Petitioner's Attorneys.

(Here follows cut and specifications of letters patent No. 127,878 to William Haslup, granted June 11, 1872.)

47 STATE OF MINNESOTA, } *ss:*
County of Ramsey, }

Osmon Lunn came before me personally, and, being duly sworn, doth say that he is the president of the St. Paul Plow Works, the petitioner in the above-entitled action; that the foregoing petition is true of his own knowledge except as to those matters therein stated on his information and belief, and as to those matters that he believes it to be true.

OSMON LUNN.

Subscribed and sworn to before me this 14th day of March, A. D. 1887.

[NOTARIAL SEAL.] HENRY D. LANG,
Notary Public, Minn.

Endorsed: Filed March 14, 1887. Oscar B. Hillis, clerk.

DISTRICT OF MINNESOTA, *ss:*

I, R. R. Nelson, judge of said circuit court, do hereby certify that I hereby allow the within petition for a new trial to be filed.

March 14, 1887.

R. R. NELSON, *Judge.*

48 And afterwards, to wit, on the 12th day of July, 1887, the following further proceedings were had and entered of record in Term Minutes G, page 541, in the words and figures following, viz:

Term Minutes.

United States Circuit Court, District of Minnesota. June Term, A. D. 1887, July 12, 1887.

WILLIAM STARLING *vs.* ST. PAUL PLOW WORKS.

Defendant's motion for a new trial in this case coming on to be heard, the same is fully argued upon behalf of complainant by Frackelton & Careins, and on behalf of defendant by E. P. Sanborn, duly submitted, and by the court taken under advisement.

49 And afterwards, to wit, on the 10th day of October, 1887, the following opinion denying a motion for a new trial was filed in this cause in the words and figures following, viz:

Opinion.

50 United States Circuit Court, District of Minnesota. October, 1887.

WILLIAM STARLING, Plaintiff,

vs.

THE ST. PAUL PLOW WORKS, Defendant.

Frackelton & Careins, for plaintiff; John B. & W. H. Sandborn, for defendant.

NELSON, *J.:*

A motion for a new trial is made by defendant upon the following grounds:

"First. On account of accident and surprise which ordinary prudence could not have guarded against.

Second. On the ground that the decision is not justified by the evidence and is contrary to law.

Third. On the ground of newly-discovered evidence material for the petitioner which it could not with reasonable diligence have discovered and produced at the trial.

Fourth. On account of error in law occurring at the trial and excepted to by the petitioner."

The trial was before the court without a jury and was very thorough. Many questions arose, and if error was committed it was in allowing the defendant to show want of novelty and patentability of the plaintiff's plow. The action was brought upon a contract in which the defendant became a licensee to manufacture and sell the plaintiff's invention, called the "Starling plow," on payment of a royalty for each and every "Starling plow" manufactured and sold. A breach of the contract is alleged and a recovery
51 sought and obtained for the amount of royalties upon plows sold and not accounted for and paid by the defendant. If the defendant manufactured plows called by a different name but substantially the same as the plaintiff's invention, invading his rights under the patent or using devices claimed in the plaintiff's patent, it is a breach of the contract if defendant fails to pay the royalty therein provided, and on a repudiation of the contract by the licensee the licensor and patentee can either sue for royalties unpaid or for infringement. (3rd Banning & Arden, 572, and cases cited.)

The election to sue for a breach of the contract is made in this case and sustained. The court decided the defendant did infringe and gave judgment. I dismiss all of the reasons assigned for a new trial, with one exception, and will briefly consider that one, viz., "newly-discovered evidence material for the petitioner which it could not with reasonable diligence have discovered and produced at the trial."

This evidence is a patent, No. 127,878, issued June 11, 1872, to William G. Haslup, assignor, for "improvement in plows." If the newly-discovered evidence which is submitted would not change the result of the verdict and judgment, it is well settled that a new trial should — be granted. The letters patent are attached to the petition for a new trial. I have examined the specifications and claim, and if it had been offered under the ruling of the court at the trial it could not have changed the result.

The first claim of the plaintiff's patent is "for a crank bar combined with the plow beam, lever, and axle, as and for the
52 purpose set forth, so that the horses are made to raise the plow out of the ground."

The plaintiff's plow has a crooked axle and a crank bar bent twice at right angles, passing through a box bolted to the plow beam toward the rear end. The forward end of this bar near the driver's seat or right wheel of the sulky rides upon the inner end of the journal. The end of a spring lever, which projects upward along a curved bar on the right side of the driver's seat, is connected rigidly with this end of the crank bar. The curved bar, with notches on the outer side to receive this upright lever, is attached to the axle and part of a brace running from the axle to the tongue. The crank bar thus bolted to the plow beam can be held in any position to which the lever is adjusted. By this device and manner of construction and bolting the plow can be locked, either in the ground at any depth or up at any height at the will of the driver, and in the operation of raising the plow the point comes up first. By means of the

lever the point turns up and the horses are made to raise the plow out of the ground.

In the Haslup patent sulky plow there is a sleeve around the axle proper, which is revolved by a lever affixed to it. This sleeve has two arms projecting toward the rear and pivoted to the plow beam underneath.

When the lever is pushed forward the plow is raised and a trigger pivoted to the lever falls into a notch on a circular plate fastened on the right of the axle or its connection with arms running to the tongue.

The plow is thus held up while it is turned or taken from the field. The plow can be locked in the ground or the depth to
53 be plowed determined only by inserting a pin in holes made for that purpose in the circular plate fastened as heretofore stated. The driver cannot regulate the depth to be plowed and lock the plow in the ground while it is in motion. The pin prevents the plow being raised by the lever, and it could not be operated while in motion so as to raise the point of the plow and make the horses pull it out of the ground.

The Haslup plow does not have the combination of the plaintiff for the purposes described in the patent and does not anticipate his invention.

The motion for a new trial is denied.

Endorsed: Filed Oct. 10, 1887. Oscar B. Hillis, clerk.

54 And afterwards, to wit, on the 10th day of October, 1887, the following further proceedings were had and entered of record in said cause in Term Minutes G, page 574; which said proceedings are in the words and figures following, viz:

Term Minutes.

United States Circuit Court, District of Minnesota. June Term, 1887, October 10, 1887.

WILLIAM STARLING *vs.* ST. PAUL PLOW WORKS.

The jury having been duly waived herein and this cause having been tried by the court, and the court, on Feb. 8th, 1887, having filed its written findings herein, wherein it finds for the plaintiff as follows, to wit:

"The plaintiff is entitled to a royalty on 1,310 plows at $2.50 each, making the amount of $3,275, for which sum judgment is ordered."

And the entry of judgment herein, pursuant to said finding, having been staid pending the hearing of defendant's motion for a new trial—

Now, said motion having been heretofore fully argued by the attorneys for the respective parties, duly submitted, and by the court taken under advisement, and the court being fully advised in the premises files its decision on said motion pursuant thereto, it is hereby ordered that a new trial be denied.

Thereupon, upon motion of Frackelton & Careins, plaintiff's attorneys, it is considered, ordered, and adjudged that the above-named plaintiff, William Starling, do have and recover of and from
55 the above-named defendant, The St. Paul Plow Works, a corporation, the aforesaid sum of $3,275 so found to be due by the court, with interest thereon from the date of said findings, to wit, February 8th, 1887, being $154.10, and all amounting to $3,429.10, besides plaintiff's costs and disbursements herein, to be taxed, and that he have execution therefor.

Dated Oct. 10th, 1887.

R. R. NELSON, *Judge.*

56 And afterwards, on the 27th day of October, 1887, the following *præcipe* for a writ of error was filed in this cause in the words and figures following, to wit:

Præcipe for Writ of Error.

57 U. S. Circuit Court, District of Minnesota.

WILLIAM STARLING, Plaintiff,

vs.

ST. PAUL PLOW WORKS, Defendant.

To the clerk of the circuit court of said district.

SIR: The defendant, The St. Paul Plow Works, complains that manifest error has been committed in the trial and entry of judgment against it in the action above entitled for $3,429.10 and costs, and that it has been greatly damaged thereby, and it prays that a writ of error therein to reverse said judgment be issued out of the Supreme Court of the United States directed to said circuit court.

ST. PAUL PLOW WORKS,
By JOHN B. & W. H. SANBORN,
Its Attorneys.

Endorsed: Filed Oct. 27th, 1887. Oscar B. Hillis, clerk.

58 And on the same day, to wit, Oct. 27th, 1887, a bond was filed in this cause in the words and figures following, viz:

Bond.

59 Supreme Court of the United States.

WILLIAM STARLING, Defendant in Error,

vs.

ST. PAUL PLOW WORKS, Plaintiff in Error.

Know all men by these presents that we, St. Paul Plow Works, as principal, and Charles H. Bigelow and Wm. R. Dean, as sureties, are held and firmly bound unto William Starling, in the sum of eight thousand dollars, to be paid to said William Starling, his ex-

ecutors or administrators; to which payment, well and truly to be made, we bind ourselves and each of us, jointly and severally, and each of our heirs, executors, and administrators, firmly by these presents.

Sealed with our seals and dated this 26th day of October, 1887.

Whereas the above-named St. Paul Plow Works has prosecuted a writ of error to the Supreme Court of the United States to reverse the judgment rendered in the case of William Starling, plaintiff, *vs.* The St. Paul Plow Works, defendant, for $3,429.10 damages and $372.18 costs by the circuit court of the United States for the district of Minnesota:

Now, therefore, the condition of this obligation is such that if the above-named St. Paul Plow Works shall prosecute its said writ of error to effect and pay all costs and damages and the amount of said judgment and interest and just damages for the delay if it shall fail to make good its plea, then this obligation shall be void; otherwise to remain in full force and virtue.

60 ST. PAUL PLOW WORKS,
By OSMON LUNN, *Pt.* [SEAL.]
FREDERICK C. MILLER, [SEAL.]
Secretary.
CHARLES H. BIGELOW. [SEAL.]
WM. B. DEAN. [SEAL.]

Signed, sealed, and delivered in presence of—
F. N. DICKSON.
HENRY D. LANG.

STATE OF MINNESOTA, } *ss:*
County of Ramsey, }

On this 26th day of October, A. D. 1887, before me appeared Osmon Lunn and Frederic C. Miller, to me personally known, who, being by me duly sworn, did say they are the president and secretary, respectively, of the St. Paul Plow Works, and that the seal affixed to said instrument is the corporate seal of said corporation, and that said instrument was signed and sealed in behalf of said corporarion by authority of its board of directors, and said Osmon Lunn and Frederic C. Miller acknowledged said instrument to be the free act and deed of said corporation.

[SEAL OF N. P.] FRED. N. DICKSON,
Notary Public, Minn.

STATE OF MINNESOTA, } *ss:*
County of Ramsey, }

Charles H. Bigelow and William B. Dean came personally
61 before me on this 26th day of October, A. D. 1887, to me well known to be the same persons who executed the foregoing bond, and each acknowledged the same to be his own free act and deed.

[SEAL OF N. P.] FRED. N. DICKSON,
Notary Public, Minn.

STATE OF MINNESOTA, } ss:
County of Ramsey, }

Charles H. Bigelow and William B. Dean, being first duly sworn, doth say each for himself that he is the same person as the surety above named, and is a resident and freeholder of and in the county of Ramsey and State of Minnesota and worth the sum of fourteen thousand dollars above his debts and liabilities and exclusive of his property exempt from execution.

CHARLES H. BIGELOW.
WM. B. DEAN.

Subscribed and sworn to before me on this 26th day of October, A. D. 1887.

[NOTARIAL SEAL.] FRED. N. DICKSON,
Notary Public, Minn.

Endorsed.

I hereby approve the security provided by this bond and order that upon the filing of the same a supersedeas be allowed and all proceedings be stayed thereunder.

R. R. NELSON,
Judge of the U. S. Circuit Court.

Endorsed: Filed Oct. 27th, 1887. Oscar B. Hillis, clerk.

62 And on the same day, to wit, Oct. 27th, 1887, a writ of error was issued out of this court; which said writ of error is in the words and figures following, viz:

Writ of Error.

63 UNITED STATES OF AMERICA, ss:

Supreme Court.

WILLIAM STARLING, Defendant in Error,
vs.
ST. PAUL PLOW WORKS, Plaintiff in Error.

The President of the United States to the judges of the circuit court of the United States for the district of Minnesota, Greeting:

Because in the records and proceedings and also in the rendition of the judgment of a plea which is in the said circuit court before you of William Starling, who is the plaintiff therein, and Saint Paul Plow Works, which is the defendant therein, a manifest error hath happened, to the great damage of the said St. Paul Plow Works, as by its complaint appears, we, being willing that the error, if any hath been, should be duly corrected and full and speedy justice done to the parties aforesaid in this behalf, do command you, if judgment be therein given, that, under your seal, distinctly and openly, you send the record and proceedings aforesaid, with all

things concerning the same, to the Supreme Court of the United States, together with this writ, so that you may have the same at Washington on the second Monday in October next, in the said Supreme Court to be then and there held, that, the record and proceedings aforesaid being inspected, the said Supreme Court may cause further to be done therein to correct that error what of right and according to the laws and customs of the United States should be done.

64

Witness the Honorable Morrison R. Waite, Chief Justice of the said Supreme Court, the 27th day of October, in the year of our Lord one thousand eight hundred and eighty-seven.

[Seal of U. S. C. C.]

OSCAR B. HILLIS,
Clerk of the Circuit Court of the United States for the District of Minnesota,
By L. P. RICHARDSON,
Deputy Clerk.

Endorsed: Filed Oct. 27th, 1887. Oscar B. Hillis, clerk.

65 UNITED STATES OF AMERICA, *ss:*

Circuit Court of the United States, District of Minnesota.

I, Oscar B. Hillis, clerk of said circuit court, do hereby certify and return to the honorable the Supreme Court of the United States that the foregoing, consisting of 65 pages, numbered consecutively from 1 to 65, inclusive, is a true and complete transcript of the records, process, pleadings, orders, final judgment, and all other proceedings in said cause, excepting the evidence produced by the respective parties on the trial of said cause, and of the whole thereof as appears from the original records and files of said court.

In witness whereof I have hereunto set my hand and affixed the seal of said court, at Saint Paul, in the district of Minnesota, this 16th day of February, in the year of our Lord one thousand eight hundred and eighty-eight, and of the Independence of the United States the one hundred and eleventh year.

[Seal U. S. Circuit Court, Dist. of Minnesota.]

OSCAR B. HILLIS, *Clerk,*
By L. P. RICHARDSON, *Deputy.*

[Endorsed:] United States circuit court, district of Minnesota. Wm. Starling *vs.* St. Paul Plow Works. Return to Supreme Court.

Endorsed on cover: Minnesota C. C. U. S. No. 1367. The St. Paul Plow Works, plaintiff in error, *vs.* William Starling. Filed February 20, 1888.

JAMES H. McKENNEY.

SUPREME COURT OF THE UNITED STATES.

OCTOBER TERM, 1887.

No. 1367.

ST. PAUL PLOW WORKS,
Plaintiff in Error,

vs.

WILLIAM STARLING,
Defendant in Error.

In Error to the Circuit Court of the United States for the District of Minnesota.

ON MOTION TO DISMISS THE WRIT OF ERROR, BRIEF AND ARGUMENT OF PLAINTIFF IN ERROR.

JOHN B. & W. H. SANBORN,
St. Paul,
Attorneys for Plaintiff in Error.

H. H. SMITH PRINTING COMPANY, ST. PAUL.

things concerning the same, to the Supreme Court of the United States, together with this writ, so that you may have the same at Washington on the second Monday in October next, in the said Supreme Court to be then and there held, that, the record and proceedings aforesaid being inspected, the said Supreme Court may cause further to be done therein to correct that error what of right and ac-
64 cording to the laws and customs of the United States should be done.

Witness the Honorable Morrison R. Waite, Chief Justice of the said Supreme Court, the 27th day of October, in the year of our Lord one thousand eight hundred and eighty-seven.

[Seal of U. S. C. C.]

OSCAR B. HILLIS,
Clerk of the Circuit Court of the United States
for the District of Minnesota,
By L. P. RICHARDSON,
Deputy Clerk.

Endorsed: Filed Oct. 27th, 1887. Oscar B. Hillis, clerk.

65 UNITED STATES OF AMERICA, *ss:*

Circuit Court of the United States, District of Minnesota.

I, Oscar B. Hillis, clerk of said circuit court, do hereby certify and return to the honorable the Supreme Court of the United States that the foregoing, consisting of 65 pages, numbered consecutively from 1 to 65, inclusive, is a true and complete transcript of the records, process, pleadings, orders, final judgment, and all other proceedings in said cause, excepting the evidence produced by the respective parties on the trial of said cause, and of the whole thereof as appears from the original records and files of said court.

In witness whereof I have hereunto set my hand and affixed the seal of said court, at Saint Paul, in the district of Minnesota, this 16th day of February, in the year of our Lord one thousand eight hundred and eighty-eight, and of the Independence of the United States the one hundred and eleventh year.

[Seal U. S. Circuit Court, Dist. of Minnesota.]

OSCAR B. HILLIS, *Clerk,*
By L. P. RICHARDSON, *Deputy.*

[Endorsed:] United States circuit court, district of Minnesota. Wm. Starling *vs.* St. Paul Plow Works. Return to Supreme Court.

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FILED
MAY 2 1888
JAMES H. McKENNEY,
CLERK

SUPREME COURT OF THE UNITED STATES.

OCTOBER TERM, 1887.

No. 1367.

ST. PAUL PLOW WORKS,

Plaintiff in Error,

vs.

WILLIAM STARLING,

Defendant in Error.

In Error to the Circuit Court of the United States for the District of Minnesota.

ON MOTION TO DISMISS THE WRIT OF ERROR, BRIEF AND ARGUMENT OF PLAINTIFF IN ERROR.

JOHN B. & W. H. SANBORN,
St. Paul,
Attorneys for Plaintiff in Error.

H. M. SMYTH PRINTING COMPANY, ST. PAUL.

SUPREME COURT OF THE UNITED STATES.

OCTOBER TERM, 1887.

No. 1367.

ST. PAUL PLOW WORKS,

Plaintiff in Error,

vs.

WILLIAM STARLING,

Defendant in Error.

In Error to the Circuit Court of the United States for the District of Minnesota.

ON MOTION TO DISMISS THE WRIT OF ERROR, BRIEF AND ARGUMENT OF PLAINTIFF IN ERROR.

JOHN B. & W. H. SANBORN,
St. Paul,
Attorneys for Plaintiff in Error.

STATEMENT.

The defendant in error moves to dismiss the writ in this case for want of jurisdiction, and the only question is whether this is "a case touching patent rights."

U. S. Revised Statutes, Sec. 699.

It was conceded that plaintiff in error took the license, Exhibit "A" to the complaint, (page 3, Printed Record,) which the court will notice gave the plaintiff no exclusive right to make the Starling Sulky Plow, but left the defendant in error at liberty to license everyone else in the same territory, which specified no time whatever during which it should continue in force, and no quantity or number of machines that it should cover, and which in no way bound defendant in error not to make and sell other sulky plows.

It was conceded that up to December 5th, 1878, the plaintiff in error made and sold thirty-five or forty plows, and no more, for which it paid in full.

Pages 14 and 18, Record.

The issues that were made by the pleadings and tried and decided by the court in this case were:

1st. Whether Patent No. 116,956, to Hay and Freeman, dated July 11th, 1871, anticipated Patent 154,293, dated August 18th, 1874, to defendant in error.

Complaint, page 1, Record; Answer, page 6, Record; Findings, pages 15 and 16, Record.

2d. Whether Patent No. 120,560, dated October 31, 1871, to Worrell and Rynerson, anticipated said patent to defendant in error.

(Same references as above.)

3d. Whether Patent No. 123,505, dated February 6th, 1872, to Owen, anticipated said patent to defendant in error.

Pages 1, 6, 15 and 17, Record.

4th. Whether Patent No. 132,772, dated November 5th, 1872, anticipated said patent to defendant in error.

Pages 1, 6, 15 and 18, Record.

5th. Whether Patent No. 134,121, dated December 17th, 1872, anticipated said patent to defendant in error.

Pages 1, 6, 15 and 18, Record.

6th. Whether Patent No. 143,147, dated September 23d, 1873, anticipated said patent to defendant in error.

Pages 1, 6, 15 and 18, Record.

7th. Whether a plow manufactured according to the description in Patent No. 225,207, dated March 9th, 1880, infringes any of the claims of the patent to defendant in error.

Answer, page 8, Record; Reply, page 9; Findings, page 15, folio 83, where the court finds that it infringes only one of the three claims of the patent of defendant in error.

8th. Whether the plaintiff in error, before it made any of the plows for which the recovery was had, gave defendant written notice that the Starling plow was useless, and that it renounced its license and would act under it no longer, and the court found that it did.

Answer, page 7, Record; Reply, page 10, Record; Findings, page 14, Record.

The judgment of which we ask a review is for $2.50 apiece royalty on 1310 plows which the plaintiff in error manufactured under the Berthiaume patent after it had renounced its license under the defendant in error.

Pages 14 and 18, Record.

I.

Because in this case the issues were squarely made, tried and decided by the court as to the validity and value of the eight sulky plow patents above mentioned, and a finding and decision made that this Starling patent, which was before almost unheard of, practically covers all the sulky plows in the country, we insist this is "a case touching patent-rights," in which we are entitled to a review of this judgment and decision in this court.

Prior to 1870, statutes in the following words measured this branch of the appellate jurisdiction of this court:

"All actions, suits, controversies and cases arising under any law of the United States granting or confirming to inventors the exclusive rights to their in-

ventions or discoveries, shall be originally cognizable, as well in equity as at law, by the Circuit Courts of the United States. * * * * * * * * Provided, however, that from all judgments and decrees of any such court rendered in the premises, a writ of error or appeal, as the case may require, shall lie to the Supreme Court of the United States in the same manner and under the same circumstances as is now provided by law in other judgments and decrees of circuit courts, and in all other cases in which the court shall deem it reasonable to allow the same."

5 Statutes at Large, page 124, section 17.

On February 18th, 1861, Congress passed an act entitled "An act to extend the right of appeal from decisions of Circuit Courts to the Supreme Court of the United States," which provided:

"That from all judgments and decrees of any Circuit Court, rendered in any action, suit, controversy, or case, at law or in equity, arising under any law of the United States granting or confirming to authors the exclusive right to their respective writings, or to inventors the exclusive right to their inventions or discoveries, a writ of error or appeal, as the case may require, shall lie, at the instance of either party, to the Supreme Court of the United States, in the same manner and under the same circumstances as is now provided by law in other judgments and decrees of such Circuit Courts, without regard to the sum or value in controversy in the action."

12 Statutes at Large, page 130, chapter 37.

It will be noticed that the appellate jurisdiction of this court under these acts was measured by the same words which measured the exclusive original jurisdiction of the Circuit Courts in cases arising under the patent laws: in both courts the jurisdiction extended to "any action, suit, controversy, or case arising under any law of the United States granting or confirming to inventors the exclusive right to their inventions."

In determining the jurisdiction of the Circuit Courts and of this court, under the statutes we have cited, there grew up a line of decision which tended to hold that the jurisdiction of this court to review, and the exclusive original jurisdiction of the Circuit Courts to try patent cases, was limited to those cases in which the complainant rested his cause of action solely upon his exclusive right under the Patent Laws, regardless of contracts and licenses, and that where actions were brought in the Circuit Courts upon contracts and licenses relating to patents, and jurisdiction was obtained through the citizenship of the parties, this court might have no jurisdiction to review the judgment, although the validity of patents was actually decided and determined in the Circuit Courts by these judgments.

These decisions are cited at page 6 of the brief of defendant in error and all arose under the provisions of statute which we have cited above, and are devoted to determining either what was the original exclusive jurisdiction of the Circuit Courts or the appellate jurisdiction of the Supreme Court under those statutes.

Not one of them relates to, considers or construes

the act of Congress by which the appellate jurisdiction of this court is now measured, and which was passed in 1870 and is found in volume 16 of the Statutes at Large, page 207, section 56.

The object of giving this particular branch of its jurisdiction to this court was to secure uniformity of decision in patent cases, but as we understand it, it was found that under the line of decisions above referred to litigants could and did bring suits in the Circuit Courts which were nominally founded upon licenses and contracts relative to patent rights, obtain jurisdiction through the citizenship of parties, and in fact litigate and obtain the decisions of the Circuit Courts upon the validity of their patents and yet avoid under these decisions, a review by this court, and the result was, that the findings and decisions of the Circuit Courts in such cases varied in different circuits and the desired uniformity of decisions upon patent rights failed to be obtained.

When in 1870 Congress passed the "act to revise, consolidate and amend the statutes relating to patents and copyrights," they recognized the evil that had resulted and the still greater evil that was sure to result if the jurisdiction of this court to review the judgments and decisions of the Circuit Courts upon patent rights was limited to those cases only in which they had exclusive original jurisdiction, and excluded those in which their jurisdiction was originally derived from the citizenship of the parties, but in which they had considered and rendered their opinions upon the validity of patent rights, and they extended the juris-

diction of this court to review the judgments of the Circuit Courts to all cases of every nature in which patent rights were involved and determined regardless of the law under which they arose or the ground on which the Circuit Courts obtained their jurisdiction of the cases.

They declared that the original exclusive jurisdiction of the Circuit Courts should remain exactly the same as it had been under the earlier statutes.

12 Statutes at Large, page 206, section 55.

But they provided:

"That a writ of error or appeal to the Supreme Court of the United States shall lie from *all judgments and decrees* of any Circuit Court or of any District Court exercising the jurisdiction of a Circut Court, or of the Supreme Court of the District of Columbia or of any Territory, in *any* action, suit, controversy or case, at law or in equity, *touching patent rights*, in the same manner and under the same circumstances as in other judgments and decrees of such Circuit Courts, without regard to the sum or value in controversy."

12 Statutes at Large, page 207, section 56.

That the construction of this statute we contend for is its only proper construction seems clear to us on the following grounds:

1st: The statute as it stood prior to 1870 had received judicial construction by the cases cited at page 6 of the brief of defendant in error, and Congress knew that that statute gave this court jurisdiction in the cases and only in the cases in which the Circuit

Court took exclusive original jurisdiction under the sections of the statutes above cited, which were framed in the same words—yet by the act of 1870 Congress gave the Circuit Courts their exclusive original jurisdiction in exactly the same words, but it used other words in giving this court its appellate jurisdiction, and made that jurisdiction as broad as the English language could make it when they said the jurisdiction should extend to "*all* judgments in *any* case *touching* patent rights."

This court must presume that this change meant something, and if it meant anything it meant to give jurisdiction in the class of cases of which this is one.

2d. Uniformity of decisions as to the validity of patent rights can only be preserved by such a construction—for if litigants can by making contracts and making them the quasi causes of action litigate, and obtain the decisions of the various Circuit Courts upon, the validity of their patents without a chance for review in this court,—the entire purpose of giving this appellate jurisdiction at all is utterly frustrated—there may be as many decisions as there are Circuit Courts on the various claims of a patent with no chance to review any of them.

3d. Great injustice will result to defendants in patent cases through the use by patentees of such decisions and opinions as that at the case at bar within the jurisdiction of the court in which it is rendered and in other jurisdictions to force settlements, when, if a review was permitted it might clearly appear that the finding and decision was erroneous.

If we are right in our construction of this statute it cannot for a moment be claimed that the case at bar is not a case "touching patent rights" because in the trial and decision of the case the exclusive rights of eight patentees and their grantees to manufacture and sell the ordinary sulky plows were tried, considered and determined by the Circuit Court below.

See statement and references therein, supra.

II.

The authorities cited by the defendant in error at page six of his brief are not in point in his favor upon this question because not one of them construes or refers to the act of 1870 by which this jurisdiction is given.

They all refer to and construe the former statute giving this court jurisdiction or the statute giving the Circuit Courts original exclusive jurisdiction.

Their only force is, upon a careful perusal, to make conclusive the legal presumption that Congress intended by the act of 1870 to carry this jurisdiction beyond the limits these decisions had set for it under the old statute, and give it in *every* case in which the validity of a patent was tried in the Circuit Court regardless of the manner in which it arose, or the ground on which the Circuit Court took jurisdiction—to give it as they said "from *all* judgments in *any* case *touching* patent rights."

We might safely concede that where the question as

to the patent rights was not raised in the pleadings but arose incidently only, in the evidence—that might not be deemed a case touching patent rights—but where, as in the case at bar, the novelty and utility of the patent relied on by defendant in error and the novelty and utility of that relied on by plaintiff in error are squarely at issue by the pleadings and are tried and decided by the Circuit Court, there can be no question but that this is "a case touching patent rights."

III.

If the act of 1870 had made no change in the appellate jurisdiction of this court—we submit that in the case at bar this court would have jurisdiction to review this judgment.

This was an action at law and the pleadings and practice of the Circuit Court in such action follow those of the Minnesota State courts as nearly as practicable.

Under the Minnesota code the plaintiff is required in his complaint to make a concise statement of the facts constituting his cause of action—and upon the trial he obtains any relief consistent with the case made in the complaint and embraced within the issue.

"The complaint shall contain:

First: The title of the cause specifying the court in which the action is brought and the names of the parties to the action, plaintiff and defendant.

Second. A plain and concise statement of the facts constituting a cause of action, without unnecessary repetition.

Third: A demand of the relief to which the plaintiff supposes himself entitled. If the recovery of money is demaneed, the amount thereof shall be stated.

Minn. Statutes, p. 720, sec. 91.

"The relief granted to the plaintiff, if there is no answer, cannot exceed that which he has demanded in his complaint; but in any other case the court may grant him any relief consistent with the case made by the complaint, and embraced within the issue."

Minn. Statutes, p. 749, sec. 267.

Now the defendant in error so drew his complaint—that if the court sustained the license as valid and existing notwithstanding its renunciation, he might recover on that—if it held the license void or renounced he could recover for infringement.

The complaint as the court will see on perusal contains sufficient allegations to permit proof on either theory and the defendant in error on the trial endeavored to prove both.

The three pleadings together put in issue the validity of both the Starling and Berthiaume patents and the novelty and utility of both.

Under this state of the pleadings the court tried and decided all these issues.

Under this state of facts we submit that this case under the old law was one arising under the patent laws of the United States because it was only under those laws that the court could find that defendant in

error had the exclusive privileges vested by the Starling patent.

Brooks vs. Stolley, 3 McLean, 523.
Littlefield vs. Perry, 21 Wallace, 205.
Broomer vs. Gilpin, 4 Fisher, 54.
Magic Ruffle Co. vs. Elm City Co., 13 Blatchford, 157.
Woodworth vs. Weed, 1 Blatchford, 155.
Wilson vs. Sherman, 1 Blatchford, 538.
Woodworth vs. Cook, 2 Blatchford, 160.
Pulte vs. Derby, 5 McLean, 336.
Day vs. Hartshorn, 3 Fisher, 32.
Goodyear vs. Congress Rubber Co., 4 Fisher, 56.
Blanchard vs. Sprague, 1 Clifford, 288.

In Broomer vs. Gilpin, 4 Fisher 54, the court says: "In the argument of the defendant's counsel it is insisted that in this state of the case the court has no jurisdiction, and this point is to be first considered. It is urged in support of this petition that the plaintiff's claim to a decree is based on an alleged violation of the conditions of a license to use a patented machine, and is not, therefore, cognizable in this court under the Patent Laws of the United States conferring exclusive jurisdiction on the Circuit Courts in certain cases. And this objection must prevail unless, in connection with his claim for an account of profits, he has proved an infringement of the patent. It is clearly no ground of jurisdiction, under the Patent Law, that the contract between the parties relates to a patent-right. But if an infringement is

proved, jurisdiction is conferred; and having power to protect the rights of a party under a patent, the court will take cognizance of other matters as incidental to the infringement. This is the doctrine which has been long recognized by the Federal Courts, and was distinctly held by Judge McLean in the case of Brooks and Morris vs. Stolley, 3 McLean, 523."

In Littlefield vs. Perry, 21 Wallace, 222, this court said: "An action which raises a question of infringement is an action arising 'under the law,' and one who has the right to sue for the infringement may sue in the circuit court. Such a suit may involve the construction of a contract as well as the patent, but that will not oust the court of its jurisdiction. If the patent is involved, it carries with it the whole case."

In the case at bar the validity of the patent was at issue upon the pleadings, was tried and was determined by the court upon the proof.

The difference between the case at bar and the decisions cited at page 6 of defendant's brief is, that in the case at bar the question of the novelty and utility of the inventions, the entire question of the validity of the patents, was squarely at issue in the pleadings, was tried and decided, while in those cases the validity of the patents referred to in various pleadings was conceded, and the only question to be determined was the rights of the parties under licenses or contracts made in relation to patents that were conceded to be valid.

In Brown vs. Shannon, 20 Howard, 55, it nowhere appears from the opinion that any question of the

validity of the patents or patent-rights was in issue or tried.

In Albright vs. Teas, 106 U. S. 613, it expressly appears that the validity of the patents was in no way questioned. The only question was the amount of royalties to be paid under the contract. (Pages 614, 615, 617.) The plaintiff had no patent and no rights except under the contract by which he had assigned them. The court said: "In passing on the question of jurisdiction the case is to be considered as if Albright and Cahoone were the only defendants. The appellee, before the commencement of the suit, sold and transferred to Albright and Cahoone all his title and interest in the inventions covered by his patent. The transfer was absolute and unconditional. No right, therefore, secured to the appellee in the patent by any act of Congress remained in him. He had no right to prosecute anyone for infringements of his patents, or to demand damages therefor, or an account of profits. He was entitled to the royalties secured by his contract and nothing more, and the only question raised by the bill of complaint and the answer of Albright and Cahoone was simply this: What is the sum due the appellee from Albright and Cahoone for his royalties under his contract?"

In Wilson vs. Sandford, 10 Howard, 99, the question arose upon a demurrer to the bill, which necessarily admitted the validity of the patent set up therein, and no issue was made or could arise on this demurrer as to the validity of any patent.

In Hartell vs. Tilghman, 99 U. S. 547, the defend-

ants in their answer admitted the validity of plaintiff's patent and the use of the invention, and averred a compliance with the contract and their right to use the invention, and offered to pay what was due under it, and this case was decided by a divided court.

In all the other cases cited at page 6 of the brief of defendant in error the validity of the patent sued on *was not* in question, and in none of them were any of the exclusive rights given patentees by the Patent Laws in issue by the pleadings, or tried and decided by the court, while in the case at bar, as the pleadings and findings show, these rights were squarely in issue, were tried and determined by the court, and we insist that under these circumstances this court would have been authorized to review this judgment under the statutes as they stood prior to 1870, because the questions of the validity of the patent and its infringement were according to the practice of the Minnesota courts which prevailed in this case on the trial below, squarely within the issues and properly tried and decided.

IV.

But defendant in error at page 22 of his brief claims that it was unnecessary for the court to go into and determine the validity of the patents in deciding this case because the plaintiff in error was estopped to deny the validity of the patent of defendant in error by the license.

Our answer to this position is:

1st. This is one of the main questions at issue in the review of this case which we seek—a question which if decided by this court as it was decided after full argument on the trial by the court below, in our favor, makes the validity of this patent the turning point in the case. There is no motion to affirm here, and this question is not raised by the motion to dismiss.

The fact remains that the validity of all the patents pleaded *was* tried and decided by the court below—and thus the case was one *touching patent rights*. Whether the court below erred in trying and deciding upon these patent rights at all, and whether its decision upon them was correct, are questions which we are entitled to be heard upon on their merits, and orally before this court, and we protest that neither of them ought to be considered or decided against us on this motion, and we do not propose to discuss this question of estoppel at length now. We however suggest:

2d. The plaintiff in error was not estopped by the license to contest the validity of the patent of defendant in error.

That license is *sui generis* and we ask the court to notice these peculiarities.

Record, page 3.

A. It does not admit or recite the validity of the Starling patent but simply allows the licensee to make and sell a particular plow under it.

B. It gives the licensee that privilege for no stated time and for no stated number of plows whatever, and so was revocable at any time.

C. It gives the licensee no *exclusive* privilege to make and sell this plow, but leaves the licensor the right to give the same privilege to every one else in the territory.

D. It in no way binds the licensee not to make and sell as many sulky plows of other designs or under other patents as it chooses.

E. It does not bind the licensee to manufacture or sell *any number* of Starling sulky plows, or to manufacture or sell them for *any length of time*.

Now we contended and still contend that this instrument was voidable by either party on proper notice, as it was for no definite time and gave neither party any exclusive rights.

It was nothing more than an agreement to make and sell some Starling sulky plows in the usual way under the license, and to pay $2.50 for what were made under the license.

Plaintiff in error made thirty-five or forty under the license and paid for them and gave written notice on December 5th, 1878, "that the construction of the sulky plow was unsatisfactory and useless, and many had been returned as unservicable, and that the defendant would thereafter manufacture a sulky plow of its own design, and renounced its license."

Record, page 14.

The recovery was for plows made after this renunciation on the ground that these plows infringed one of three claims in Starling's patent.

Record, page 15, 3d.

We insist that after this renunciation the plaintiff in error had the same right to contest the validity of the Starling patent that it had before the license was made, and that no recovery could be properly had against it unless it infringed the patent; that there could be no recovery under the license because it was only plows made "under patent number 154,293," the Starling patent, that the license required it to pay for, and these plows were *not* made under this patent, but the license had been renounced and the patentee notified that the plaintiff in error was *not* manufacturing under this patent but in defiance of it. The license was ended.

In any event the plaintiff in error was not under these circumstances estopped to contest the validity of the patent.

Brown vs. Lapham, 27 Fed. Rep. 77.

Burr vs. Duryee, 2 Fisher's Pat. Cases, 275, 284.

Moody vs. Taber, 1 Banning and Arden's Pat. Cases, 41, 43.

Bostock vs. Goodrich, 25 Fed. Rep. 819.

Bell vs. McCullough, 1 Fisher, 380.

Wood vs. Wells, Crittenden & Co., 6 Fisher, 385.

In a similar case in Burr vs. Duryee, 2 Fisher, 282, 284, where the licensee had not renounced, the court said: "The respondents had a right to purchase and use any other machine. If such machine should be challenged as an infringement of a prior patent, they have a right to defend themselves by any plea any other person might use, *their purchase of a license forms no bond of allegience to the patentee, or an estoppel from averring and proving the truth.*"

In Moody vs. Taber, 1 Banning and Arden, 43, the court said: "The company elected to repudiate any rights or liabilities under the contract and to determine the contract relations absolutely. This it did by its letter of October 9th, 1869, in which the company say to the complainant: 'In order that there may be no misunderstanding in the future, we hereby give you notice that we understand the contract to be at an end, and we shall not therefore account to you for any profits we may derive from the manufacture and sale of abdominal supporters after October 10th, 1869.'"

And the court held such notice *did terminate* the contract relations. And so are all the authorities above and in like cases.

The authorities cited at page 23 of defendants' brief are not in point because in every one of those cases some of the essential elements of the case at bar, that of a naked licensee who has renounced his license are wanting.

In Kinsman vs. Parkhurst, 18 How. 289, the contract was an agreement of partnership between joint

owners of patent rights, and the defendant had never renounced the contract but had made and sold his machines under it.

In White vs. Lee, 14 Fed. 789, 790, there was an express agreement in the contract not to question the validity of the patent or the defendants' infringement thereof, and the defendant had not renounced the contract.

In Rogers vs. Peisseur, 30 Fed. Rep. 525, defendants held the *exclusive* right to make and sell the patented articles, and had not renounced their license, but manufactured and sold under it, and the question was whether they should pay a part of the royalties to a member of a firm which gave them their *exclusive* right.

In Marston vs. Sweet, 66 N. Y. 206, and 82 N. Y. 526, the license was a grant of an *exclusive* right, and the licensee had given no notice of renunciation, and the court well said that the fact that the licensor had granted the *exclusive* right and *thereby agreed that he would not manufacture and sell in the district*, might well be consideration for the contract where no notice of renunciation had been given.

In Baltimore Car Co. vs. North Balt. Car Co., 21 Fed. Rep. 50, the licensee, by the agreement, acknowledged the articles it made to be infringements of the patent and agreed to pay license fees thereon during the term of the patent.

And so are all the cases cited here against us. We have been unable to find *any* decision *anywhere* that a

licensee who had no exclusive right, who never agreed not to make other articles, who agreed to pay royalties for no definite time, and on no definite number, and who has paid for all he made and sold under the license, and has repudiated and renounced the license, is estopped to contest the validity of the patent thereafter.

3d. The defendant in error did not plead any estoppel but waived it, if there might have been one, and joined issue squarely on the validity of the patents, and the question of estoppel is in reality not in the case.

See Reply, page 9, Record.

4th. One of our exceptions, which appears in the bill of exceptions, is this: We offered to prove the fact that the combination described in the Starling patent had been in constant use, *without objection on his part*, for twenty years by all sulky plow makers, and that he had thereby abandoned it, and we had, by the competition of others who used it without license or royalty, been evicted. The court below refused to permit this and we excepted.

This was a good ground of defense, and authorized an attack on the patent and license, even if it had been exclusive and not renounced. An eviction authorizes even an exclusive licensee to attack the patent; and the public use of an invention *is* an eviction, and

the court erred in this ruling. But this does not appear in the record now here, and if the motion is granted we shall be deprived of the review of this and other important questions which the bill of exceptions will disclose.

We respectfully ask that the motion be denied.

JOHN B. & W. H. SANBORN,
Attorneys for Plaintiff in Error.

FILED
APR 2 1891
JAMES H. MCKENNEY
CLERK

Supreme Court of the United States.

OCTOBER TERM, 1890.

No. 329.

THE ST. PAUL PLOW WORKS,

Plaintiff in Error,

vs.

WILLIAM STARLING,

Defendant in Error.

BRIEF FOR PLAINTIFF IN ERROR.

WALTER H. SANBORN,

Attorney for Plaintiff in Error.

H. M. SMYTH PRINTING COMPANY, ST. PAUL.

Supreme Court of the United States.

OCTOBER TERM, A. D. 1890.

ST. PAUL PLOW WORKS,
Plaintiff in Error,

No. 329. vs.

WILLIAM STARLING,
Defendant in Error.

BRIEF FOR PLAINTIFF IN ERROR.

STATEMENT.

The defendant in error brought an action for $10,000 damages, and for his cause of action alleged:

First. That he was the inventor of an improvement in sulky plows that had never been known, used, described or patented before his invention, and that he obtained a patent for it, No. 154,293, dated August 18, 1874.

Transcript, page 1.

Second. That defendant and plaintiff on December 17th, 1877, made the following contract:

"This indenture, made on this 17th day of December, A. D. 1877, between Wm. Starling, of the town of Princeton, Bureau County, Illinois, of the first part, and the St. Paul Plow Works, of St. Paul, Minnesota, of the second part, witnesseth:

That the party of the first part does hereby grant to the party of the second part the right to make and sell the Starling sulky plow under patent No. 154,293, dated August 18th, 1874, in the following territory, viz., Wisconsin, Minnesota, Dakota, and all that part of Iowa north of the Northwestern railway, and all that territory west and north of above described territory. In consideration of the above grant the party of the second part agrees to make said sulky plows in a good and workmanlike manner, and advertise and sell them in the usual manner and at a price not to exceed the usual price of this class of implements sold by other manufacturers, and render an account on the first day of January and July of each year of all plows sold prior to those dates on which the royalty has not been paid, and pay to the party of the first part, his heirs or assigns, two and fifty one-hundredths dollars for each and every plow sold, said royalty for spring sales to be paid July 1st, and for fall sales January 1st of each year.

The party of the first part also grants to the party of the second part the right to make and sell the improvement in whiffletrees under patent 151,804, in consideration of which the party of the second part agrees to pay the party of the first part, at the time of the payment of the royalty for the sulky plows and in the same manner, the sum of one cent for every pound of said irons used or sold.

In witness whereof the said parties have hereto affixed their signatures the day and year above written.

ST. PAUL PLOW WORKS,

Witness: P'r H. E. MANN, Sec'y & Treas.

JAS. J. PAYNE. WILLIAM STARLING."

Transcript, folios 3 and 6.

Third. That plaintiff in error failed to perform the contract in the following respects:

A. That it had lately desisted from making and selling the Starling sulky plows altogether.

B. That it had always failed to make the same in a workmanlike manner.

C. That it had failed to properly advertise the same or properly sell the same.

D. That it had accounted for no plows sold after January, 1879, but had sold sulky plows not accounted for under a different name, which embodied the improvements in and were the plows of defendant with slight modifications.

Transcript, folios 4 and 5.

Fourth. That the contract bound the plaintiff in error to do all these acts, its failure to do which is charged as a breach of the contract for the full term of the patent.

Transcript, folios 3 and 4.

Plaintiff in error by its amended answer defended on the following grounds:

First. It denied that Mr. Starling was the inventor of the improvements he claimed, averred that they had been known, used and on sale in this country more than two years prior to his application, and had been patented in

Letters patent No. 116,956, dated July 11, 1871, to W. Hay and T. B. Freeman.

Letters patent No. 120,560, dated October 31, 1871, to Worrel & Rynerson.

Letters patent No. 123,505, dated February 6, 1872, to C. N. Owen.

Letters patent No. 132,772, dated November 5th, 1872, to C. N. Owen.

Letters patent No. 134,121 dated December 17th, 1872, to J. Worrell.

Letters patent No. 143,147, dated September 23, 1873, to J. D. Harrison.

Second. It admitted that the contract dated December 17th, 1877, was made, but averred that this contract granted no exclusive right to it, to manufacture or sell under the Starling patent; that Mr. Starling reserved his right to license everyone else to manufacture and sell in this territory; that the Plow Works did not agree to manufacture or sell Starling sulkies for the unexpired term of the patent or for *any stated time;* that it did not agree to sell *any number* of plows; that it did not agree that it would not sell other sulky plows under other patents, and that the only effect of the agreement was that Mr. Starling permitted the Plow Works to make and sell Starling sulkies, and the Plow Works agreed to pay him $2.50 apiece for what Starling sulkies it made and sold under the contract.

Transcript, folios 15 and 16.

Third. That the Plow Works fully performed its part of the contract made, advertised and sold some plows under the contract and accounted for and paid $2.50 apiece on each thereof.

Transcript, folio 17.

Fourth. That the Starling sulky plows made under said agreement, according to the Starling patent, proved useless and unsalable, and on December 5th, 1878, the Plow Works

notified Mr. Starling of these facts; that it renounced its license, would no longer manufacture or sell the Starling plow or claim any right so to do, but that it would make and sell a plow of its own design.

Transcript, folios 18 and 19.

Fifth. That after this renunciation it made and sold sulky plows, such as are described in patent No. 225,207, dated March 9th, 1880, to Louis Berthiaume, and that these plows were constructed on entirely different principles from the Starling plows, and were not Starling sulky plows.

Folio 17, Transcript.

Mr. Starling by his reply admitted the notice of renunciation of the license, and denied the other statements of the answer.

The case was tried upon these issues before Hon. R. R. Nelson, acting circuit judge, without a jury, and he found:

First. That the plaintiff in error manufactured and sold thirty-five or forty Starling sulky plows under the contract and accounted for and paid the $2.50 each on them. That it, on December 5th, 1878, gave Mr. Starling written notice that the construction of the Starling sulky plow was unsatisfactory and useless, that many such plows had been returned as unserviceable, and that it renounced its license and would thereafter manufacture a sulky plow of its own design.

That the plaintiff in error could not, without the consent of Mr. Starling, terminate the rights conferred by the license, and, there being no limitation on its face, it continued until the expiration of the letters patent.

Folios 31 and 33, Transcript.

Second. That after the notice of renunciation of the license the Plow Works made and sold 960 plows called Star plow, designed by Berthiaume, described in his patent, and

350 plows called the Harris plow, making 1310 plows, for the contract price of which, (at $2.50 each,) amounting to $3275, he ordered judgment.

Folios 32–39, Transcript.

Third. That the Berthiaume and Harris plows infringed the *first claim* of the Starling patent, but no other.

Folio 33, Transcript.

Fourth. That none of the patents pleaded in the answer anticipated the first claim of the Starling patent, because they did not show a device for locking the plow in the ground by a locking lever at any desired height, or for tilting up the point of the plow so that the horses would pull it out of the ground.

Folios 34–39, Transcript.

On the trial of the action, after the notice of renunciation of the license had been admitted and proved, the plaintiff in error objected to the evidence that it had thereafter made and sold the 1310 plows, on the ground that it was incompetent and immaterial, and Mr. Starling could not recover for them on the contract, but these objections were overruled and it excepted.

Folio 67, Transcript.

The course of the trial was such that the defendant in error introduced in evidence the Starling patent, evidence tending to show the manufacture and sale of the 1310 plows, and the testimony of two experts, Mr. Starling and Mr. Gunckel, tending to show that the Berthiaume and Harris plows infringed the first claim of Starling's patent, and rested.

Folios 66–94, Transcript.

The plaintiff put in evidence the patents pleaded in the answer and testimony of three experts tending to show that these patents anticipated every claim of Starling's patent,

and offered to prove that by the testimony of two more witnesses, but was not permitted to do so (folio 204), and rested.

The defendant in error then introduced the testimony of Messrs. Gunckel and Starling, to the effect that neither of these patents anticipated Starling's, and they stated their reasons and the grounds for their claims in detail as to each of these patents; and for the first time on this trial and in this testimony, stated that the reason these patents did not anticipate was that there was no device in either of said patents which enabled the operator to lock the plow at any desired depth in the ground, or to tilt up the point of the plow so that the horses would assist in raising the plow out of the ground.

Folios 205–281.

Plaintiff in error then offered to show in rebuttal of the last mentioned evidence, by three witnesses then in court, that there is a device in the Hay and Freeman patent, in the Worrell and Rynerson patent, and in the two Owen patents, by which the operator is enabled to lock the plow at any desired depth in the ground, and also to tilt up the point of the plow so that the horses will assist in raising the plow out of the ground, and that these several devices consist of the same combination or a combination of the same mechanical equivalents as that shown in Starling's first claim, and that the witnesses Gunckel and Starling were mistaken in their testimony that there were substantial differences between Starling's combination and its operation shown in his first claim and the combinations and their operations shown in said anticipating patents.

But the court refused to hear any of this evidence, and plaintiff in error excepted.

Folios 282–3, Transcript.

Defendant in error in his testimony introduced evidence to the effect that sulky plows well made according to the sample and patent would be, and that plows so made by the Princeton Manufacturing Company were practical, operative and successful plows and gave the best satisfaction to purchasers.

Folio 205, Transcript.

The plaintiff in error having introduced evidence that defendant in error had sent it a sample plow made at Princeton, Ill., at the time the contract was made, and that it constructed its Starling plows according to that sample and they were worthless—while the Berthiaume and Harris plows were practical and salable—offered to show by witness Carter, who was a practical dealer in plows, that at Princeton, Ill., in 1879, he made and sold the Berthiaume plows at the price of $45 each, in competition with the Starling plows at a price of $25 each, and that the witness was able to sell his plows without difficulty, while the Starling plows had no sale.

Folios 205–281.

But the defendant in error objected to this as immaterial, and the court sustained the objection, to which ruling plaintiff in error excepted.

Folio 281, Transcript.

After the plaintiff in error had rested its case in rebuttal, the defendant in error offered evidence tending to show that he had first constructed a plow containing the elements of his first claim in the winter of 1871–2, before the first Owen patent, dated February 2, 1872.

This evidence was objected to on the ground that it was immaterial, and was a part of the plaintiff's case in chief, but the court overruled the objection and the defendant excepted.

Folio 281, Transcript.

ASSIGNMENT OF ERRORS.

The plaintiff in error alleges that the court below committed manifest errors in the following particulars:

I.

That after it had been proved and the court below had found that the plaintiff in error had constructed and sold between thirty-five and forty Starling sulky plows, under the agreement and according to the sample Starling sent it, (folio 281, Transcript,) and had about December 5th, 1878, given the defendant in error written notice that the construction of the Starling plows was unsatisfactory and useless—that many had been returned as unservicable—that it would not longer manufacture or sell that plow, but would make one of its own design, and that it renounced its license and would no longer act under said agreement, and after said court had found that the plaintiff in error rendered its account to January 1st, 1879, and paid $2.50 apiece on all the plows it made before it renounced the license or agreement—the court still ruled, held and decided "that the defendant could not without the consent of the plaintiff terminate the rights conferred by the license, and there being no limitation on its face the license continued until the expiration of the present letters patent," and ordered and caused judgment to be entered against the plaintiff in error for $2.50 each on the 1310 plows, which the plaintiff in error made after the renunciation of said license, and which were not Starling sulky plows, but plows of an entirely different character and construction, (folios 77–79, Transcript,) and this is an action founded solely on the contract and not brought for infringement of the patent, and when the court

below itself found that the 1310 plows so manufactured were unlike that described in the Starling patent, and did not in any event infringe more than one claim of said patent—when the court should have ruled and decided that there could be no recovery of any amount in this action upon the contract for any of the plows made after said renunciation, and that said renunciation terminated the rights of both parties under said contract.

Transcript, folios 31, 32, 33, 34–39, 327–329, 294.

II.

That the court, against the objection of plaintiff in error that such evidence was incompetent and immaterial after the notice of the renunciation of said contract had been admitted and proved, permitted the defendant in error to introduce evidence tending to show that the plaintiff in error had made and sold the 1310 plows above referred to, which were not made according to the Starling patent, or the sample Starling sent, but after the design of the Berthiaume patent.

Folios 67, 333, Transcript.

III.

That the court below refused to permit the plaintiff in error to introduce the evidence of the three witnesses then in court, in rebuttal of the testimony of Messrs. Gunckel and Starling, to the effect that the patents pleaded in the answer did not anticipate the first claim of Starling's patent, because there was no device in either of said patents which enabled the operator to lock the plow at any desired depth in the ground, or to tilt up the point of the plow so that the horses would assist in raising it out of the ground, when this claim had

been made for the first time by these witnesses in their testimony in rebuttal, and the plaintiff in error had had no opportunity to rebut it before, and when he could have shown by the witnesses Woodward, Haupt and Harris, that there was such a device in the Hay and Freeman patent, in the Worrell and Rynerson patent, and in the two Owen patents.

Folios 66–94, 204, 205–281, 282–3, 331.

IV.

That after the defendant in error had introduced evidence and testimony to the effect that sulky plows well made, according to the sample which had been made by the Princeton Manufacturing Company and sent by defendant in error to the plaintiff in error, would be, and that plows so made by the Princeton Manufacturing Company were practical, operative and successful plows and gave the best satisfaction to purchasers (folio 205, Transcript), and when the plaintiff in error had introduced evidence that it constructed its Starling plows according to said sample and constructed them well, but that they were worthless, while the Berthiaume and Harris plows were practical and salable, the court below refused to permit the plaintiff in error to show by the witness Carter, who was a practical dealer in plows, that at Princeton, Illinois, in 1879, he made and sold the Berthiaume plows at the price of $45 in competition with the Starling plows at a price of $25, and was able to sell his plows without difficulty while the Starling plows had no sale, and sustained the objection of the defendant in error that this testimony was immaterial.

Folios 281, 333, Transcript.

V.

That the court overruled the objection of the plaintiff in error that such evidence was immaterial and was a part of the defendant in error's case in chief, when, after the plaintiff in error had rested its case in rebuttal, the defendant in error offered evidence tending to show that he had first constructed a plow containing the elements of his first claim in the winter of 1871–2, before the first Owen patent, which is dated February 2d, 1872.

Folios 281, 334, Transcript.

VI

That the court sustained the objections of the defendant in error to the testimony offered by the plaintiff in error tending to show that the lever device shown in the Starling patent, and substantially the same as that shown in the Starling model, was used on the Deere sulky plow and the Buford sulky plow prior to 1872.

Folios 2, 13, 204, 281, 333, Transcript.

VII.

That after it appeared in evidence that the defendant in error at the time of the making of the contract caused one of his Starling sulky plows to be sent to the plaintiff in error as a sample, and that the plaintiff in error manufactured the Starling sulky plows in a workmanlike manner according to said sample and they were unserviceable, and after the court had found that the 1310 plows made after the renunciation of the license, did not contain the device used for depressing

the plow-beam in front in the Starling plow, and did not infringe the first two claims of the Starling patent, and were to that extent unlike the Starling sample, yet it still held that a change in these particulars after the renunciation did not defeat the right of Starling to recover the full $2.50 each upon these 1310 plows in this action for a breach of the contract.

Folios 281, 284–287, 329, Transcript.

VIII.

That the court below ruled, decided and held that the improvement claimed in Starling's first claim in his patent in evidence was not anticipated by the patent of Hay and Freeman in evidence.

Folios 287–296, 329, 299–305, Transcript.

IX.

That the court below held, ruled and decided that the Worrell and Rynerson patent in evidence does not show the combination of Starling for the purposes described in his patent, and does not anticipate Starling's pretended invention.

Folios 287–296, 329, 316–319, Transcript.

X.

That the court below ruled, held and decided that patent 123,505, issued to C. N. Owen, in evidence, does not have the combination of Starling for the purposes described in his patent, and does not anticipate his pretended invention referred to in his first claim.

Folios 287–296, 305–308, Transcript.

XI.

That the court below ruled, held and decided that patent number 132,772, issued to C. N. Owen, in evidence, does not have the combination of Starling for the purposes described in his patent, and does not anticipate his pretended invention referred to in his first claim.

Folios 287–296, 308–310, Transcript.

XII.

That the court below ruled, held and decided that patent number 127,828, issued June 11th, 1872, to William G. Haslup, does not have the combination of Starling for the purposes described in his patent, and does not anticipate the invention referred to in his first claim.

Folios 323:353, Transcript.

BRIEF.

FIRST, SECOND AND SEVENTH ERRORS ASSIGNED.

We submit that the court below erred in ordering and entering judgment in this suit upon the contract for the $2.50 each upon the 960 Berthiaume plows, and the 350 Harris plows, that were made and sold by the plaintiff in error after the contract or license was renounced by it, and this on the following grounds:

First. Because the contract did not bind the defendant in error to grant the privilege of manufacturing or selling any number of Starling sulky plows, or of manufacturing or selling them for any length of time to the plaintiff in error, and did not bind the plaintiff in error to manufacture or sell any number of Starling sulky plows or to manufacture or sell them for any length of time, and was therefore void as to all plows made or sold after either party indicated to the other its unwillingness to longer act under the contract. It was so utterly void that no damages could be recovered from either party for failing to permit on the one hand the manufacture and sale, or failing to manufacture and sell on the other.

Bailey vs. Austrian, 19 Minn. 535.
Atkins vs. Van Buren, 77 Ind. 447.
Addison on Contracts, Vol. 1, Star pages 390, 435, 436.
Williamson vs. Taylor, 5 Q. B. 175.

Second. Because the contract was a mere naked permit or license which granted no exclusive privilege to the plaintiff in error to make and sell the Starling sulky plow, but left

the defendant in error the right to give the same permit to every one else in the territory, and it in no way bound the plaintiff in error not to make and sell as many sulky plows as it chose of other designs or under other patents, and was therefore revocable by Starling and capable of being renounced by the Plow Works at any time.

Hence, when it was renounced on December 6th, 1878, and all the Starling sulky plows made to January 1st, 1879, were paid for, the defendant in error could not recover upon the contract for the 1310 plows made thereafter, which were not Starling sulky plows, but were so different that they contained at most but one of the three elements or claims that distinguished the Starling plow.

Brown vs. Lapham, 27 Fed. Rep. 77.
Fetter vs. Newhall, 17 Fed. Rep. 841, 844.
Rich vs. Hotchkiss, 16 Conn. 409, 418.
Moody vs. Taber, 1 Banning & Ard. 41, 43.
Bell vs. McCullough, 1 Fisher, 380, 381.
Sherman vs. Champlain Transportation Co., 31 Vt. 162, 180, 181, 182.
White vs. The S. Harris & Sons Mfg. Co., 5 Banning & Ard. 571.

Third. Because the contract itself, if not revoked or renounced, only permitted the plaintiff in error to make and sell the *Starling sulky plow.* It only protected him in making and selling that plow, and the making and selling of the Berthiaume and Harris plows was an act in no way covered by the contract or license, and not in any way a breach of that contract. The plaintiff in error had not agreed not to make and sell other plows, but as to these other plows it stood out from under its license, was liable for infringement like any stranger if it infringed the Starling patent, and could

defend against such suits on the same ground that any stranger could defend, but for these other plows the defendant in error could not recover any royalty under the contract, because that was confined to the *Starling sulky plow* and that alone, and none of these plows contained the distinguishing characteristics of that plow.

Burr vs. Duryee, 2 Fischer, 281, 282, 283.

Wood vs. Wells, Crittenden & Co., 6 Fisher, 385.

In discussing these propositions the following undisputed facts must be borne in mind:

The contract in this case (folios 6 and 7, Transcript) is *sui generis*, and has the following peculiarities:

A. It does not admit or recite the validity of the Starling patent but simply allows the Plow Works to make and sell a particular plow under it.

B. It gives the Plow Works that privilege for no stated time and for no stated number of plows whatever, and so was revocable at any time.

C. It gives the Plow Works no exclusive privilege to make and sell this plow, but leaves the licensor the right to give the same privilege to every one else in the territory.

D. It in no way *binds* the licensee *not to make* and sell as many plows of other designs or under other patents as it chooses.

E. It does not bind the licensee to manufacture or sell *any number* of Starling sulky plows, or to manufacture or sell them *for any length of time.*

F. It is restricted to "*The Starling Sulky Plow*" and does not authorize the licensee to make or sell any *other* plow under the patent. Nor does it obligate it to pay license fees for the sale of *any other plow*, but as to all other plows except the Starling sulky plow, it leaves the plaintiff

in error free to manufacture and sell, subject only to its liability as an infringer in the same way as it would have been without the contract.

At the time the contract was made, the defendant in error sent to the Plow Works at St. Paul "A Starling Sulky Plow" according to which as a sample the plaintiff in error constructed the 35 or 40 plows it made under the contract.

Transcript, folios 75, 281, 284–5.

On December 6th, 1878, the plaintiff in error renounced the contract and gave notice thereof, and accounted for and paid for all the Starling sulky plows it manufactured up to January 1st, 1879.

Transcript, folios 284–5, 66, 67.

It is for 960 plows called "Star Plow" designed by Berthiaume and 350 plows called the "Harris Plow" made after the license was renounced, that the judgment herein is ordered.

Transcript, folios 285, 293.

None of the 960 Berthiaume plows or of the 350 Harris plows were "Starling Sulky Plows."

There were three claims in Starling's patent, (Transcript, folio 301,) and the sample of the "Starling Sulky Plow" was constructed according to that patent.

The Berthiaume and Harris plows contained nothing equivalent to the second or third devices claimed in the Starling patent, and the judgment went on the sole ground that these plows infringed the first claim of the Starling patent and that only, and we think we can demonstrate later that they did not infringe even that.

Transcript, folios 71, 72, 77, 287, 51, 114–118, 123–130, 133, 145–168, 174.

FIRST.

The court below escaped from the first two propositions we have stated above, by holding that "there being no limitation on its face the license continued until the expiration of the present letters patent, and that the defendant could not without the consent of the plaintiff terminate the rights conferred by the license."

Transcript, folio 33.

He was led into this error by the citation and use by the defendant in error, upon the trial, of the following authorities, which will no doubt be cited in this court, and by his failure to mark the vital distinction between the contract or license in these cases, and the one in case at bar. The cases were

A. Kelly vs. Porter, 17 Fed. Rep. 517, 592.
Cohn vs. National Rubber Co., 3 Banning & Ard, 568, 571–2.
Walker on Patents, sec. 309.

B. Hodge vs. Hudson River R. R. Co., 6 Blatchford, 165, 169.
Woodworth vs. Weed, 1 Blatchford, 163, 164.
Nixon vs. Paper Bag Machine Co., 105 U. S. 766,771.
Rogers vs. Reissner, 30 Fed. Rep. 530.

C. White vs. Lee, 17 Fed. Rep. 780.
McKay vs. Jackman, 17 Fed. Rep. 641–3.
Kinsman vs. Parkhurst, 18 Howard, 289.
Evory vs. Candee, 17 Blatchford, 204.
Pope Mfg. Co. vs. Owsley, 27 Fed. Rep. 101.
National Rubber Co. vs. Boston Rubber Shoe Co., 41 Fed. Rep. 48, 50.

These authorities and those cited in the opinions and text books in support of the decisions in these cases, are not in point in the case at bar for the following reasons:

First. There is this vital distinction between the contracts on which the cases above cited arose and the one in the case at bar, to-wit, in those cases the contracts granted the *exclusive right* under the patent to make and sell patented articles in a certain territory, or the *exclusive right to use* a certain machine or number of machines—this is *a grant of a portion of the franchise*, and as it conveys an intregral part of the franchise, that part exists just as long as the whole out of which it is carved continues, that is for the life of the letters patent.

Aiken vs. Manchester Paint Works, 2 Cliff. 438.
Bloomer vs. Millinger, 1 Wall. 340.

Hence, a notice of abandonment or renunciation of the conveyance of this integral part, which has been executed and delivered, does not diminish the fractional part or the continuance of the portion of the franchise conveyed. This proposition rests upon sound reason, and it is this: the patentee by the grant of the exclusive right has deprived himself of the right and privilege of giving to other individuals the right in the territory thus excluded to manufacture or sell the patented article, and hence the exclusive licensee ought not to be and will not be permitted after he has accepted the grant and thus deprived the licensor of his privilege to license others, to abandon or renounce the grant and thus damage the licensor. This is upon the principle that having taken the grant and so deprived the licensor of the right to license others, he is estopped to repudiate the grant, because he cannot put the licensor *in statu quo*.

It is for these reasons, that in Kelly vs. Porter, 17 Fed. Rep. 519:522, where the patentee contracted to give the licensee "the exclusive right and privilege of manufacturing and selling the aforesaid goods under any patent that he might obtain by or through his application aforesaid," in a certain territory, and covenanted to protect the licensee "against any and all persons during the term for an application for a patent as aforesaid, and after he shall have obtained a patent from the United States government aforesaid," and that if the patentee's claims were rejected, the agreement should then cease and be void. The court held that the contract and grant extended for the life of the patent, and could not be revoked by the licensor.

It would be strange indeed if it could be, after he had granted an integral part of his franchise, had covenanted to protect against everybody, and had provided in what case alone his agreement should cease.

So in Cohn vs. National Rubber Co., 3 Banning and Arden, 568, 571-2, which seems to have been cited and relied on by the court (folio 51, Transcript), and where it is said, "if licensees refuse to perform on their part and repudiate the license, they may be treated by the owner of the patent at his election as infringers. He may have his remedy by suit upon the license, in case they have repudiated the license, or he may elect to treat them in the future as infringers of his exclusive rights under the patent. Being infringers they cannot set up the license in defense of a suit any more than if they had never possessed any such authority."

It is important to remember that that was an action by the patentee for an infringement, and the defendant's plea was that it had an exclusive license from the plain-

tiff, but that the plaintiff's patent was void, that it had not sold any shoes that infringed the plaintiff's patent, and if it had it was ready to pay royalty under its license. The only question decided was, that after being defeated on the question of infringement, defendant could not defend under its license. What is said about the licensor having his remedy by suit upon the license in case the licensees have repudiated the license is *obiter dict*, and if it is good law at all, it applies only to cases where an integral part of the franchise has been granted by the conveyance of an exclusive right and that for the reasons we have stated above.

The remarks in Walker on Patents, section 309, and other text books upon this particular point, rest solely upon the authorities we have cited above, and relate solely to cases of the grant of exclusive rights.

But a contract like that at bar which gives *no* exclusive right—grants *no* integral part of the franchise, but merely permits an individual to use it in the making and sale of certain machines, with the agreement to pay a stipulated amount for those so made and sold, *without any stipulation as to the time of its continuance or number to be sold*—continues no longer than both parties assent to and act under it. It is revocable by the licensor and may be renounced by the licensee, because when notice of revocation or of renunciation has been given and the machines made before such notice under the license are paid for, both parties are restored to the same position in which they stood before the license was made—and there was no agreement for its continuance.

The licensor has lost nothing, for he has always had the privilege of licensing everybody, and he has been paid for what the licensee has sold under the contract; the licensee has lost nothing, for he has had the license for what he sold

under it, and he always had the right which he still has to make machines in defiance of the patent and take his chances of infringement.

This is a contract on the one hand that plaintiff in error may make "the Starling Sulky Plow," and on the other that plaintiff in error will make such plows and pay $2.50 on those made and sold.

Now what is the difference between that contract and an agreement on the one hand to permit one to take water from a well, and the agreement on the other hand to pay ten cents a hogshead for that taken, or an agreement on the one hand to make shoes and on the other to pay one dollar a piece for those made.

Is it not axiomatic that either party in any of these contracts may at any time pay for what he has had—give notice he will act under the contract no more, and be free of all obligations thereof thereafter?

It has always seemed to us that the court below was clearly in error when it held that this contract extended for the life of the patent and could not be renounced, and if so the judgment should never have been rendered.

See authorities under subdivision first at the head of this point.

The distinction we have urged is fundamental, and underlies all the law relative to licenses.

So in real estate law a license unaccompanied with the grant of any exclusive right may at any time be revoked or renounced.

Johnson vs. Stillman, 29 Minn. 95.
Malott vs. Price, 109 Ind. 22.
Parish vs. Kasper, 109 Ind. 586.
Kivet vs. McKeithen, 90 N. Car. 106.
Chute vs. Carr, 20 Wis. 531.

Price vs. Case, 10 Conn. 375.

Huff vs. McCauley, 53 Pa. St. 206.

St. Louis Stock Yards vs. Wiggins Ferry Co., 112 Ill. 384.

Jackman, Sharp & Co. vs. Phila. & C. R. R. Co., 4 Del. Ch. 130.

Cobb vs. Fisher, 121 Mass. 169.

Stoddard vs. Filgur, 21 Ill. App. 560.

But where one granted the exclusive privilege to take wild fowl on the lake, sloughs and waters of the grantor with privilege of ingress and egress, this was held to be a grant of a license or power *coupled with an interest*, and therefore irrevocable.

Bingham vs. Salene, 15 Oreg. 208.

To the same effect are

Rogers vs. Cox, 96 Ind. 157.

Gardner vs. Weaver, 11 W. N. C. (Pa.) 544.

Second. Another distinction which differentiates many of the cases relied on by defendant in error from the case at bar, is that the contracts in those cases expressly stipulated that they should continue and parties should act under them for an agreed time.

In Hodge vs. Hudson R. R. Co., 6 Blatchford, 165, 169, the license granted the right to use the patented article "for and *during the term* for which the said letters patent may be granted."

The only question was whether this gave the right to use them during an extended term, and the court held it covered the term existing when the contract was made, but not the extended term.

In Nixon vs. Paper Bag Machine Co., 105 U. S. 766, 771, there was no question of renunciation or revocation—no

question whether a license extended during the term of the original letters—the only question was whether an *exclusive* license in a certain territory extended beyond that term, and the court held it did *not*.

In Rogers vs. Reissner, 30 Fed. Rep. 530, the defendants had by the grant obtained "the *exclusive right* to make and sell the patented improvement throughout the United States *to the end of the patent*, and agreed to pay certain license fees monthly."

Of course neither party could abrogate such a contract without the consent of the other. But the contract at bar granted no part of the franchise, stipulated no time, and is governed by the other rule.

Third. Another distinction that distinguishes many of the cases from that at bar is that the defendants have retained and used the machine that they were licensed to use or the exclusive right conveyed, and still tried to defend against the payment of the consideration for that use or right.

So in Woodsworth vs. Weed, 1 Blatchford, 163, 164, plaintiff granted defendant a license to construct and use one patent machine for which defendant gave his five promissory notes, and agreed that the license should revert if he failed to pay any of the notes. Defendant failed to pay two of his notes but still used the machine. Held, plaintiff was entitled to an injunction until the notes were paid. Of course he could not continue to use the machine for which he had agreed to pay an aggregate amount and defend on any principle of law or equity.

But in the case at bar plaintiff in error paid for everything it had, gave notice of renunciation, and this put Mr. Starling

just where he was before he made the contract, before it made the plows for which this judgment was rendered.

Fourth. Another difference between the cases relied on by the defendant in error and the case at bar is that in those cases the licensee, either by express covenants in the license or by recitals and admissions, or by a failure to give notice of a renunciation and continuing to use the licensed articles without such notice, and then seeking to defend against payment for what he had already had and used, had estopped himself to contest the validity of the patent, while in the case at bar no such facts working estoppel existed.

It was indeed claimed on the trial that the plaintiff in error was estopped to contest the validity of the patent of Mr. Starling, and the authorities of defendant in error which we have cited above were read for that purpose, but they are not in point.

Thus, in White vs. Lee, 17 Fed. Rep. 780, the licensee stipulates that "he will not in any way contest the validity of said patents or of either of them, or any reissue or renewal thereof, nor the sufficiency of the specifications, or the validity of the licensor's title, nor the fact of his infringement in the manufacture or sale of said shoes."

In McKay vs. Jackman, 17 Fed. Rep. 641–3, the defendant was using a machine under a lease and license by which he expressly stipulated not to contest the validity of the patents. (Page 642.)

In Kinsman vs. Parkhurst, 18 Howard, 289, a partnership contract had been made which provided that one party should manufacture and sell the patented machines and render an account and pay over a certain amount of the proceeds to the plaintiff. The defendants manufactured and sold the

patented machines under this contract with the patentee without any notice of repudiation or renunciation and then undertook to defend against paying over the proceeds belonging to the plaintiff by showing the invalidity of the patent.

Of course they were estopped to do this on the principle that where an agent has collected a debt for his principal, he cannot keep the money upon an allegation that the money was not justly due. (Page 293.)

In Evory vs. Candee, 17 Blatchford, 204, the patent recited that the license was "lawfully granted," and the court said:

"It is not necessary to consider upon the first point the question whether in an action to recover over-due license fees, the licensee is estopped from contesting the validity of a patent by a naked license and by an unmolested exercise of the right the license purported to convey, for in this case the licensee expressly admitted the validity of the patent in the recitals of the agreement."

In Pope Mfg. Co. vs. Owsley, 27 Fed. Rep. 101, defendant had covenanted in the license not to contest the validity of the patent or title.

In National Rubber Co. vs. Boston Rubber Shoe Co. 41 Fed. Rep. 48, 50, the defendants took a license and agreed to pay license fees on shoes made under it quarterly; they did so from January 1st, 1882, to September 30th, 1886. On *December 30th*, 1886, they notified plaintiff they would not pay any more until the validity of the patents was established. On *March 14th, 1887*, they repudiated the license. This action was for the license fees on shoes made between September 30th, 1886, and January 1st, 1887. That is, before they had given any notice that they would not pay or that they renounced the license, and the court held that up

to January 1st, 1887, they acted under the license and derived benefits from it, and therefore as to license fees earned prior to that date they were estopped to contest the validity of the patents.

In Covell vs. Bostwick, 39 Fed. Rep. 421, 425, the defendant had a grant of an exclusive right, which he did not repudiate but enjoyed without renunciation, and the court held that he must pay the fees applicable to the goods made according to the contract and could not defend against these by attacking the patent, but it also held that he had the right to show that the goods he made were not within the license, and that as to those not so within it, there was no estoppel even where the exclusive right was granted. (Pages 426–7.)

Now in the case at bar there is no covenant not to attack the patent—there is no recital that it was lawfully granted—there are no benefits derived by the plaintiff in error that it did not fully pay for when it renounced its license—there are no license fees upon any plows that were manufactured or sold before the defendant in error received notice of the renunciation that had not been fully paid—there was no grant of any exclusive right or privilege and so no conveyance of any part of the franchise—there was no agreement fixing the time during which either party would continue to act under or perform the contract, or fixing the quantity that either party should license or make—and every case that has ever been cited against us is widely and easily distinguished both in reason and upon settled principles of law from the case at bar by one or many of the considerations above mentioned.

SECOND.

Turning to the authorities cited under the second subdivision at the head of this point, it seems clear that when the notice of renunciation had been given and all fees paid to that time under this contract, the parties stood exactly as they did before any contract was made—each had the same rights and remedies and none other. For whatever happened thereafter no action upon the contract could be maintained, for it no longer existed. Such, as we understand it, is the effect given to such a renunciation in cases of a naked license without any grant, admission, or contract relative to the franchise.

In Brown vs. Lapham, 27 Fed. Rep. 77, the defendants were licensees of the plaintiff but, after acting under the license for a time, repudiated the same, and afterwards infringed in defiance of the patent. It was sought to estop them from defending on the ground of the invalidity of the patent because they once had this license, but the court said:

"There is no fair question, but that a licensee under a patent is estopped to deny its validity on any question arising out of that relation between the parties. (Kinsman vs. Parkhurst, 18 Howard, 289.) *It does not follow that he will always be estopped because he has stood in that relation. When he stands out from under it and claims nothing from it and does nothing more under it with full knowledge to the licensor of his position, he would appear to be at as full liberty to contest the patent as any one.*"

In Moody vs. Taber, 1 Banning and Arden's Patent Cases, 41: 43, where the defendant undertook to defend on the ground that it had a license after it had given notice of renunciation, the court said:

"The company elected to repudiate any rights or liabilities under the contract, and to determine the contract

relations absolutely. This it did by its letter of October, 1869, in which the company say to the complainant: 'In order that there may be no misunderstanding in the future, we hereby give you notice that we understand the contract to be at an end, and we shall not therefore account to you for any profits we may derive from the sale of abdominal supporters after October 10th, 1869.' The company could not be permitted thus to put an end to the contract and deny the validity of the patent and refuse to recognize any title in the patentee, and afterwards set up the license as a defense."

To the same effect is Bell vs. McCollough, 1 Fisher, 380.

In Fetter vs. Newhall, 17 Fed. Rep. 841–844, the defendant had a patent under a license which had two claims. He repudiated and renounced the license and made and sold a patented article, which infringed only one claim of the patent, and the court said:

"In doing this he is not acting under the license, whatever its terms are which are in dispute, but is acting in defiance of the patent and outside the license. Under these circumstances the license is no protection against suit for infringement."

In Sherman vs. The Champlain Transportation Co., 31 Vt. 162, the defendant made a contract to pay the plaintiff, who was a patentee, a fixed amount per annum for each of two machines which the plaintiff himself had made and delivered to the defendant, and a separate amount per annum for a right to use a machine which the defendant made that infringed the patent. After paying for two or three years, the defendant gave notice that it renounced the patent, but continued to use all three of the machines. Held, the defendant could not repudiate the contract and stand out from under the patent as to the two first machines without

returning them. But as to the third, which the defendants made themselves, the court said:

"Here there was nothing which the defendants had received of the plaintiffs, and which they could restore to him upon repudiating the contract, and we are not prepared to say that after the defendants had done all in their power to restore the plaintiff to the same condition he was in before the contract, they might not cease to act under the contract and take issue with the plaintiff as to the validity of the exclusive right which he claimed by virtue of his alleged title to the patent." Pages 180–181.

We respectfully submit that both upon reason and authority the first and second propositions at the head of this point are well established and entitle us to a reversal of this judgment.

THIRD.

If however we are in error regarding these two propositions, still there could be no recovery on this judgment for the reason stated in our third proposition.

The contract related only to the "*Starling sulky*" *plow* made after the sample sent by the defendant in error, and none of the 1310 plows *was* a "*Starling sulky*" *plow* or contained either the second or third devices shown in the three claims of the Starling patent, or was in any way like the "Starling sulky plow" except that it possibly infringed the first claim of that patent.

Transcript, folios 71–72, 77, 287, 51, 114–118, 123–130, 133, 145–168, 174.

These plows were not covered or referred to by the contract—the defendant had a right to make and sell any plow but "the Starling Sulky Plow," without paying any license fees to Starling under this contract, and as to all such

plows it stood in the same relation as a stranger to Starling, and his only remedy if they infringed was a suit for infringement. He certainly had none under the contract, for neither party had made any contract about them.

In Durr vs. Duryee, 2 Fisher, 283, the defendants had a license to use two machines, constructed according to complainant's patent, to make hats upon. Held, it was no violation of the license contract for the defendants to manufacture and sell, or use other machines made by other parties which might infringe the plaintiff's patent, and the license to use the two machines would not estop them from contesting the validity of complainant's patents in suits for infringement based on the manufacture and sale of other machines.

The court said: "*The respondents have a right to purchase and use any other machine; if such a machine should be challenged as an infringement of a prior patent, they have a right to defend themselves by any plea that any other person might use. Their purchase of a license forms no bond of allegiance to the patentee, or any estoppel from averring and proving the truth.*"

In Wood vs. Wells, Crittenden & Co., 6 Fisher, 385, where the defendants had a license to attach patented fixtures to Landau carriages they made and sell the carriages with the fixtures on them, but they proceeded to make and sell the fixtures without the carriages, the court said:

"The license grants to the defendants the right to attach the invention to Landau carriages, but does not grant the right to deal in the fixtures as articles of merchandise. *As to this the defendants stand in the same situation as persons who have no license. If they sell, they sell in violation of the patent, but not in breach of any condition of the license. They stand as any other person does who violates the patent without authority.*"

The distinction and principle announced by these authorities is just and reasonable, and great force is added to the weight of these authorities by considering the manifest injustice that has resulted in this case from ignoring the principle they announce.

The contract permitted the making and sale of the "Starling Sulky Plow," on which plaintiff in error agreed to pay license fees, but the contract left plaintiff in error free to make and sell any other plows.

The "Starling Plow" was inoperative, and it renounced its license and made other plows, which if they contained anything, contained only one-third of the improvements of Starling.

Now, if the plaintiff in error was sued for infringement here, and the royalty for a "Starling Sulky Plow" was $2.50, the presumption is that the royalty for the infringement of one claim would not be more than 83⅓ cents, and if, as in this case, the patented machine was much improved by the plaintiff in error, it would have the right to show that, and the defendant in error could recover only nominal damages, unless he could show what proportion of the profits was due to this original first claim.

Where only one of the claims of the patent is infringed, and there is an established license fee for the whole patent there can be a recovery of only that proportion of the fee which the part infringed bears to the entire improvement patented.

Wooster vs. Simonson, 16 Fed. Rep. 680. 20 Fed. Rep. 316.

Bostock vs. Goodrich, 25 Fed. Rep. 819.

Garretson vs. Clark, 111 U. S. 127.

Dobson vs. Hartford Carpet Co., 114 U.S. 439:440–445, and cases cited at page 445.

In the case at bar there was no established license fee, for Mr. Starling never licensed anybody else, and his recovery would have been limited to the profits derived from the first claim of his patent, and the burden would have been upon him to have shown what that was, and failing that the recovery would have been nominal, for this court has said:

"The patentee must in every case give evidence tending to separate or apportion the defendant's profits and the patentee's damages between the patented feature and the unpatented features, and such evidence must be reliable and tangible and not conjectural or speculative, or he must show by equally reliable and satisfactory evidence that the profits and damages are to be calculated on the whole machine, for the reason that the entire value of the whole machine, as a marketable article, is properly and legally attributable to the patented feature."

Garretson vs. Clark, 111 U. S. 127.

Where such proof is not made, only nominal damages may be recovered.

Dobson vs. Hartford Carpet Co., 114 U. S. 443–445.

The result of ignoring the rule that the contract covers only what the parties contracted about, is that the plaintiff in error is made to pay in this case $3275 in license fees for making plows that *were not covered by the contract*, because it contracted to pay $2.50 on what "Starling Sulky Plows" it sold, when if the defendant in error was remitted to his suit for infringement and his recovery limited to the profits derived from the first claim of his patent, he never could recover one cent.

We therefore submit that for the reasons we have stated, the court below could not lawfully render this judgment against the plaintiff in error upon the contract—

Because the contract contained no stipulation as to the continuance of its term or the number or quantity of "Starling Sulky Plows" to be made or sold.

Because it was renounced by the plaintiff in error before the plows whose license fees were sued for were made.

Because the plows, the license fees for which are in this judgment, were not "*Starling Sulky Plows*"—were not covered by the contract, and if they infringed any claim of Starling's patent, his only remedy was a suit for infringement and it was no violation of the contract for the plaintiff in error to make or sell them.

EIGHTH, NINTH, TENTH, ELEVENTH AND TWELFTH ERRORS ASSIGNED.

It was error in the court below to find that the first claim of Starling's patent No. 154,293, August 18, 1874, (folio 300,) was not anticipated by the patent to Hay and Freeman, No. 16,956, July 11, 1871, (folio 302); the patent to Worrell and Rynerson, No. 120,560, October 31, 1871, (folio 316); the patent to Charles N. Owen, No. 123,505, February 6, 1872, (folios 306–7); the patent to Charles N. Owen, No. 132,772, November 5, 1872, (folios 308–310); and patent to William Hoslup, No. 127,878, June 11, 1872, (folios 323–4).

Folios 288–294, 52–3.

It was proved below and found by Judge Nelson that the 1310 plows in no way infringed the second and third claims of Starling (folios 71, 72, 77, 287, 51, 114, 118, 123–130, 133,

145–168, 174), so that the only material question was whether Starling's first claim, which Judge Nelson thought was infringed by the Berthiaume and Harris plows, was anticipated by the patents above mentioned, which were pleaded and proved.

Starling's first claim is:

"The crank-bar, K, combined with the plow-beam, N, lever, L, and axle, A, as and for the purposes set forth, so that the horses are made to raise the plow out of the ground."

In the specifications we read, "K is a bar which is bent twice at right angles to bring its middle into horizontal position. One end of the crank-bar, K, rides upon the inner end of the journal of the wheel, B, and the other end rides upon a bolt or pin attached to the plate, F. * * * With the end of the crank-bar is rigidly connected the lower end of a spring lever, L, which projects upwards along a curved bar, M, attached to the axle, A, and brace, J, and in the outer side of the rear part and in the extreme forward part of which are found notches to receive the lever, L, and hold it in any position into which it may be adjusted. * * * To the under side of the plow-beam, N, is bolted a box, P, to receive the horizontal part of the crank-bar, K."

Folio 299.

The operator, by pushing forward upon the lever, causes the rear part of the crank-bar which is attached to the plow-beam to rise, and to take with it the plow-beam and plow as the horses move forward.

It would seem that a combination of a crank-bar, plow-beam, lever and axle in such a way that when the operator pushed or pulled the lever the plow-beam and plow would be raised out of the ground by the draft of the horses, would anticipate this claim.

The learned judge below did not claim that the patents we have referred to as anticipating Starling's did not have a combination of a crank-bar, lever, plow-beam and axle, or of their mechanical equivalents, for the purpose of raising the plow out of the ground and so that the horses were made to raise the plow out of the ground, but he claimed that these patents did not anticipate Starling's because he thought there was no locking device shown in either of them by which the plow could be locked at any required depth, and because he thought that in the operation of the plows shown by these patents the point of the plow was not first tilted up by the lever and locked, so that the horses could pull it out of the ground by that means.

Folios 288: 290–291.

We insist:

First. The court below was in error in finding that the horses were enabled to pull the plow out of the ground in Starling's patent by the adjustment of the lever in the notches in the curved bar, as he does at folio 286.

An examination of the Starling patent shows that the curved bar, M, has notches only "*in the outer side of the rear part and in the extreme forward part of it*" (folio 299), and that these could only be used when the plow was at its depth in the ground or fully raised out of the ground. The bar was without notches to hold the lever at any intermediate point at which it would be while the plow was being raised.

Besides, it is perfectly evident that the lever could not be locked while the plow is coming out of the ground, because as the plow rises from its position in the ground the lever must constantly move forward along the curved bar through a space proportionate to the rise of the plow. To lock it anywhere while the plow is being raised would either stop its ascent or carry the sulky up with it and tip it over.

Second. The curved bar, M, and the locking device the court below seemed to find therein were *not claimed* by Starling in his patent, and the bar constitutes no part of the combination which he claimed to invent. (Folios 300, 79, 84, 85, 90.) Starling claimed as his invention here the "combination of the crank-bar, K, plow-beam, N, lever, L, and axle, A, as and for the purpose set forth, so that the horses are made *to raise the plow out of the ground.*" On the trial below it was claimed, and the court below found, that Starling had invented and secured by this claim the combination of the curved bar, M, (not mentioned at all in the claim) with the lever, L, "so that the operator *was enabled to fasten the the plow in the ground, or at any other height.*"

See Judge Nelson's opinion, folios 288–293: 52.

It was this new claim, combination and function, and this alone, that the court below found was not anticipated by the patents we pleaded. They did anticipate the claim as it stood in Starling's patent.

We respectfully submit that it was not competent for the judge below to spell out this new combination and claim from the specifications of Starling, and then subordinate all other sulky plow patents to the Starling patent on the ground that this combination of bar and lever—this locking device—was not anticipated by the patents that anticipated the claim as stated.

White vs. Dunbar, 119 U. S. 49–51.

Howe Machine Co. vs. National Needle Co., 134 U. S. 394.

Day vs. Fairhaven R. R. Co., 132 U. S. 98, 102.

The Corn Planter, 23 Wallace, 224.

Keystone Bridge Co. vs. Phœnix Iron Co., 95 U. S. 274, 278.

The statute provides that the inventor shall in his claim "particularly point out and distinctly claim the part, improvent or combination which he claims as his invention."

Section 4888, Revised Statutes.

In The Corn Planter, 23 Wallace, 224, Mr. Justice Bradley said:

"Where a patentee, after describing a machine, claims as his invention a certain combination of elements, or a certain device or part of the machine, this is an implied declaration, as conclusive so far as that patent is concerned as if it were expressed, that the specific combination or thing claimed is the only part which the patentee regards as new. True, he or some other person may have a distinct patent for the portions not covered by this, but that will speak for itself; so far as the patent in question is concerned the remaining parts are old, common or public."

If Mr. Justice Bradley was right the curved bar, M, which is not claimed at all, and its combination with the lever, L, which is not claimed at all, and their function to prevent the plow from being raised or lowered by the horses, and to hold it fast at some desired heighth, which is the diametrical opposite of the function which Starling did claim, were old and common to the public so far as this patent was concerned.

Walker on Patents, section 117.

In Day vs. Fairhaven R. R. Co., 132 U. S. 93: 102, this court said:

"A claim in letters patent must be held to define what the patent office has determined to be the patentee's invention, and is not to be enlarged in construction beyond the fair interpretation of its terms."

In White vs. Dunbar, 119 U. S. 49:51, Chief Justice Waite said:

"Some people seem to suppose that a claim in a patent is like a nose of wax which may be turned and twisted in any direction, by merely referring to the specifications—so as to make it include something more than, or something different from, what its words express. The context may, undoubtedly, be resorted to, and often is resorted to, for the purpose of better understanding the meaning of the claim; but not for the purpose of changing it, and making it different from what it is; the claim is a statutory requirement, prescribed for the very purpose of making the patentee define precisely what his invention is; and it is unjust, to the public, as well as to the law, to construe it in a manner different from the plain import of its terms. This has been so often expressed in the opinions of this court that it is unnecessary to pursue the subject further. See Keystone Bridge Co. vs. Phœnix Iron Co., 95 U. S. 274, 278; James vs. Campbell, 104 U. S. 356:370."

In Howe Machine Co. vs. National Needle Co., 134 U. S. 394, Chief Justice Fuller said:

"Doubtless a claim is to be construed in connection with the explanation contained in the specification, and it may be so drawn as in effect to make the specification an essential part of it; but since the inventor must particularly specify and point out the part, improvement and combination which he claims as his own invention or discovery, the specification and drawings are usually looked at only for the purpose of better understanding the meaning of the claim, and *certainly not for the purpose of changing it and making it different from what it is:* as remarked by Mr. Justice Bradley in

White vs. Dunbar, 119 U. S. 47–52: 'The claim is a statutory requirement prescribed for the very purpose of making the patentee define precisely what his invention is; and it is unjust to the public, as well as an evasion of the law, to construe it in a manner different from the plain import of its terms.'" Page 394.

Under these decisions it cannot be then that Starling's patent was not anticipated for the reason given by judge Nelson that there was no locking device, like that in Starling's curved bar shown in the anticipating patents.

Third. These anticipating patents show a combination of the same mechanical equivalents, performing the same function as claimed in Starling's first claim.

Worrell & Rynerson, No. 21,560, dated Oct. 31, 1871, (folios 316–319.)

An examination of this patent and its specifications shows that it describes a combination of the same parts as claimed in Starling's first claim, operating in the same way for the same purpose and performing the same function: the only difference is, that the lever is an extension of one side of the crank bar so placed as to be operated by the foot instead of by the hand. The patent clearly shows this, and Judge Nelson in his opinion (folios 289–290) clearly finds it, and then holds it does not anticipate Starling, in these words: "The object of the foot-lever is to enable the driver to raise the plow entirely out of the furrow and out of contact with the ground, but as soon as his foot is removed the plow falls back. There is no device for locking the plow at any required depth and the foot lever which is an extension of the yoke or transfer bar will not raise the point of the plow."

The claim of that judge that a claim to anticipate Starling's first claim must have a locking device we think we have disposed of above.

The only other reason why this patent does not anticipate Starling's is that the foot lever will not tilt the point of the plow up as the horses raise it through the operation of the lever.

Our answer to this is:

1st. In the Worrel and Rynerson plow the operation of the foot lever *will* tilt the point of the plow upward, so that the horses moving forward will draw it out of the ground, and thus assist in raising it.

The ground taken below to show that the point of the plow would not be raised was that the rack H and the rack lever H' which are shown in this patent and used to regulate the depth of the furrow would hold the plow-beam rigidly and prevent it from being raised when the foot lever C' was operated. An inspection of the patent shows this was a mistake. The teeth of the rack H are so made as to prevent the plow-beam from descending, but they *do not prevent it from rising.*

See figure 2, folio 315, and specifications top of page 161.

Again the lever H' is made for the express purpose of raising the point of the plow-beam, and may be operated at the same time with the foot lever C'. It follows that there is nothing to prevent the point of the plow from first rising and that to any desired height, while an examination of Starling's specifications shows that his plow-beam *was* prevented from rising beyond a fixed point by the fact that the rear end of the jointed foot lever U V was so made that it struck against a stop W attached to the rear part of the tongue I, and of course as soon as it struck that stop neither point of plow nor lever-beam could rise higher.

Starling says too: "The jointed lever U V enables the driver with his foot to hold or *lock* the forward end of the plow-beam *down*, or to raise it as may be desired."

Folio 300.

It is plain then that Starling's construction provided a jointed lever upon the end of the plow-beam operated by his foot, by which he could *raise*, *lower* and *lock* the forward end of the plow-beam within certain limits, but he could not raise it above the point where the rear end of the jointed lever struck the stop.

The Worrel and Rynerson construction provided for the raising and lowering of the plow beam by the operation of a *hand lever* thereon, but there was no limit to the power to raise the forward end of the plow beam, nor was it ever locked or fastened down.

It conclusively follows that if the Starling patent did not prevent the point of the plow from turning upwards, because he could so operate his foot lever as to raise the forward end of the plow-beam to a limited extent, the Worrell and Rynerson construction did not, since the forward end of the plow-beam was not locked down at all, and if it were by the operation of the hand lever H' it could be raised or lowered.

Now inasmuch as the forward end of the plow-beam was not fastened down at all in the Worrell and Rynerson construction, and inasmuch as the point of attachment of the plow-beam to the crank bar or transverse bar D, is such that the greatest weight of the plow is far in the rear of its attachment, the forward end of the plow-beam will first rise when the lever C' is operated, and this will tilt up the point of the plow so that the horses will assist in raising it out of the ground.

Folios 88, 99, 123, 139, 140, 180, 181, 182.

Even the defendant in error and his expert are forced to admit that the elements of Starling's first claim are found in this patent, and that when both hand and foot lever are operated these elements will perform the same functions as in Starling's construction.

Folios 258, 212.

Yet it is certainly true that if as is stated may be done in the specifications of Starling, the driver with his foot and the use of the jointed lever U V has locked the forward end of the plow-beam down (folio 300) in the operation of the Starling plow, it would be necessary to unlock or raise the forward end of the plow-beam by the operation of Starling's foot lever, before the operation of his hand lever could tilt up the point of the plow. How then can it be that Worrell and Rynerson's patent does not anticitate Starling's?

2nd. But whether the operation of the lever would tilt up the point of the plow or not—it is certain that its operation is such that the horses are made to raise the plow out of the ground.

The trend of the crank bar or bail is upward and backward from the line of draft, and as the transverse bar to which the plow-beam is attached rises—the horses advancing must draw or turn the bar or bail and with it the plow upward and forward, and thus assist in raising the plow out of the ground.

Figure 1, folios 316: 98: 101: 140: 181.

This was the function Starling was trying to secure. Folio 70, Transcript.

Now we insist that it makes no difference in what way the horses are made to assist in raising the plow out of the ground by the operation of the combination of elements described in Starling's first claim.

If by the operation of those elements in the Worrel and Rynerson patent the horses are made to raise the plow out of the ground by raising the heel at the same time or before the point, the function specified in Starling's claim is performed, and inasmuch as the elements are the same, the combination the same and the function performed the same, and Starling has not specified in his claim how the plow shall tilt while the function is being performed and has not patented or claimed the tilting of the point and could not under the law have patented that claim if he had made it, we insist that his first claim would be anticipated here, whether the point of the plow tilted up or down.

Hay and Freeman's Patent, No. 116,956, dated July 11, 1871, (folios 302–305.)

In the construction shown in this patent the plow frames rest upon the main axle when the plows are in the ground, and the crank-bar, axle, curved lever and frame are shown in substantially the same relation and performing the same function as in Starling's first claim.

As the frame of the plows rests upon the main axle, the height of the wheels determines the depth of the furrow. Judge Nelson, among other things, says of the device:

"By a locking device the lever will hold the wheels at any height desired. This device is to regulate the depth of the furrow put out. * * * There is no mode of locking by the lever in the ground at any required depth or raising the point of the plow by the lever and locking so that the horses can pull it out of the ground."

We submit:

1st. That as the frame and plows rested upon the main axle their weight would keep them resting there, and a lock-

ing device that fixed the height of the wheels practically locked the plows at the desired height in the ground.

2nd. As the crank-bar or bail trends upward and backward, the draft of the horses would as it arose pull it over forward, and thus must assist in raising the plows out of the ground, and thus the function specified by Starling would be performed.

Folios 302: 137: 179: 256: 97: 136–139: 178–180.

3rd. There is no device in Starling's patent for raising the point of the plow and locking so that the horses can pull it out of the ground.

There are no notches on the curved bar, M, at the intermediate points where the lever must be as the plow is rising out of the ground, as we have shown.

Folio 299.

Nor could the lever be locked in such a position, because as the plow comes out of the ground the lever must steadily and correspondingly move forward along the curved bar. To lock it there would be to stop the plow from coming out or to take the sulky off the ground.

Charles N. Owen's Patent, No. 123,505, dated Feb. 5, 1872,
(folios 305–308.)

The device shown in this patent is a combination of the elements in Starling's first claim and accomplishes the same purpose, to-wit, that of enabling the horses to pull the plow out of the ground. It also shows a device for locking or holding the plow in any desired position after it has been raised out of the ground.

Pages 152, 153, Transcript.

The patent and specifications also show a treadle bar sliding in a slot cut in the tongue, secured by a pin passing

through any one of a series of holes in the bar and above the tongue for the purpose of preventing the treadle from falling through. The treadle bar terminates in a T-piece which rests upon the plow-beam and beneath the tongue, and upon the treadle bar a sliding sleeve stop is shown which may be secured by a set-screw to prevent the plow-beam from being drawn out of the ground in operation.

It is proved and found by the court that the elements of Starling's first claim are found in this patent, and that by the operation of the lever the horses are made to aid in raising the plow, but Judge Nelson declares that it does not anticipate Starling's first claim because "the plow can be held in a certain elevated position but not locked in the ground. Neither will the lever raise the point of the plow out of the ground, and the front device running through the tongue will prevent the tilting of the point of the plow when raising it out of the ground."

It was claimed that unless the slide sleeve stop was rigidly fastened upon the treadle bar so that in plowing it would rest against the under side of the tongue—the plow would pull out of the ground, and that as the stop must always be pressing against the tongue in operation—the point of the plow would not tilt up when the lever was operated.

1st. We think this claim is unfounded, and if so, then the stop may be secured a few inches below the tongue or not secured at all, and then as the lever operates the point of the plow will rise first.

Folios, 123: 141–2.

2nd. If however the claim is well founded, the Starling plow and the Berthiaume plow must have their beams fastened down in operation, and the Berthiaume plow whose plow-beam is fastened down by a T and spiral spring on the

treadle bar, would not tilt its point up when raised and thus would not infringe Starling's claim.

Page 164 Transcript; lower figure 3, folio 318.

3rd. But whether the plow point would tilt up or not, the draft of the horses acting upon the bail or crank bar as it comes above the pivotal point would draw the bail forward and upward and thus assist in raising the plow out of the ground.

Folios 99: 101: 102: 103: 141–2: 264–5.

Charles N. Owen's Patent, No. 132,772, Nov. 5, 1872,
(folios 308–311.)

This patent shows the same devices as the one last named and a device connected with the lever for locking the plow at any desired height in or out of the ground.

This and the preceding patent fully and clearly anticipate the interpolated claim of a locking lever which seems to have influenced the court below.

Notice the description of the locking device at the middle of page 152, the third claim at the middle of page 153, Transcript, and the statement in folio 309, after the description of the locking device, as follows: "In plowing ground having a very smooth surface, it is sometimes found advantageous to lock the plow at such height as shall insure a proper depth of furrow, thus relieving the sole of much friction and materially lessening the draft."

We respectfully submit that these devices, descriptions and claim would have anticipated any locking device that Starling could have described or claimed if he had claimed such an invention in his patent.

Folios 112–114: 143–4.

The only ground on which the judge below escaped from this patent was that the point of the plow was not tilted up

when the plow was raised out of the ground by the aid of the horses as they drew the bail or crank bar upward and forward.

We think we have shown that this position is untenable.

Folios 105: 123: 142–3.

William Haslup's Patent, No. 127,878, June 11, 1872,
(folios 323–325.)

This patent shows the same combination of elements performing the same function as those in Starling's first claim.

In operating this device the point of the plow will tilt up and is indeed so shown in the drawing. (Fig. 1, folio 323.)

The only objection of the court below to this patent seems to be that the driver cannot regulate the depth to be plowed, and lock the plow in the ground while it is in motion.

Folio 53.

We have discussed that position. We find no such claim in Starling's patent.

THIRD ERROR ASSIGNED.

The course of the trial was such that the defendant in error introduced in evidence his contract and patent, and he and his expert, Mr. Gunckel, testified that the Berthiaume plow infringed his patent, and rested.

Plaintiff in error then introduced in evidence the anticipating patents and the testimony of his experts to the general proposition that in their opinion these patents anticipated Mr. Starling's.

Defendant in error then put in evidence his own testimony and that of Mr. Gunckel to the effect that none of these patents described any device which enabled the operator to lock the plow at any desired depth in the ground, or to tilt up the point of the plow in the operation of raising it, and that for these reasons the patents we had introduced did not anticipate Starling's, and rested.

Plaintiff in error then offered to show in rebuttal by Messrs. Woodward, Haupt and Harris that in the Hay and Freeman patent, the Worrell and Rynerson patent, and the two Owen patents there were devices shown which enabled the operator to lock the plow at any desired depth in the ground, and to tilt up the point of the plow so that the horses would assist in raising it out of the ground.

Folios 281–3.

These claimed points of difference, the locking device and the tilting point, were not elaborated by defendant in error until after the plaintiff in error had rested.

Folios 206: 208: 211: 212: 220: 22: 279.

We respectfully submit that as this was new testimony, and to a new claim regarding the anticipating that plaintiff in error did not and could not anticipate, he had the right to meet and explain it with his witnesses, and the court erred in refusing to permit him to do so.

FOURTH ERROR ASSIGNED.

In the course of the trial the defendant in error introduced evidence tending to show that sulky plows, well made according to the sample which had been made by the Princeton Manufacturing Company and sent by defendant in error to the plaintiff in error would be, and the plows so made by the Princeton Manufacturing Company were practical, operative and successful plows, and gave the best satisfaction to purchasers, and the plaintiff in error had introduced evidence that it constructed its Starling plows according to said sample, and constructed them well, but that they were unsalable and worthless, while the Berthiaume and Harris plows were practicable and salable—thereupon the court below refused to permit the plaintiff in error to show by the witness Carter, who was a practical dealer in plows, that at Princeton, Illinois, in 1879, he made and sold the Berthiaume plows at the price of $45 each, in competition with the Starling plows at a price of $25, and was able to sell his plows without difficulty, while the Starling plows had no sale.

Folio 281, Transcript.

One of the issues in this case was whether the Starling sulky was a salable, practical or operative plow; this issue the defendant in error produced his testimony upon.

Folios 287: 18.

Certainly the testimony of Mr. Carter that it was not salable, that the Berthiaume plow sold for $45 in the open market at the home of the Starling when that plow could find no sale at $25, was competent evidence as to the salability and practicability of the Starling plow, and it should have been received.

FIFTH ERROR ASSIGNED.

After defendant in error had introduced his patents and expert testimony thereon and rested, and the plaintiff in error had put in evidence his patents and evidence concerning them and had rested, the court below, over the objection of plaintiff in error that such evidence was immaterial and a part of the case in chief of defendant in error, allowed him to testify that he first constructed a plow containing the elements of his first claim in the winter of 1871–2 and before the first Owen patent, which was dated Feb. 5th, 1872.

Folio 281.

Mr. Starling's patent is dated August 18th, 1874. There is no allegation of any earlier invention, no evidence or claim of it in his case in chief—and it was certainly properly part of that case—and at the close of the trial, when it was too late for plaintiff in error to meet or rebut it, it was not material testimony under the pleadings and not proper rebuttal. It was error to receive it.

SIXTH ERROR ASSIGNED.

Although the court below permitted the defendant in error to testify in rebuttal at the close of the trial, that he made his invention three and one half years before his patent is dated—it refused to permit the plaintiff in error to prove by competent testimony that the lever device shown in the Starling patent and substantially the same as shown in the Starling model was in common use in this country on

the Deere sulky plow and the Buford sulky plow prior to 1872.

Folios 20, 12: 13.

It was certainly competent to prove that this device had been in public use more than two years prior to Starling's application for his patent, for this was one of the issues the defendant in error tendered.

How was it competent for Mr. Starling on rebuttal, without pleading or notice, to swear back the date of his invention two years and a half before the date of his patent, and not competent for the witnesses of plaintiff in error to testify that this device had been in public use more than two years before the application for a patent, when this was pleaded and an issue made up upon it?

We ask that the judgment be reversed.

St. Paul, February 10th, 1891.

WALTER H. SANBORN,
Attorney for Plaintiff in Error.

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SUPREME COURT OF THE UNITED STATES.

OCTOBER TERM, A. D. 1890.

NO. 329.

THE ST. PAUL PLOW WORKS,
Plaintiff in Error,

vs.

WILLIAM STARLING,
Defendant in Error.

BRIEF FOR PLAINTIFF IN ERROR.

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In presenting an additional brief in this cause, it is not deemed essential to add to that which has already been presented in respect to several of the errors assigned.

This brief will be addressed mainly to the consideration of the true construction of the patent sued on; the prior art, and infringement. This discussion will arise mainly under the consideration of the sixth, seventh, eighth, ninth, tenth, eleventh, twelfth, thirteenth and nineteenth errors assigned, which are set forth at length in the record, commencing page 168, and also partly in the brief heretofore filed by Walter H. Sanborn, Esq., commencing on page 9.

The errors are assigned in the order in which the record shows them to occur, but it will conduce to clearness and conciseness to consider them otherwise than in their numerical order, therefore, those relating to the patent and to the prior art will be taken up after first considering the right to have these questions considered.

The questions of the validity of the patent under the showing of the prior art and of infringement, was raised in the pleadings and issue was joined thereon, p. 15, f. 34.

Curtis, sec. 215, states the rule, that *if the party joined issue* upon allegations made contrary to the demands in the license, intead of pleading an estoppel, *the license is not conclusive.* Issue has been joined upon all the allegations of the answer or pleas, and upon the issues thus tendered the defendant in error cannot plead an estoppel. The issues are sufficient to open out the case so as to let in all that the plaintiff in error has proved, and to let in the prior art upon the validity of the patent, as well as to give a standing for the presentation of such law questions on the validity of the patent as may arise.

While agreeing that the license was duly revoked, yet, if the license shall be considered as a valid and subsisting one, even then these questions may be considered, as the scope of the patent may be contested, and the fact of non-user of the patent may as well be considered and shown under the head of non-infringement, as under non-user, for the outcome is the same.

The law in relation to this subject is:

That unless by reason of the recitals of the license itself, the licensee is not estopped from denying the validity of the patents. *National Mfg. Co.* v. *Meyers*, 7 F. R. 355.

That no license is an estoppel on the defendant to deny infringement. *Blatherwick* v. *Carey*, 10 Biss.

Judge LOWELL, in *White* v. *Lee*, 14 F. R. 790, says: "I intimated on a former occasion that the stipulation not "to contest the fact of infringement was insensible and "repugnant, inasmuch as the agreement is only to pay for "*such as embody the invention* or some material part "thereof." Use is infringement, and infringement is by using, making or selling.

An agreement in a license to pay *on all* machines made, is only an agreement to pay *on such as are made according to the patent*. *Goucher* v. *Clayton*, 13 L. T. Rep., N. S. 115.

That a licensee *may stop payment* and dispute the patentee's right. *Nielson* v. *Fothergill*, 1 Web. P. C. 290.

A licensee who is not at liberty to dispute the validity of a patent, can be allowed to show that his machines do not embody the principle of the patent. *Crossley* v. *Dixon*, 10 H. L. Cases, 293.

Where a defendant is not at liberty to dispute the validity of a patent, he may insist upon its *true construction*. *Trotman* v. *Wood*, 16 C. B., N. S. 479.

Subsisting License.—While a licensee cannot dispute the patent so long as he holds the license, he may show that what he has done *does not fall within the limit or scope of the patent*, and for that purpose he may put prior publications in evidence to assist in construing the patent. *Clark* v. *Adie* (H. L.), L. R. 2 App. Cas. 423.

Plows are of very ancient origin.—The mold-board plow is descended from the old Chinese and Roman plows, which have been largely improved, while the single and double shovel plows of to-day are substantially the same as the old Greek plow. Wheeled plows are also old. An

old Saxon plow of the fifteenth century would be considered a fair sulky plow at this time.

The modern plow is subdivided into numerous classes, and the ones involved in the consideration of this suit are commonly known as hand plows, traveling plows or swing plows; hand plows with sulky attachments, which are common traveling plows, over which wheels and an axle are provided which carry a guide pole or tongue for the team and a seat for the driver. In this class of plows the team is hitched to a clevis at the front end of the plow beam, and the carriage is pushed along over the ground by its connection with the plow beam. These plows are frequently but improperly called sulky plows.

Sulky plows are those where the draft of the team is upon the carriage itself and the plow is drawn by the carriage.

Power lift plows may be either plows with the sulky or riding attachment, or true sulky plows, and they get their name from an attachment between the plow and the furrow wheel by which the draft of the team acting upon the furrow wheel will not only run the plow out of the ground, but lift it above the ground without any lifting being performed by the driver or operator.

Hand or traveling plows are several times referred to in the record, but are not shown. They are within common knowledge.

Hand plows with sulky or riding attachments are shown in the following exhibits:

Owen, February 6, 1872, and November 5, 1872; Worrell, Harrison, Worrell & Rynerson, Starling, and Berthiaume, Hay & Freeman show a true sulky plow, and Harrison's plow also belongs to the class known as power lifts.

While classification has little to do with the administration of patent law, as "analagous use" cannot be disposed of in this manner, yet it is sometimes important in order to get a correct understanding of the matter in controversy.

The patented plow belongs to the class of hand plows with a sulky or riding attachment, and the devices in controversy are those which relate to running the plow out of the ground, and incidentally to lifting it above the ground.

Beside the features consisting of the old four elements claimed by Starling for raising the plow out of the ground (the only known method for a plow having a sulky or riding attachment), nearly if not quite all of these plows contain devices for adjusting the running depth of the plow and leveling it when adjusted.

These appliances are necessary for the reason that in going around the field or a "land" for the first time, there is no furrow for the furrow wheel to run in; consequently the axle is adjusted down at both ends so as to lower the plow below the position in which it will run after a furrow has been made. When the first furrow has been made, the plow is then readjusted at the wheels or the axle ends, so that the furrow wheel will travel on a lower plane than the land wheel. The plow is accordingly readjusted, and the depth to which the plow is to run is adjusted on the furrow wheel side; and, therefore, these devices are commonly known as the gauging devices. It is also important that the bottom or sole of the plow runs level, and this leveling is by an axle adjustment at the land-wheel side, so that the devices on this side of the plow are usually called levelers.

It will be noticed that all of the plows involved in this suit have both gauging and leveling devices.

Starling uses a thin spring lever, and it should be borne in mind that there is a wide difference between a spring lever, and a stiff lever with a spring dog or a weighted dog, and that they are not recognized in the art as the same lever. The spring lever is necessarily light and thin so that it can be bodily sprung out of a notch, while the lever with a dog may be heavy and strong.

VI.

In the consideration of this and the following errors which relate to the patent, and to the state of the art, the true construction of the patent sued on is necessarily involved, and will be here considered for this assignment of error as well as for the 7th, 8th, 9th, 10th, 11th and 12th.

Starling's first claim.—The first claim is as follows: "The crank-bar K, combined with the plow beam N, "lever L, and axle A, as and for the purpose set forth, so "that the horses are made to raise the plow out of "the ground."

From the testimony hereinafter cited, it will be seen that the manner in which the horses are made to "raise" the plow out of the ground, or rather to *run it out*, is by lifting the front end of the plow-beam and thereby elevating the plow point, so that as the team advances the upward running of the plow will bring it to the surface of the ground.

The specification is utterly silent on this matter, as the manner of running it out of the ground is nowhere mentioned except in the claim itself. The proof is that the only way in which the team can aid in running the plow out of the ground is by lifting the front end of the plow-beam by the lever and crank-bar (commonly called the bail), which is accomplished in hand-plows by bearing

down on the handles and thereby elevating the point of the plow-share so that the progress of the team will run the plow to the surface as before stated.

It will be seen that in raising the plow in this manner, the raising is by *a progressive and continuous shifting of the lever*, and a continuous upward progression of the plow; also, that if the plow was locked at any point between the two extremes, the plow would take a new position and run on a new level from such readjusted place, without coming to the surface of the ground at all.

It is at this point that the court below made its first serious error, and the one which is really the foundation of all of the others.

In considering the opinion of the court, the one commencing on page 14 is referred to, as that appears to be revised from the one commencing on page 140. On page 15 the court says: "The first claim is for the combi-"nation of the crank-bar, lever, plow-beam and axle, for "the purposes set forth, so as to enable the horses to pull "the plow out of the ground. *This is done by the adjust-"ment of the lever in the notches of the curved bar.*"

From this it will be seen that the court has carried into the claim the segmental notched bar, marked M in the drawing of the Starling patent, by intendment, for this curved notched-bar is not an element of Starling's first claim.

That this notched bar or segmental rack was not intended to be considered as an element of the claim is evident from the patent itself and from the proofs:

First—Because the raising or running of the plow out of the ground by the horses is a continuously progressing upward movement of the plow and a continuous forward movement of the lever. Therefore, the use of the

notched bar, instead of producing the stated purpose of the claim, *would absolutely defeat it.*

Second—Because the plow *cannot be raised* or run out of the ground *when the lever is held in any one of the notches.*

Third—Because it is contrary to the patent itself, which says, the "lever, L, which projects upward along a "curved bar, M, attached to the axle A and brace J, and in "the outer side of the rear part and in the extreme forward "part of which are formed notches to receive the lever L, "*and hold it in any position into which it may be adjusted.*"

This is the entire description, and the stated purpose of the notches is to hold the lever in the notch in which it may be placed, and when so held the lever prevents the plow from being raised at all, and the plow takes a new adjustment.

For these reasons it is clear that the notched bar was never intended to be included as an element of the claim, as *its use during this operation defeats the stated purpose of the claim.*

The rule of construction is well stated by this court, in *Howe Machine Co.* v. *National Needle Co.*, 134 U. S., page 394, as follows: "Doubtless a claim is to be con-"strued in connection with the explanation contained in "the specification and it may be so drawn as in effect to "make the specification an essential part of it; but since the "inventor must particularly specify and point out the part, "improvement or combination which he claims as his own "invention or discovery, the specification and drawings are "usually looked at only for the purpose of better under-"standing the meaning of the claim, and certainly *not* "*for the purpose of changing it and making it different from* "*what it is.* As remarked by Mr. Justice BRADLEY, in

" *White* v. *Dunbar*, 119 U. S. 47, 52: 'The claim is a " statutory requirement, prescribed for the very purpose " of making the patentee define precisely what his invention " is; and it is unjust to the public, as well as an evasion of " the law, to construe it in a manner different from the " plain import of its terms.' "

From this it will be seen that the court below erred in law as well as in fact in bringing the notched bar into the claim as an additional element thereof.

This fundamental error in the construction of the Starling patent is the main cause or foundation of the other errors relating to the prior art, as it will be seen when the older patents are separately considered, that the court held them not to anticipate, because these prior patents did not contain notched bars. If the other patents in so old an art did not contain the notched bar, that fact should have instructed the court that a notched bar was not an essential feature in any plow, and that its omission from Starling's first claim was not accidental; but even if it was accidentally omitted, the courts have no power to so re-issue a combination claim as to make it a claim for the combination of *five* elements, when the claim itself is for *four* only.

Burns v. *Meyer*, 100 U. S. 672.
R. R. Co. v. *Mellon*, 104 U. S. 118.

The court could not lawfully say that a prior patent did not anticipate the patent in suit because it *lacked* the element of the combination *which the court itself had added to the claim;* yet it was for this reason mainly that the court found that the older patents did not anticipate the combination of Starling's first claim.

Raising plow points.—*Woodward*, p. 59: " *The Court* —How, in an ordinary traveling plow, would the plow-

man raise the point of the plow to get it out of the ground? Do not the horses aid in getting it out? He depresses the handles and that raises the point, and do not the horses aid in raising the point out of the ground? A.—Yes, sir.

"*The Court*—Q.—Does this not do the same thing? (The Owen.) A.—No, sir. It raises the back end the first.

"*The Court*—Q.—When you raise the plow do not the horses aid you in this manner (indicating)? A.—Yes, sir.

"Q.—If that be so the arrangement in the Owen and in the Worrell & Rynerson lifts the point of the plow in the same manner? A.—Yes, sir. I think so; *precisely the same. The lightest part of the plow is forward.*"

P. 67, *Haupt:* "Q.—Does it (Worrell & Rynerson drawing) show distinctly that according to the way the bail is attached to the plow beam that the weight of the plow-beam—and principal part of it—is in the rear of the place where it is attached to the beam? A.—In this particular drawing that is not clearly shown, but unquestionably the raising of that plow beam by means of that lever would have tendency to raise the entire plow, and such an arrangement would raise the point of the plow as well as the rear part, and, the rear part being heavier, *the tendency would be to tip up the point of the plow unquestionably.*"

P. 87, *Harris:* "Q.—It is claimed in this plow of Starling's that the operation of that combination is to raise the point of the plow before the rear parts of the plow were constructed like that in the drawing of the Hay & Freeman patent. Would the raising of the plow by that device have the same effect? A.—*Just the same.*"

In order that a plow run with the least friction, it is adjusted *by the clevis* at the front end of the beam, so that it will find its own neutral or balanced line independently of the wheels, and the plow works heavily and badly until it takes its own level.

That the proper adjustment is by the clevis, will be seen from the following:

Clevis Adjustment.—Gunckel, p. 118. "Q.—Isn't it a matter of practical experience that a walking plow is so set that it will run about the proper depth without extraordinary exertion of the man who holds the handles, so that all the man has to do is to keep it in position standing up and keep it from turning over to one side or the other? A.—Yes, sir; after it is once placed at the depth it is desired to put it in.

"Q.—Isn't it a fact that a sulky plow should be constructed to run in the same manner ordinarily? A.—Yes, sir.

"Q.—Then, that being true, isn't it true that the drawing down of the point of the plow as it stands, if properly constructed, will take it to its ordinary depth? A.—It should do so."

Gunckel, p. 118, 119. "Q.—Doesn't the fastening of the forward end of the beam at any given height either in a walking or sulky plow determine the depth of the furrow? A.—I understand that is determined by the adjustment of the clevis or by means of a furrow wheel."

Starling, page 128. "Q.—Would the draft down here upon that part of the beam be so as to make it difficult or easy to operate that hand device? A.—It must be very difficult to do so, for the reason that with a walking plow you regulate the depth of the plow or the depth of the furrow by changing this clevis up and down."

Starling, pages 135, 136. "Q.—In point of fact, how would this plow (Owen second patent) operate if there were nothing here to control the operation of the plow beam?—How, in practical plowing, if you were to take away the device for determining the direction of the plow beam—how would it operate? A.—It would operate very much as a walking plow would operate in the absence of the operator to throw it onto the beam or share."

Raising the plow by the team.—That the method of running the plow out of the ground by tilting up the front end of the beam, and thereby tilting up the plow point so that the plow will run to the surface is very old, appears from the following:

Woodward, page 59, f. 122. "*The Court*—How, in an ordinary traveling plow, would the plowman raise the point of the plow to get it out of the ground? Do not the horses aid in getting it out? He depresses the handles and that raises the point, and do not the horses aid in raising the point out of the ground? A.—Yes, sir."

F. 123. "*The Court*—When you raise the plow do not the horses aid you in this manner (indicating)? A.—Yes, sir."

"Q.—If that be so, the arrangement in the Owen and in the Worrell & Rynerson lifts the point of the plow in the same manner? A.—Yes, sir; I think so; precisely the same. *The highest part of the plow is forward.*"

Depressing the plow point. Starling, p. 33. "Q.—Do you claim in that patent that you discovered and invented the lowering of the beam of the plow as a method of getting it into the ground? A.—I invented that jointed foot lever."

The Court, p. 33.—"You don't mean to say that the lowering of the point of the plow in order to get it into the ground was not known before that machine of yours? A man with an ordinary traveling plow raises the handles so as to get the point of the plow into the ground. A.—I meant that I invented the device in my plow by which that device is reached." (The device here referred to is the toggle lever of the second claim.)

Gunckel, p. 41. "Q.—Isn't the method of depressing the plow point for putting it into the ground *a method that has been used from time immemorial?* A.—Yes, sir."

Prior Art.—On page 16, referring to the Hay & Freeman patent, the court says: "There is no mode of "*locking* by the lever the plow in the ground at any "required depth or raising the point of the plow by the "lever and *locking so that the horses can pull it out of the* "*ground.*"

We have already seen that it is absolutely impossible to raise the point of the plow by the lever when it is locked or in a notch, and impossible for the horses to pull the plow out of the ground so long as the lever remains in

a notch; so that if this patent had in fact contained the provision which the court failed to find therein, it could not have anticipated the claim, but not having these notches, it necessarily has the operation called for by the Starling claim and by devices substantially the same in construction and the same in combination.

The patent, page 148, shows the combination of a crank bar combined with a plow-beam, a lever and an axle so arranged that the horses are made to raise the plow out of the ground, the same as in the Starling patent.

The only way in which Starling obtains this operation is by having the crank-bar or bail so hitched to the plow-beam that the heaviest part is behind the bail attachment. This is emphatically the Hay & Freeman construction, and when the operator applies power to the lever, the front end, *being the lightest*, raises, and lifts the plow points so that the plows run themselves out of the ground, and when run out of the ground, a further continuation of the lever movement lifts them above the ground.

There are only *two known ways* of running plows out of the ground. One is to tip them so that they will run out sideways, as is a common practice with hand plows, but which is impossible with wheeled plows; therefore *the only known way left* is to elevate the point so that the plow will run itself out as the team advances. A wheeled plow which does not contain this provision is a defective and practically inoperative plow, because, in addition to the overweighting at the rear by the plow itself, there is the additional weight of the furrow-slice when the plow is in actual operation.

The only way in which Hay & Freeman can get their plows out of the ground is by lifting the points and utiliz-

ing the progression of the plow for running them to the surface.

We have already seen that Hay & Freeman use the same four elements called for by Starling's first claim for producing the identical purpose called for by the claim, and, in fact, this operation was so well understood among plow-makers that *Starling, himself, in his specification, did not deem it necessary to even refer to it.*

Starling's expert, Gunckel, p. 102, thinks that the Hay & Freeman plow does not have this well-known operation, because of a guide connected with the foot-board of their plow. If he had read their specification with care he would have seen that the plow had no such guide; first, because it is absurd to suppose that such a guide could be attached to an axle pivoted in the hubs of two opposite wheels; second, because the specification itself says: " As the frame F is moved up and down the bolt *g* " slides in the slotted arms *f*, and *the axle A is thereby* " *prevented from turning over*, as it would otherwise be " liable to do." From this it will be seen that this guide can turn with the axle and move up and down with the frame, and that its office is not to hold the frame down but to keep the axle from tipping over. This guide also performs exactly the office or purpose performed by the combination of Starling's second claim, which is that when the forward end of the beam or frame has moved upward to the predetermined limit, its upward motion then ceases and forms a stop so that the heavier rear end can be lifted above the ground after the plow is out of the ground, for without some such provision the forward end of the beam or frame would continue to rise and thus leave the heavier plow dragging along on its heel.

Testimony.—The testimony on this point is as follows:

Woodward, p. 46, f. 97, concerning the Hay & Freeman patent, says: "It contains the same elements combined to produce the same results. The connection between the elements is slightly different. The axle is of a different form, but I find in that patent all the elements of a combination in the first claim of Starling—the crank bar, plow beam, lever and axle.

Q.—"Do you find them used for the same purpose and accomplishing the same results? A.—Yes, sir; substantially."

Haupt, p. 65, f. 136, says: "I find the same elements combined in the same way in the patent of Hay & Freeman, viz., the crank bar K, combined with the plow beam N, lever L, and axle A, and as for the purpose set forth.

Q.—"What is that purpose? A.—The purpose specified is to assist the horses in raising the plow from the ground. That is specified in the Starling case."

P. 67, f. 138, he testifies as follows: "Now, looking at the Starling patent, are there any advantages in its construction over the Hay & Freeman that enable it to get the plow out of the ground. A.—I see none whatever."

Harris, p. 87, f. 178, testifies as follows: "Q.—What is the first claim of Starling? A.—The first claim I can find here is 'the crank bar K, combined with the plow-beam N, lever L, and axle A, as and for the purpose set forth, so that the horses are made to raise the plow out of the ground.' We call that crank bar a bail.

"Q.—Now examine that patent of Hay & Freeman and see whether or not you find the same ingredients and elements combined in the same way and performing the same function in the same way as shown in the Starling first claim? Do you find that shown in the drawings? A.—Yes; I find the same thing here. * * * *

"Q.—It is claimed in this plow of Starling's that the operation of that combination is to raise the point of the plow before the rear parts of the plow were constructed like that in the drawing of the Hay & Freeman patent. Would the raising of the plow by that device have the same effect? A.—Just the same."

Carter, page 100, concerning this Hay & Freeman patent, says in reference to Starling's first claim. "Q.—Do you find the same ingredients and the same elements used in each substantially for the same purpose? A.—I do substantially.

"Q.—Do you find the same in that—the same combination as shown in Starling's first claim? A.—I do substantially."

VII.

In considering the Worrell & Rynerson patent the court, p. 16, says: "*There is no device for locking the plow* "at any required depth and the foot lever, which is an "extension of the yoke or transverse bar, will not raise the "point of the plow." It is here seen that the court below made the same error in regard to this patent that it made in regard to the Hay & Freeman. Starling's hand lever is only an extension of the yoke or bail, the same as the Worrell & Rynerson.

The court, as will be seen, found, as a matter of fact, that the yoke or bail would not raise the point of the plow. The court is certainly mistaken in regard to this feature, as will be seen from an examination of their patent, p. 160. The court fell into this error, partly from understanding that "the draft *is upon the tongue*, to which a curved rack and an elbow lever are pivoted."

The court fell into this error from a misnomer in the specification, which says: "G represents the draft-beam, "to which the curved rack H and double-armed or elbow-"lever H' are pivoted." Draft-beam is a common name for a tongue or pole, and the word is carelessly used, as fully appears from other parts of the specification.

The title of the patent is "Improvement in Sulky Attachments for Plows," and the statements are: "Have "invented a new and valuable improvement *in sulky*

"*attachments for plows.*" Further on they say: "This "invention has the relation to an improved sulky attachment "to plows."

We have already seen that a sulky attachment can only be applied to a plow which is drawn *by the clevis* in the ordinary manner. Any one familiar with plows, when considering the statement that the improvement was in "sulky attachments," would understand that the team was not hitched to the pole, but to the plow beam by a clevis, and they would so particularly understand, in reference to the plow shown in this patent, for the reason that it is absolutely impossible to guide or control a plow which is to be drawn from a point so near the plow itself, as that shown by the bail attachment; also, that it is impossible to draw the plow by the link connection in front, which has its hinged bar attached to the tongue only by a little staple. This front device is for the same purpose as the combination of Starling's second claim, and it has no other use or purpose.

The specification also refers, page 161, for a better understanding of the patent, to patents issued to the same parties July 26, 1870, and March 28, 1871. The last date shows two. These patents are numbered, respectively, 105, 849; 113, 234, and 113, 235. While it is a well-settled rule that when the specification of a patent refers to a prior description, the latter can only be properly understood by referring to such prior description. The record, unfortunately, does not contain these prior patents, but, if the court will refer to them in the Patent Office records, it will see that all three of these prior patents referred to have clevises for hitching the horses to the front end of the plow-beams, and do not hitch to the tongue. The very title of the patent, and the plow shown, however, are

sufficient to show one, at all familiar with the art, that the hitch is to the plow-beam, and could not be to the tongue.

The Worrell & Rynerson patent shows the combination of a crank-bar combined with a plow-beam, a lever for raising the front end of the plow-beam, and an axle, in the same relative position to each other as that shown by Starling, for the identical purpose that Starling has them, and they produce the same result in the same way by the same means, the only difference being the difference between a hand-lever and a foot-lever. It certainly could not amount to a patentable invention to bend up the Worrell & Rynerson lever so as to bring it within reach of the hand; and the very fact that they do not show or use any segmental notched bar shows that they do not regard it as an essential or an important feature, as notched bars or segmental racks are among the commonest known devices.

Testimony.—Referring to the Worrell & Rynerson patent, *Woodward*, p. 47, f. 99, testifies as follows:

"Q.—State whether or not, in your opinion, this answer is a perfect answer to the patent of the Starling—that is, *as* to the first claim of the Starling patent. A.—It contains the same elements precisely, combined to produce the same effect and in the same manner."

Haupt, p. 67, f. 139, testifies as follows: "Q.—Now take the Worrell & Rynerson patent No. 120,560. State whether or not you find the same ingredients or elements combined in the same manner and performing the same functions in the same way as in the Starling combination and for the same purposes. A.—I find the same elements, viz., the axle and crank bar, the lever and plow beam, and they are arranged substantially in the same way and operating in the same way, with the exception that the lever instead of being a hand lever is a foot lever operated by the foot.

"Q.—If that foot lever were turned up at right angles with the extension of the right-hand side of the bail or crank bar and made straight for a hand lever would it

show the exact construction shown in the Starling patent? A.—Yes, sir; I think it would."

Harris, p. 88, f. 179, testifies as follows:

"Q.—Take the next patent, Worrell & Rynerson No. 120,560, and examine that drawing and specification, and state whether or not you find the same elements and ingredients combined in the same manner and performing the same function in the same way as in the combination claimed in the first claim of Starling. A.—I find the bail and axle and beam just the same.

"Q.—And the lever? A.—Yes; it is a foot lever here.

"Q.—And a plow beam? A.—Yes, sir.

"Q.—Attached in the same way substantially? A.—Yes, sir; in the same manner."

He continues, and says that the only difference is the difference between a foot and a hand lever.

On page 92, f. 187, he says: "Q.—Take the Worrell & Rynerson patent No. 120,560, do you find any arrangement for lowering the point of the plow there? A.—Yes, sir; I find a standard in front secured to the plow beam running through the pole and running up into a ratchet that has a similar lever attached to it for to lock it or to raise it up and down, to shove it into the ground and hold it there.

"Q.—In the arrangement to push it down is there anything to fasten it down to any desired point? A.—Yes, sir.

"Q.—Isn't that the same as the Berthiaume has? A.—Yes, sir; it is the same thing."

Starling, page 127, f. 258, testifies as follows: "Q.—Now, as to the Worrell & Rynerson patent, do you find the elements of your first claim or their equivalents present in this patent—that is, the crank bar with the crank bar extended, forming a foot lever, described in the specifications, for the purpose of raising the plow out of the ground? A.—It would perform that function."

VIII.

In regard to the Owen patent, 123,505, of February 6th, 1872, the court says, page 17: "The plow can be "held at a certain elevated position, but not locked in the "ground. Neither will the lever raise the point of the "plow out of the ground, and the front device running "through the tongue will prevent the tilting of the point "of the plow when raising it out of the ground."

Especial attention is called to this plow for the reason that in respect of the parts complained of *it is almost identical with the plows* made by the plaintiff in error.

The patent, p. 150, shows the combination of a crank-bar combined with a plow-beam, a lever, and an axle, so combined that the horses may run the plow out of the ground when the lever is moved. The bail is projected forward so as to form a foot-lever, as most clearly shown in Fig. 2. In addition to this, there is a hand-lever having a segmental rack or cogged wheel at its lower end which gears with a corresponding segmental rack on the crank-bar, so that the operator may use both foot and hand or either in raising the plow out of the ground. The hand-lever has a smaller lever conected with a weighted dog, which takes into and locks with the wheel or segment at the lower end of the hand-lever, so that the hand-lever may be made to engage at any time, or be held out of engagement, so that the plow may be raised entirely by the foot; entirely by the hand, or by the use of both combined. The plow has a hang-up hook, so as to take the weight of the plow off from the levers when it is elevated above the ground.

The court was of the opinion that the bar D', sliding through the tongue and resting loosely upon the front end

of the plow-beam, prevented the front end of the beam from rising so as to tip the plow point up, and thereby utilize the advancing movement of the team for running the plow out of the ground.

We have before seen that this method of getting plows out of the ground is the only one known for this class of plows. This bar drop D' is for the same purpose, and for no other purpose than that of the devices included in Starling's second claim.

Some of the witnesses have endeavored to make it appear that when this plow was in operation the under stop of the bar D' was *against* the tongue or pole; but the drawing shows that the bar rides upon the pin above the pole. *The plow-beam* is not connected to this drop bar, so that the plow-beam could as well run a foot below it as in contact with the cross bar at its lower end when in operation, even if the under stop was against the pole, as it is not, for the drawing shows that between the upper limit pin and the under stop, there is a play equal at least to four times the thickness of the tongue, and besides this, the lower stop is adjustable so that any required play can be obtained.

The operation of this device is specifically that of the Starling foot lever and stop. When power is applied to the lifting lever (either hand or foot) the front end of the beam rises until it comes in contact with the cross plate at the lower end of the drop bar, when the two rise together until the under stop reaches the pole. *This gives a wider range of movement for the front end of the plow beam than is given by Starling*, and when the stop is brought in contact with the pole, the plow cannot do other than run out of the ground by reason of the elevation of the plow point; and when this limit stop reaches the pole, the further

movement of the lever will raise the rear end of the plow *above the ground* exactly as in Starling, and when at its highest point the plow will be caught by the hang up hook, where it will ride until released.

If the Berthiaume and Harris plows *infringe*, this Owen patent *must of necessity anticipate* the Starling patent, for the Berthiaume plow has the same swivel connection with the crank-bar or bail that the Owen has, and also *the identical device* for operating and stopping the front end of the plow-beam, so that it has even the additional features of the plows manufactured by plaintiff in error, as well as those in common with the Starling and the older plows.

The stop of the Starling plow at the front end of the beam is subject to the same criticism as the Owen, with the difference in favor of Owen, as his stop is adjustable, while Starling's is not.

Woodward, after stating the elements of the combination of Starling's first claim, testifies as follows, p. 48, f. 99:

"Q.—Do you find these combined in the same manner as in Starling's patent? A.—Combined in the same manner to produce the same effect, except that the lever, instead of being turned up in the manner of the hand lever, is continued in the same way as a foot lever, operated by being pushed down with the foot instead of being pushed down with the hand." He follows this by quotations from Owen's specification.

P. 49, f. 102. "Q.— * * * What is the difference between the Worrell & Rynerson and the Owen's and the Starling? Will you explain that? A.—The only difference is the continuation of the bail forward in the form of a foot lever in one end, and in the other the same — turned up in the form of a hand lever."

P. 55, f. 114: "My question is whether this method of locking the plow by the device shown here in the C.

N. Owen patent is a well-known equivalent to the ratchet used by Starling. A.—Yes, sir; it is well known to mechanics to use a pinion or segment to change the motion of any two parts."

Haupt, p. 68, f. 141: "Q.—Now take the C. N. Owen patent, No. 123,505, Feb. 6, 1872. I ask you the same question: Do you find in this patent the same ingredients and elements combined in the same way to perform the same function in the same way as in the Starling combination stated in the first claim of his patent? A.—I do; yes, sir."

Harris, p. 89, f. 181, in reference to this patent, says: "A.—There is a ratchet and a foot and a hand lever on this, as near as I can see into it, and a bail. There are two levers, a foot and a hand lever both.

"Q.—Plow beam attached to the bail? A.—Yes, sir; and a dog to catch the plow when it is up.

"Q.—Are those combined in substantially the same manner as in the Starling? A.—Identically the same thing.

"Q.—And to accomplish the same result? A.—Yes, sir."

Starling, p. 131, f. 265, says: "Mr. Owen can raise his plow out of the ground, and by retaining this lever he can hold it and by letting go of the lever it will return to the ground again, but there is no device whereby he fastens the plow in the ground or at any particular position."

It will be seen that Starling has to go back to this adjusting lock to find an excuse for rejecting the Owen as an anticipation of his own patent, which lock, as we have already seen, defeats the stated purpose of Starling's first claim.

On p. 132, f. 268, Starling emphasizes this further, as follows:

"Q.—Do you find the same elements in the Owen first patent combined for the purpose of accomplishing the purposes substantially in the same way as in your first claim. A.—I do not; it lacks a very essential element.

It lacks the element of fastening the plow into any position to which it is desired to adjust it."

Starling thus emphatically rests his sole right to recover as against this Owen patent on the lock, which lock, as has been repeatedly stated, prevents the running of the plow out of the ground by the horses, for so long as the lever is locked into any one of its positions the plow cannot be raised out of the ground.

IX.

Owen second patent, November 5, 1872. This plow in respect to the combination in controversy, is substantially like the older one just considered. It differs mainly in having a forked lateral foot-guide for the front end of the plow beam, and a dog on each side of the toothed wheel attached to the hand lever, so that it can be locked at either limit of movement, and at any intermediate point.

The court, p. 18, says: " The lever used will lock the " plow so as to prevent it from going deeper, but the point " of the plow cannot be raised by the lever."

The patent, p. 154, shows the same arrangement for lifting the front end of the plow-beam first, that the earlier Owen patent and the Starling patent show. It is obvious that if Owen cannot lift the front end of his plow-beam so as to elevate the point, that Starling cannot, for they are organized in this respect exactly alike. Owen's drop bar, marked M in this patent, is both adjustable as to vertical position and as to the amount of play required in the drop-bar to let the front end of the plow-beam move upward. *The under collar forms the limit stop for the upward movement, the same as the stop W does in the Star-*

ling patent, and it has this advantage over Starling, that it is adjustable so that more or less limit may be given for the upward movement of the front end of the plow-beam and tip the plow-point up as the soil or conditions of the plow may require.

Owen says in his specification, p. 155, "M, M' is a "treadle-bar or drop-iron sliding vertically in a slot in the "tongue. The T-piece M' is intended to engage with the "plow-beam and regulate its vertical position, as in my earlier "patent, for which reason it is provided with a sliding stop, "*m*; but in this new treadle-bar one or both of the stops "m' at the end of the T-piece M' are made adjustable, as "it is sometimes convenient to confine the horizontal vibra-"tions of the tongue within narrow limits."

The arrangement for controlling the horizontal movements is shown in detail at Fig. 4, also the adjustable stop *m* and the cross-pin for adjusting and controlling the vertical movement of the beam. The cross bar M' in this patent and the corresponding bar in the older patent is sometimes called by the witnesses the "hyphen bar."

In considering the issues involved, it is not important to consider this feature of the plow further than that it is almost literally copied in the Berthiaume and Harris plows manufactured by the plaintiff in error, and for the further reason that it is by this drop bar having a limited movement (which is the full equivalent of the Starling toggle bar), that the plow can be raised above the ground after it has been run out of the ground by tipping the front end of the beam upwards; and the court below did not fail to find the combination of the crank bar combined with the plow beam, lever and axle, as in the Starling, and it only found that it lacked the feature of lifting the front end of the plow beam by a movement of the hand or foot lever,

and rejected it for this reason alone; but we have already seen that the court was very clearly mistaken in this respect, as is shown by the following testimony:

Woodward, p. 50, f. 105, says: "This, the second patent of Charles N. Owen, as far as its construction is concerned touching this point — it is the same as his first patent. The patent is for some improvements outside of those particular elements I have mentioned. It contains all the elements — the axle, beam, lever, and crank bar — in the same manner as in his first patent.

"Q.—And in the same combination? A.—The same combination accomplishing the same result."

P. 51, f. 105, concerning the various patents set up by the defense, he testifies as follows:

"Q.—What is the function of these various patents you have spoken of with the lever, crank bar, axle, and beam, as you have stated? A.—To elevate the plow from the ground.

"Q.—And in each case *does it elevate the point* before it does the rear; according to the drawing does it necessarily do so? A.—Yes, sir; it would, for the reason that I find the end to which the crank bar is attached to the beam is forward of the mould board or the heavier part of the plow."

On p. 56, f. 117, he says: "The Berthiaume device "is very much more nearly anticipated by the Owen and "Worrell & Rynerson construction than by the Starling."

Haupt, p. 69, f. 142, testifies as follows: "Q.—According to the construction shown in this second patent of Owen, No. 132,772, can or cannot the hand lever alone be operated to raise the plow out of the ground without using the foot lever? A.—Yes, sir.

"Q.—Can the foot lever, which is simply an extension to one side of the bail, be used alone to raise the plow? A.—Yes, sir; because they work independently of each other.

"Q.—And can they both be used together at the same time? A.—Yes, sir."

On the same page, f. 144, concerning this patent, he is asked: "I will ask you the same question as before, whether you find there the same elements as found in the Starling first claim, and combined in the same way and performing the same function in the same way that is described in the Starling patent. A.—Yes, sir; I do.

"Q.—Do you find it to be the mechanical equivalent and combined in the same way as in the Starling first claim? A.—Yes, sir.

"Q.—In your opinion anticipating it fully? A.—Yes, sir."

Harris, p. 89, f. 182, after testifying that the first Owen patent was the same thing as the Starling and accomplished the same result, testified as follows:

"Q.—Look at the next patent, C. N. Owen, 132,772, and state whether the same thing is shown there. A.—Yes, sir; it is an improvement on the other.

"Q.—Is that the same thing, as far as this is concerned? A.—Yes, sir; the same thing."

He goes on then to speak of the hand and foot lever, and agrees with witness Haupt that either or both of the levers may be used to accomplish the result called for by Starling in his first claim.

Concerning the manipulation of the front end of the plow beam, he testifies as follows:

P. 92. "Q.—Look at this C. N. Owen Patent, No. 132,772; do you find a method of depressing the point of the plow shown? A.—Yes, sir; I find a device here that goes through the pole and crosses over the beam the same as the Berthiaume exactly.

"Q.—Used for the same purpose? A.—Yes, sir.

"Q.—And working in substantially *in* the same manner? A.—Yes, sir; just the same. The pin is above the pole on this."

Gunckel, p. 110, f. 223, agrees that the two Owen patents are substantially alike in respect to the matters in controversy.

X.

Harrison.—Concerning this plow, the court, p. 18 says: "This invention has a device attached to the hub of "the right wheel, by means of which the plow is raised out "of the ground by the power of the team, but no hand or "foot lever arrangement for raising the plow out of the "ground."

As before stated, this plow belongs to the class commonly known as "power lift" plows; but, notwithstanding this fact, it is manipulated by a hand lever the same as the Starling, but when the lever is started forward, the continuous movement of the lever is by the power of the team, instead of by the muscular power of the driver or operator.

Some of the witnesses have endeavored to find some mystery in this plow, but its structure and operation are very easily understood by those having any familiarity with this class of plows.

The axle in this patent is in the frame form, having front and rear bars marked *c*. The bail *e* is attached to this frame at the rear, and on the land wheel side has a lever, or, as the patentee calls it, "hand crank arm *l*," firmly attached to the end of the crank bar or bail as in Starling. This lever is provided with a small bell crank lever and link rod, which connects with the lower end of the operating pawl *k*, which pawl is provided with a tooth engaging with the teeth or cogs on the wheel hub.

When the operator desires to lift his plow, he takes hold of the lever *l* and moves it forward, at the same time lifting the lower end of the dog, or pawl, *k*, and throwing it into engagement with the teeth on the hub. As the plow moves forward, the front end of the plow-beam rises until it strikes the front cross-bar, *c*, which inclines the point of

the plow upward. When the plow-beam strikes this cross-bar, the forward motion of the team (if the plow is properly adjusted) takes the exact motion of the upward incline of the plow bottom, and lifts the plow bodily. The hub carries the lever *l* over until it strikes an inclined pin or projection *n*, which gives the hand-lever *l* a lateral movement towards the axle frame, and disengages the dog *k* from the wheel hub, at the same time carrying the lever under a short pin, *i*, where the lever remains until it is disengaged, and the plow is lowered by hand.

From this it will be seen that the Harrison plow has the identical movements of the Starling, with this difference only,—that the progressive forward movement of the lever in raising the plow out of the ground is by the team instead of the hand, while the lowering of the plow to an operative position is by hand, the same as in the Starling.

If there were no teeth on the wheel hub, the Harrison plow would be an operative plow, and its operation would be identical with the Starling. There is no mystery in this plow, and the drawing and specification are amply sufficient to determine its structure and operation.

It is beyond question that this Harrison plow has in it the combination of Starling's first claim, and it answers the stated purpose of the Starling claim better than the Starling plow itself does; for in this case "the horses are in fact made to raise the plow out of the ground."

The record is not very full in respect to this patent.

Starling, p. 137, testifies as follows:

"Do you find any lever for the purpose of raising the plow out of the ground? A.—I see there is a lever there, or a plan to throw the dog or some kind of an arrangement of a ratchet or clutch of some kind; it is not very clear. I have tried to make out what that was, but I can't succeed.

"Q.—It is apparently some kind of an arrangement to make the dog catch under the toothed wheel? A.—Yes, sir; that is the claim; so as to make the horses raise it, I should judge."

XI.

Worrell Patent.—The only objection which the court, p. 18, found to this patent is, "There is no *locking lever* "described in this patent, as in Starling's, and no device "like his for raising the point of the plow or locking the "plow in the ground."

The patent, p. 157, shows a plow much like that shown in the Worrell & Rynerson patent before considered. The principal difference consists in a device attached to the top and rear of the machine, "in order to tilt the plow to the right or left," which is a feature entirely outside of and additional to the subject matter in controversy. This plow has the combination of a crank-bar or bail, combined with a plow-beam, lifting-lever, and an axle, which parts are combined in the same relative position and for accomplishing the same objects or purposes for which they are combined in the Starling patent.

The patent shows the same adjustable drop-bar at the front end of the plow beam that we have before considered, and found to be the full equivalent of Starling's toggle bar for controlling the front end of the plow-beam, and the front end can raise and does raise to tip the plow point so that the plow will run out of the ground, the same as the Starling. The crank-bar or bail (H) is of the full width of the machine, the same as in Starling.

The expert Gunckel, called by defendant in error, page 112, says that this plow has no lifting lever of any kind. He could not have so stated if he had understood the patent or the plow. The specification says: "One arm of the

" frame H projects forward, and is used as *a foot-lever* in " raising the plow." Fig. 2, which is a front view, shows this foot-lever arm extending forward and inclined inward, so as to partly obscure the bail H. It is located as shown on the furrow-wheel side, which is the side cut off in making the longitudinal vertical section shown in Fig. 1.

The plow of this patent, therefore, as before stated, has the four elements of Starling's first claim, combined in the same way and for the same purpose that Starling has them, with the sole exception that the lever extends forward to be used by the foot, instead of upwards to be used by the hand, which difference, as we have already seen, is purely a matter of selection or choice, and does not involve invention.

Starling, p. 136, testifies that according to his understanding the Worrell, and the Worrell & Rynerson, are very much alike, with some improvements added by Worrell.

XII.

This exception relates to the question of infringement by the making and using of the Berthiaume plow, and will be considered further on.

XIII.

Haslup patent.—As this patent came into the case on a motion for rehearing, this court, under its decisions, would not consider it if it stood alone; but as it has been certified up as a part of the main record, and as it is useful in informing the court in regard to the state of the art, it is taken for granted that it will be considered with the others, as the courts are not refusing information in patent causes, which are properly before them.

The patent, p. 165, shows a common plow with a sulky attachment, in which the bail is mounted upon the axle by a sleeve so as to turn thereon by a hand-lever when the plow is to be raised out of the ground by the horses. The court, p. 24, concerning this plow, says: "The plow can be locked in the ground or the depth to "be plowed determined only by inserting a pin in holes "made for that purpose in the circular plate, fastened as "heretofore stated.

"The driver cannot regulate the depth to be plowed and "lock the plow in the ground while it is in motion. The "pin prevents the plow being raised by the lever, and it "could not be operated while in motion so as to raise the "point of the plow and make the horses pull it out of the "ground.

"The Haslup plow does not have the combination of "the plaintiff for the purposes described in the patent, "and does not anticipate his invention."

We have before called attention to the fact that nearly all of these plows have levelers and gauges for adjusting the running depth and the level running of the plows, which are frequently separate and distinct from, and independent of, the lifting lever.

The court fell into the errors above stated in not recognizing the fact that these devices were separate in the Haslup plow. The lever which operates in connection with the pin noticed by the court is the *gauge lever K*, and is not the *lifting lever O*. This Haslup plow has a disk somewhat similar to the Starling disk, and the running depth of the plow is gauged by a pin inserted in the side of the disk, which is fast to the axle; and what the court says is regard to the locking of the plow or determining its running depth by inserting a pin in holes made for

that purpose in the circular plate, is correct *for the lever K*, which is the gauge lever, and has nothing to do with lifting the plow.

The lifting lever O, which is located on the opposite side of the disk, has a spring dog which connects with teeth on the periphery or edge of the same disk, so that it is wholly independent of the gauge lever; and while the running depth is to be determined by the gauge lever and pin, the lifting lever O can at all times be operated while the plow is in motion, so as to raise the point of the plow and make the horses pull it out of the ground. This identical operation (which is not mentioned by Starling) is shown by the dotted lines in Fig. 1 of this Haslup patent, which *shows the point of the plow elevated*, so that it must of necessity run out of the ground; and it also shows it in the position of dragging on its heel, as the Starling will drag, until the upward movement of the front end of the beam is arrested by a stop. In Starling, this is the stop W, and in Haslup it is the stop R, which is best shown in Figs. 2 and 3. The specification states, p. 166, that "The front end of the plow-beam is held by a brace, R, "as shown in dotted lines, which is made adjustable by "means of a slot-hole in the bottom hound-cap C, and "fastened by a set-screw, *m*."

Concerning the gauge lever K and its operation, the specification says: "This" (raising or lowering the wheel) "is effected by means of the lever K attached to the arm "and connected with the stud by a rod, *e*. *The wheel* by "this means *is raised or dropped* on the land *to suit the* "*depth to be plowed*, the height being regulated *by a pin* "inserted in holes upon the wheel-arm."

The specification continues, in regard to raising the plow, as follows: "L is a sleeve placed on the axle H be-

"tween hounds G G, and provided with two arms, N N, "projecting toward the rear and pivoted to the plow M. "By revolving this sleeve on the axle these arms are raised "or lowered at will, thus putting the plow in or out of "the ground. The sleeve is turned by means of the "hand-lever O, which is bolted or otherwise affixed to "the sleeve. *By pushing forward on this lever the "plow is raised*, and a trigger, *f*, pivoted to the "lever, drops into a notch on the circular plate, "P, fastened to the hound, and holds the plow while it is "being turned or taken from the field. The depth to be "plowed is regulated by a pin, *h*, and pin-holes in the "circular-plate P."

This depth of plowing, as before seen, is regulated by the lever K and not by the lever O; and the failure to distinguish between these two levers, on opposite sides of the disk, one connected with the side of the plate by a pin and the other with the edge or rim of the plate by teeth, led the court into the errors stated in the opinion.

This Haslup plow has the combination of the four elements called for by the Starling first claim, in the same relation to each other and to the plow that Starling has them, and for the same purposes.

If the court distinguishes between a separate gauge lever and a lifting lever also operating as a gauge lever, then infringement cannot be found, as the machines of the plaintiff in error use these devices separate as in this patent.

XIV.

That this assignment of error is well averred, appears from the fact that the defendant in error, by himself and his expert Gunckel, after the plaintiff in error had made its

defense to the *prima facie* proofs and contentions, radically shifted his grounds of contention, and made a new case by the so-called rebuttal evidence, which the plaintiff in error has not had any opportunity to meet or answer.

This radical and unlawful change appears from the following specimen testimony.

Gunckel, p. 39. " Q.—Do you find in this combination any locking lever or any method of a locking lever in the combination claimed by Mr. Starling in his first claim? A.—*I do not find* set out specially *in the claim a device by which the lever is locked.* I find the lever L referred to, which in the specification is described as a lever which is locked for the purpose *of adjusting the plow.*

" Q.—You do not find he claims any combination of that lever with any arrangement to lock it? A.—Not as a specific claim; no, sir.

" Q.—Then, if this be a combination, it is not a combination of an arrangement to lock the plow with the lever or with any other parts. A.—Not specifically; no, sir."

This witness, finding that the foregoing exploitation of the claim (the true one) was fully met in the prior art shown, in his rebutting testimony makes a radical change of base and a gross error, as will be seen from the following:

Gunckel, pp. 124–5: " Q.—In looking at the Starling patent, what do you understand Mr. Starling has patented in his first claim? A.—A combination of his crank axle with a bail and plow beam and locking lever, *whereby the beam is locked at a certain horizontal plane.*"

If the court had not fallen into the same error it would hardly be necessary to remark that Starling has no such patent.

Starling, in his *prima facie* testimony, p. 31, f. 70, states his understanding of the patents as follows:

"Q.—Explain how in this combination of your first claim the horses are made to raise the plow out of the ground. A.—Moving that lever forward, the point of the plow being raised, the horses continue to move forward, and the effect of it will be to raise the plow out as the line of the plow is directed upward. Not only have you got the horses pulling directly forward, but the bail, being raised up by the lever, consequently the horses are turning that bail upward; so that a person can operate a sulky plow when the horses are moving with a good deal less than half the necessary expenditure of power that would be used if the horses were not moving.

"Q.—By what means is a walking plow drawn out of the ground? A.—By turning the point upward by pressing upon the handles.

"Q.—Pressing down upon the handles would have what effect upon the plow? A.—It would raise the point.

"Q.—And the horses walking forward would pull the point of the plow out of the ground? A.—Yes, sir.

"Q.—State whether or not that performs the same functions as your plow in making the horses raise the plow out of the ground. A.—Yes, sir."

On rebuttal, p. 127, f. 257, he finds that the Hay & Freeman patent does not anticipate his first claim, and says:

"A.—I see no evidence in their drawing and no description of it in the specification by which the plows are *locked or fixed* in their position *in the ground* whatever."

P. 127, f. 258, referring to the Worrell & Rynerson devices, he testifies as follows:

"Q.—Now, as to the Worrell & Rynerson patent, do you find the elements of your first claim or their equivalents present in this patent—that is, the crank bar with the crank bar extended, forming a foot lever, described in the specifications, for the purpose of raising the plow out of the ground? A.—*It would perform that function.*"

"Q.—How about the parts performing the functions which are capable of being performed by the use of the parts which are claimed in your first claim? A.—They cannot be *secured in the ground* by any such means whatever."

P. 131, f. 266, he makes the same objection to the Owen, and thinks it does not anticipate his patent because there is no locking device.

On p. 132, f. 268, he testifies as follows: "Do you "find the same elements in the Owen first patent com- "bined for the purpose of accomplishing the purposes sub- "stantially in the same way as in your first claim? A.—I "do not; *it lacks a very essential element.* It lacks the "element *of fastening the plow* into any position to which "it is desired *to adjust it*," and so on through the list.

The *prima facie* case was entirely made up on the correct construction of the first claim, that the parts named in the claim were so combined that when the driver put them into action so as to raise the plow point, the horses would run the plow out of the ground by their continued progression and the continuing forward motion of the lever which the notches would arrest and defeat if used. Finding that this was one of the commonest expedients in the art, the ground, as before stated, is radically shifted by the so-called rebuttal, and the invention made to consist, not in so combining these parts that the horses could raise the plow out of the ground, but to consist in a segmental notched bar (not mentioned in the claim), combined with the hand lever, so that the plow could be held in adjustment *without being run out of the ground.*

This is a radically different case from that made up by the *prima facie*, and the plaintiff in error certainly should have had an opportunity of meeting this new case, and showing that it was just as untenable as the other. This

the court refused, manifestly in error, and greatly to the prejudice of the plaintiff in error.

Record, p. 139. "After the close of plaintiff's "evidence in rebuttal the defendant now offers to show in "rebuttal of the testimony of plaintiff's witnesses relative to "the anticipating patents by the testimony of the witnesses "Woodward, Haupt and Harris, who were then present in "court, that there is a device in the Hay & Freeman patent "and in the Worrell & Rynerson patent and also in the two "Owen patents by which the operator is enabled to lock "the plow at any desired depth in the ground, and also to "tilt up the point of the plow so that the horses will assist "in raising the plow out of the ground, and that these "several devices consist of the same combinations or a "combination of mechanical equivalents as that shown in "Starling's first claim, and defendant offers to show gen-"erally by the witnesses that the plaintiff's witnesses were "mistaken in their testimony that there were substantial "differences between the plaintiff's combination and its "operation in the first claim and the combinations and "their operations shown in said anticipating (patent).

"The court declined to permit any more testimony "to be introduced upon the subject, stating that he had "heard sufficient testimony to enable him to understand "the action of the several devices."

XVI.

Excluding testimony, p. 101.—"The defendant then "offered to show by witness Harris, that the lever device "shown in the Starling patent, and substantially the same "as that shown in the Starling model, was used on the "Deere sulky plow and the Buford sulky plow prior "to 1872.

"The plaintiff objected to this evidence as incompe-
"tent and immaterial and no statutory notice—objections
"mentioned. Defendant excepts."

It is not deemed to be essential to present this at any considerable length as it is manifest error. See

Vance v. *Campbell*, 1 Black, 427.
Agawam Co. v. *Jordan*, 7 Wall. 583.
Brown v. *Piper*, 91 U S. 187.
Grier v. *Wilt*, 120 U. S. p. 429.

XII.

INFRINGEMENT.

This assignment of error is specifically to the plow of the plaintiff in error, known as the Berthiaume plow. As it appears from the record that this and the Harris plow are substantially alike, the question of infringement may as well be considered as applying to both as to consider them separately.

In considering the patent sued on and the prior art, we have seen that Starling cannot hold any claim for the general combination of a crank-bar combined with a lever, axle and plow-beam, as shown and described in his patent; that if his patent can be sustained at all, it can only be sustained by making his bail and lever substantially integral, by using a wheel-spindle of the axle as a fulcrum for the lever, and not upon the general combination. These differences are not sufficient to maintain the claim as a valid one, or one for a patentable invention or improvement.

The differences between the plow of the Starling patent and those of the older art are specifically the differences between the patent and the plows of the plaintiff in error.

Berthiaume supposed he had made a plow upon a new design; but it will be seen that he was mistaken in this, and that his improvements only relate to constructions of devices which are special to his machine. The Berthiaume patent is shown, page 161, and it does not require one skilled in the art to see at a glance that the Berthiaume plow is the Owen plow. Berthiaume did what many another one has done in attempting to improve a known machine, that is, he simply went back to an older form instead of producing a new one.

If the machines of the plaintiff in error are Owen plows, then the existence or non-existence of the license is unimportant. If they are Owen machines, they are not made under the license. If the license is not in existence as a subsisting one, then if the plows of the plaintiff in error are Owen plows, they cannot infringe the Starling patent.

That the defendant's plows are not Starling plows; that they do not infringe Starling's patent; and that they are, in fact, Owen plows—is fully established by the evidence, part of which is copied, as follows:

Woodward, p. 52, f. 108, referring to the Worrell & Rynerson patent, says: "In that respect it is somewhat similar to the Berthiaume arrangement, except that in the Berthiaume there is no device for locking the lever down. It has an upright bar, with a cross bar at the bottom, resting across the beam and provided with a lever at the top to force it down upon the beam and a lever at the top, being a foot lever instead of a hand lever, as in the Worrell & Rynerson, but the action is precisely the same as far as forcing the beam down or holding it down by the weight of the foot is concerned. I also find in the Owen patent, in both of them, a broad bar, with a cross-bar at the bottom, resting across the forward end of the beam, *constructed precisely as in the Berthiaume* patent, except that they have no hand lever nor spring to assist in raising it

up or down. In the Owen patent the upright bar is shown provided with a series of holes, through which a pin can be inserted to hold it down at any point desired, and also a collar to regulate the height to which the cross-bar can be elevated. It forms a stop to regulate or limit the motion of the bar."

"Q.—Do you find in any of those patents substantially the same mechanical device as used in the Berthiaume plow for this purpose to accomplish the same result and used for the same purposes? A.—The Berthiaume device is a combination of the elements shown in the Worrell & Rynerson and in the Owen's patents, and designed to accomplish precisely the same effect."

On p. 56, f. 117, he says: "The Berthiaume device "is *very much more nearly anticipated by the Owen and* "*Worrell & Rynerson construction than by the Starling.*"

Harris, p. 90, f. 183. "Q.—In connection with their "utility look at the Starling and the Berthiaume plows and "state whether you find the same combinations and ele- "ments in these two plows. A.—They are differently "constructed altogether. The action is different. One is "connected and the other is disconnected with the beam, "and the operation is different."

P. 92, f. 187, referring to the second Owen patent he says: "I find a device here that goes through the pole and crosses over the beam the same as the Berthiaume exactly."

Haupt, p. 73.—"Q.—Look at the Starling device now, that combination for the depression of the point of the plow, and state whether or not, in your opinion, the Berthiaume device for lowering the point of the beam is much more the mechanical equivalent of the device shown in the C. N. Owen's patent No. 132,772 and the Worrell and Rynerson patent No. 120,560, than is the device shown in the Starling second claim? A.—I think it is, without question."

Woodward, p. 52.—" I also find in the Owen patent, in both of them, a broad bar, with a cross-bar at the bottom, resting across the forward end of the beam, constructed precisely as in the Berthiaume patent, except that they have no hand lever nor spring to assist in raising it up or down. In the Owen patent the upright bar is shown provided with a series of holes, through which a pin can be inserted to hold it down at any point desired, and also a collar to regulate the height to which the cross-bar can be elevated. It forms a stop to regulate or limit the motion of the bar."

Woodward, p. 59.—" Q.—Do you notice any difference in the construction of the Starling and of the Berthiaume to the advantage of the Berthiaume? If so, what are they? A.—In the Berthiaume plow the bail is pivoted at a point *below and in the rear* of the line *of the journals of the axle*, a construction possible only on one end in the Starling patent, as his bail is pivoted at one end upon the axle and at the other end at a point a short distance below the axle when the plow is down in the ground, and at a point even with the axle when the wheels are level."

Starling, p. 133, f. 270, seems to make his side brace Q, an essential factor. He says:

" A.—In Mr. Owen's plow, in the first place, as there " frequently is a greater pressure upon the mould-board as " there is the soil to resist, the plow will not run straight. " There is a tendency in a plow not to do good work, and " it will frequently do what is called ' cut-and-cover ' work. " It is very necessary in a plow to overcome or resist the " side thrust which occurs in all plows, of course, from the " pressure of the earth. There is nothing in the Owen " plow to prevent the plow from being thrust to one side. " The arm is not rigid."

The Berthiaume plow has this same defect or difference.

Starling, p. 32, f. 72. " Q.—There is one question which I neglected to ask you with reference to this foot lever. In your opinion, does the foot lever in the Berthiaume plow perform the same function in substantially the same way as your plow? A.—A portion of the same function. It does not perform all of the functions that mine does."

Gunckel, p. 44, f. 92. " Q.—If the pivotal point of the Harris lever is upon the tongue and is operated without being connected with the axle at all, but the lever connects with the rear part of the bail so that the axle is not a part of the combination, would that be the same combination? A.—No; but it would strike me as being a very apparent attempt to avoid the patent. But if a very important element, the axle, is left out of the combination it could not be the same combination."

This would seem to make it a very successful attempt to avoid the patent.

Experting.—It is not usual to call the attention of the court to the character of the testimony of expert witnesses, but the expert for defendant in error, Gunckel, is either so ignorant or so reckless that it seems important to call attention to some portions of his testimony. Many other passages than those quoted might be referred to, but the following seem to be sufficient:

Starling, who was first called, p. 33, f. 73, claims only to have invented what his patent calls for, and in respect to the function in which his plow is supposed to differ from the others, p. 34, f. 74, says: " I did not in-
" vent that function and I did not invent that result, but I
" did invent that device in that plow by which that result
" is reached."

Gunckel, who followed him, p. 42, f. 89, says. " Q.—
" Are not all the answers you have given to the questions

" propounded to you based upon the supposition that this " Starling patent is a *foundation patent* upon the claim he " makes here? A.—Certainly; very largely."

On p. 43, f. 90, he says: " A.—Then, as I said be- " fore, I regard, assuming that Mr. Starling was *the pio- " neer inventor* as to the lever *uv*, that an equivalent de- " vice was used in the other."

" *The Court.*—Do not cultivators use the plan of de- " pressing the plow, only they use both feet—they operate " on each side? A.—Yes, sir; I think so; *but in my an- " swer I assumed* that Mr. Starling *was the first inventor*."

It required a brave man to assume that any one was a pioneer in plows as late as 1874, or a pioneer of any feature thereof. Starling himself, as we have seen, disclaimed being a pioneer.

Gunckel, p. 43, in relation to the locking device, f. 90, testifies as follows: " Q.—Is it not claimed in the " patent? A.—*It is not one of the elements set out in the " claim itself.*"

He immediately follows this by the following:

" A.—I suppose it would *occur to any competent " mechanic* constructing a plow of that character that he " would have to use some means for locking or else the " plow would be inoperative."

Attention is called to this for the reason that in his rebuttal he bases the entire case on the supposed absence of this admittedly *obvious expedient* in the prior art. His principal objection to the Worrell & Rynerson plow is as follows, p. 104, f. 211: " Q.—What elements do you find " absent in the combination of the plaintiff's first claim " absent from the Worrell & Rynerson patent? A.—A very " material element, which is to regulate the depth at which " the plow is to be set *and for locking it* at that depth."

He says that the first and second Owen patents, in respect to the matters involved in the first claim, are very much alike. On p. 111, f. 224, he says: "In Owen's "second patent there is no device for *locking the lever* or, "in other words, for locking the pivotal point of the "plow beam."

On p. 102, f. 207, he finds a guide in the Hay & Freeman plow concerning which he testifies as follows:

"Q.—Is that plow, then, capable of the function of raising the point of the plow and thereby compelling the horses to assist in raising the point of the plow out of the ground? A.—It is not, as I understand it. On the contrary, the very function of this guide device is to prevent any rising of the forward part of the plow faster than the rear part, or in any direction different from that taken by the rear part."

He had previously testified on the same page, f. 206, that the plow-points would go a little faster. The peculiarity of this testimony is that there is no such guide in the Hay & Freeman patent. All that there is shown and described is a guide to prevent the seat and axle from turning over when the plow-beam is raised.

He might as well say that you could not tip a cart because the cart-box was attached to the axle by guide-arms so that it would not slip off when the cart was tipped. This is all there is of the guide feature in the Hay & Freeman. He has totally misapprehended the construction and operation of this plow.

On p. 103, f. 209, he says that the draft of the team is applied to the tongue in the Worrell & Rynerson patent. He could not have made this statement if he had understood this plow or understood the specification, or if he had read (as it was his duty to do), the prior Worrell & Rynerson patents referred to in the specification of this

one. The reasons for these statements will be found where this patent is considered in a prior part of the brief; and on p. 106, f. 215, he considers that the principal important difference between the Starling and the Worrell & Rynerson is in locking the pivotal point of the plow beam.

He could not have made this objection unless he really understood that the Worrell & Rynerson plow was drawn by the plow beam the same as Starling and the others.

Concerning the first Owen patent, p. 108, f. 219, he says there is no device whatever in the Owen patent by which the pivotal point of the plow beam is fixed; that this is an essential point, and makes a vital difference between the structure of the two plows. We have already seen that in his *prima facie* testimony he agreed that this feature, which he here makes essential, was no part of Starling's first claim.

In the same folio he says that the only means in the Owen patent for determining the depth at which the plow shall run is by depressing the drop-bar which runs through the tongue; yet, as we have elsewhere seen, he agreed that in a properly organized plow this should be done by the clevis itself, and not by any of the parts carried on the wheel frame. The only proper adjustment for the regular running depth of one of these plows is by the draft clevis, on the front end of the plow beam. The want of attention to this fact led the witness into a great many errors.

On p. 112, f. 227, he states that there is no lever shown at all for tilting the bail of the Worrell plow. Figure 2 of this patent shows the tilting lever, and the specification says that it has one.

On p. 113, referring to the Harrison patent, he says:

"The rear portion would raise first. The point is pre-
"vented from raising by that cross-piece in the frame."

We have already seen that "that cross-piece" is above the front end of the plow beam, and that it performs the identical service of Starling's stop W, that is, the front end of the plow beam rises until it strikes this cross piece and runs the plow out of the ground. It then acts as a stop so that the plow can be raised *above* the ground.

In the same folio he testifies as follows concerning this plow: "Q.—The draft of the plow is apparently "through what? A.—The tongue D and the forward "attachment of that tongue D is at the forward end of the "plow beam." He could not have made this statement if he had looked at the drawing, in which Fig. 1 shows the tongue attached to the frame and not to the plow beam, the plow beam being at one end of the frame and the tongue near the opposite end. The specification says: "The tongue *d* is adjustable laterally upon the frame, "so as to adapt the plow for use with either two or three "horses."

If the tongue was attached to the plow beam, or if the draft is through the tongue, its lateral adjustment would be wholly unimportant, as moving it upon the frame could not affect the operation of the plow as between two or three horses; but when used simply as a guide pole, and to prevent the cart or sulky from tipping over, it would require adjustment according to the number of horses used, if, as the fact is, the horses were attached to the plow beam. The specification is specific that the tongue is attached to the frame. The location between the tongue and the plow beam would instruct any one that ever saw one of these plows that the hitch of the team was direct to the front end of the plow beam.

In this patent the point of the plow, as shown in Fig. 2, is directly under the line of the wheel spindles and forward of the bail, so that if the draft was applied to the tongue, it would simply roll the plow over until the plow beam struck against the ground. *A plow cannot be drawn from a point on the beam which is back of the plow point.*

Other quotations might be made, but these are deemed to be sufficient to justify the proposition that the witness either did not know what he was talking about or was utterly reckless in his statements.

III.

Starling's plow not a good one, p. 29.—"It was admitted by the pleadings, proved on the trial, and found to be a fact by the judge that on or about the 5th of December, 1878, after the defendant had manufactured and sold about 35 or 40 plows under the license, the defendant gave the plaintiff written notice that the construction of this sulky plow under the Starling patent was unsatisfactory and large quantities of said plows had been returned as unserviceable, and that the defendant removed (revoked) its license and would thereafter manufacture a sulky plow of its own design."

The record, in numerous places, shows that the Starling plow is not a good one, and that it was long ago abandoned, and it shows that its real defect was in attempting to use a shifting lever as gauge lever, but it was not thought best to weary the court with citations, as the brief is already too long, and as its use for a gauge lever is not claimed; such use being not only inconsistent with its use for the purpose claimed, but is in prohibition of such use.

II.

Royalty.—If the court shall be satisfied that Starling's first claim is as the patent states, a claim for a combination of a bail, plow beam and axle with a *lifting lever*, so applied that the horses are made to run the plow out of the ground; that under the showing of the prior art the claim is a valid one, and that the license is a valid and subsisting one, then Starling is not entitled to royalty for the use of *a gauge lever* which locks the plow into the ground at varying adjustments, for the reason that Starling has no such claim, and the allowance of any sum or amount of money for the use of an unpatented gauge lever is erroneous.

L. L. BOND,
For Plaintiff in Error.

Office Supreme Court U. S.
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Supreme Court of the United States.

OCTOBER TERM, 1890.

No. 329.

THE ST. PAUL PLOW WORKS,
Plaintiff in Error,

vs.

WILLIAM STARLING,
Defendant in Error.

Reply Brief for Plaintiff in Error.

WALTER H. SANBORN,
Attorney for Plaintiff in Error.

H. M. SMYTH PRINTING COMPANY, ST. PAUL.

Supreme Court of the United States.

OCTOBER TERM, A. D. 1890.

ST. PAUL PLOW WORKS,
Plaintiff in Error,

vs.

WILLIAM STARLING,
Defendant in Error.

REPLY TO BRIEF OF DEFENDANT IN ERROR.

I.

It is not very material in this case whether the findings of the court are general or special, because all the vital questions were raised by the objections to the introduction of testimony and exceptions to the rulings thereon taken in the "progress of the trial."

Thus the vital question in this case, discussed at pages 14 to 35 of our brief, and 19 to 26 of Mr. Cairns' brief, whether after the renunciation of the license it still continued in force for the term of the patent, so that defendant in error could

recover on this contract of license for plows made by plaintiff in error thereafter of construction essentially different from the Starling sulky plow, is completely presented by the rulings and exceptions at folios 67 and 333 of the transcript.

Even if it be conceded that the finding of the court was general, all the questions we have discussed in our brief, except those numbered 8, 9, 10, 11 and 12 on page 13 of the brief, were raised by rulings on the introduction of testimony. (See pages 9–12 of brief, where the pages of the transcript are referred to.)

II.

But the finding was special and not general.

The Revised Statutes of the United States required the pleadings, practice and findings to be governed by the Statutes of Minnesota.

Revised Statutes U. S., sec. 914.

The Revised Statutes of Minnesota, 1878, chapter 66, section 242, reads: "*Decision of court, when and how given.* Upon the trial of a question of fact by the court its decision shall be given in writing and filed with the clerk within twenty days after the term at which the trial took place; in giving the decision, the facts found and the conclusions of law shall be separately stated; judgment upon the decision shall be entered accordingly."

And under this statute a general finding or the failure of the judge to find specially on every material issue is error for which the judgment must be reversed.

Baldwin vs. Allison, 3 Minn. 41:42.

Lowell vs. North, 4 Minn. 17:18.

Cochrane vs. Halsey, 25 Minn. 52.

This statute the learned Judge Nelson was familiar with, and in the written decision he filed he found upon every material issue of fact and law.

Folios 284–294.

Now, we submit this constitutes a "special finding" under the United States statute.

The cases cited on pages 4 *et seq.* of Mr. Cairns' brief to show that this court will not consider this "decision," as the Minnesota statute calls it, the special finding that that statute requires, and that it is in fact, are all cases where there was no special finding at all, as in Cooper vs. Omohundro, 19 Wall. 65: 69, where the statement was "the court does find the facts in the case for the plaintiff, and gives judgment that the plaintiff recover," &c.; or where an opinion was filed which failed to find upon some material issue of fact, as in Dickinson vs. The Planters Bank, 16 Wall. 254–257, where the question was as to the liability of a drawer on a bank draft protested after long delay, and the court failed to find on the material issues as to when the draft was presented—whether there was delay in presentation—whether there was excuse for delay, and what notice of dishonor was given.

These cases are not in point, because Judge Nelson complied with the Minnesota statute, and in his "decision" found upon every material issue.

The court below and counsel for the parties so considered and treated this "decision."

The judge in the decision repeatedly uses the words "I find."

Folio 287, Transcript.

The bill of exceptions says. "it was found to be a fact by the judge that on or about the 5th of December, 1878, * * * the defendant renounced its license."

Folio 154.

This "finding of fact" was nowhere but in the "decision" at folio 284–5.

In the judgment it is recited that "the court on February 8th, 1887, having filed its *written findings* herein, wherein it finds for the plaintiff as follows, to-wit, 'the plaintiff is entitled to royalty on 1310 plows at $2.50 each, making the amount of $3275, for which sum judgment is ordered.'"

Now, the only *written findings* of the court were this decision, and from this the finding in the judgment is quoted.

Second.—If, however, this "decision" is not as we maintain—a special finding upon the material issues of fact and law—then there is no foundation for the judgment, and it must be reversed, and this question is raised by the exception to the order entering judgment.

Folios 294:327–8.

Under the Minnesota statute cited there could be no judgment except upon a special finding, which must be as complete as a special verdict, and "if a special verdict be ambiguous or imperfect—if it find but the evidence of facts and not the facts themselves, or finds but part of the facts in issue, and is silent as to others, it is a mistrial, and the court of error must order a *venire de novo;* they can render no judgment on an imperfect verdict or case stated."

Graham vs. Bayne, 18 How. 62.
Prentice vs. Zane, 8 How. 84.
Baldwin vs. Allison, 3 Minn. 41:42.
Lowell vs. North, 4 Minn. 17:18.
Cochrane vs. Halsey, 25 Minn. 52.

The result is that, if this "decision" is a special finding as we maintain, the question is fairly raised whether the facts found are sufficient to authorize the entry of the judgment, and if they are not, there must be a reversal.

If on the other hand this "decision" is not a special finding, the judgment is unauthorized by the Minnesota law, adopted by congress in section 914, U. S. Revised Statutes, and the judgment must be reversed.

III.

Even if the finding was general the rulings made in the "decision" which appear by the bill of exceptions to have been excepted to at the time and which are brought here by bill of exceptions, were made as is clearly shown by Mr. Justice Blatchford "in the progress of the trial" since they appear to have been brought to the attention of the court, ruled upon and excepted to before judgment, and at the time the decision was rendered.

Folio 294.

Clements vs. The Phoenix Ins. Co., 7 Blatchford, 51–58. Where after the trial, argument, submission and subsequent announcement that the court found for the plaintiff, questions of law were allowed to be submitted to be ruled upon, and the learned justice said he could permit this after he had announced his decision because the trial "was still in progress."

Miller vs. Life Ins. Co., 12 Wall. 297.

IV.

Upon the vital question whether or not after the plaintiff in error had renounced its license the defendant could recover on the contract for plows made after the renunciation in defiance of the patent, the diligence of opposing counsel has found no case that holds that the contract in the case at bar might not be terminated by notice of renunciation.

He has cited a large number of cases but on examination we find that not one of them presents a case where a naked licensee under a license not exclusive, which fixed no time for its continuance or amount of articles to be made under it, has been held to pay royalty under the contract for articles made or sold after renunciation and notice thereof.

We will not review his cases—they are all distinguishable from the case at bar on one or more of the grounds stated in pages 20–28 of our former brief.

We call attention to the cases on which Mr. Cairns seems most to rely, to show that a mere licensee may not terminate his contract by renunciation but that it continues for the term, found on page 25 of his brief.

In Baker Mfg. Co. vs. Washburn & Moen Mfg. Co., 18 Fed. Rep. 172, a bill was filed to obtain a modification of a license and to restrain the defendant from declaring the license annulled on the ground that plaintiff had forfeited it by failing to pay the full license fees, and it was alleged that plaintiff had paid the full fees. It does not appear whether the license itself expressly provided for its term of continuance, but the court recognized the right of one of the parties to annul it, while it continued the preliminary injunction against the plaintiffs declaring the license forfeited for nonpayment of the royalty which plaintiff had alleged it had paid.

In opening its opinion the court said "the preliminary injunction is broad enough in its terms to restrain the defendant's from annulling, or attempting to annul or revoke the complainant's license for any cause whatever, and it therefore goes beyond the scope of the bill." The question in the case at bar in no way arose in this case.

Laver vs. Dennett, 109 U. S. 90, Mr. Cairns says, is exactly like the case in question. Let us see. It was a bill in equity to have a contract for a naked license so reformed as to make it a grant of an exclusive license on the ground of mistake, and the court refused the relief asked. The contract gave the right to the licensee to make, use and vend the invention, and he agreed to manufacture and sell it and pay a royalty for each machine so manufactured, and agreed to pay at least 500 pounds per annum. The contract expressly provided that the licensee could surrender on six months' notice, and the licensor could revoke after the licensee's default on thirty days' notice.

It will be seen that the contract had no features in common with the one at bar; it provided for a fixed amount to be paid per annum, while that at bar provides for no amount; it provided that it could be surrendered only on six months' notice, and thus fixed the term, while that at bar provides no term and no continuance.

In Kelly vs. Porter, 17 Fed. Rep. 519, the license was exclusive. It was expressly provided that it should continue for the term of the patent, and should be void only if the patentee's claims were rejected, while in the case at bar no such provisions exist.

In National Rubber Co. vs. Boston, 11 Fed. Rep. 48, the action was to recover for royalty upon inventions which had been made and sold by the licensee *before* he gave notice of

renunciation. In the case at bar it is to recover for those sold *after* renunciation.

In Marsh vs. Harris, 22 N. W. 516, there was a covenant in the license that it should continue for the full term of the patent, and a covenant by the licensee to pay for the full term and not to contest the validity of the patent, and the same covenants are found in Union Mfg. Co. vs. Lounsbury, 42 Barb. 125.

There is nothing in any of these cases counter to the proposition maintained by authorities cited upon page 16 of our former brief. On the other hand, in many of the cases cited by Mr. Cairns it is conceded in the opinions to be the law that a naked licensee may by renouncing the license terminate the license contract and stand just as he would, from that time forth, had no license been made.

In Lawes vs. Purse, 88 E. C. L. 930, where a recovery was had for royalties upon inventions used by the defendant before notice of renunciation, Lord Campbell, Chief Justice, said: "No fraud is alleged, no renunciation of the permission warning the plaintiff that the defendants meant to claim to use the invention in their own right, is averred. I think, therefore, it would be contrary to all principle to hold this plea good." Page 932.

And Erle, Justice, said: "Then it is clear to me that if the defendants go on under this agreement, using the patent right by the plaintiff's permission, they must pay him whether the patent was valid or not, until at least they give notice that they dispute the validity of the patent, and will in future use the invention in their own right, and not under the permission of the plaintiff. Such a notice would change the position of the parties. After it the patentee might sue the defendants for an infringement of his patent for any

subsequent user, and perhaps in an action on the agreement for the price of such subsequent user, the invalidity of the patent might be a defense. But there is no such notice here, and for the user, till there is such notice, the defendants must pay."

In Marsh vs. Doge, 4 Hun. 278: 280–281, where the plaintiff recovered upon a license for royalties upon machines he had used, the court said: "*Moreover, the defendants were estopped to deny that the rakes were manufactured under the plaintiff's license, so long as they retained the license itself. They were at liberty to relinquish it at any time, and they were bound to do so if they intended to deprive the plaintiff of his royalty.*"

In Jones vs. Burnham, 67 Maine, 93, where certain cans of corn had been packed under a license and without notice of renunciation, the court placed its decision, at page 93, on the ground that "no renunciation of the permission warning the plaintiffs that the defendant meant to claim to use the invention in their own right is averred."

And in Hyatt vs. Ingalls, 49 Sup. Ct. N. Y. 375: 379, and in Marston vs. Swett, 82 N. Y. 532–534, two cases in which the plaintiff recovered royalties under licenses which had not been renounced, the courts used these words: "While the manufacture goes on under such an apparently valid patent, it is presumed to be under and in accordance with the agreement to pay royalties. If the manufacturer does not so intend, and chooses to make the patented article not under the patent but in hostility to it, he must give notice of that intention, in order that the presumption may not attach, or the patentee be misled."

There seems to have been no decision by any court, except the learned judge below in this case, to the effect that a

But if it was competent or material for Mr. Starling to show, without pleading it, that his invention antedated the patents we proved, we never could understand why it was not competent and material for us to prove as we offered to do, that the device shown in the Starling patent was in use prior to 1872, as we had alleged at folio 13 of the transcript. (See folio 204.)

It is not correct as Mr. Cairns says, that the testimony here offered had been introduced before at page 98; that testimony did not relate to the time anterior to 1872, or to the use substantially as used by Starling, while the offer did.

WALTER H. SARBORN,
Attorney for Plaintiff in Error.

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SUPREME COURT OF THE UNITED STATES.

OCTOBER TERM, 1887.

No. 1367.

ST. PAUL PLOW WORKS, *Plaintiff in Error.*

vs.

WILLIAM STARLING, *Defendant in Error.*

IN ERROR TO THE CIRCUIT COURT OF THE UNITED STATES FOR THE DISTRICT OF MINNESOTA.

ON MOTION TO DISMISS THE WRIT OF ERROR.

BRIEF AND ARGUMENT

OF DEFENDANT IN ERROR.

CHAS. S. CAREINS and D. S. FRACKELTON,
Attorneys for Defendant in Error.

SUPREME COURT OF THE UNITED STATES.

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BRIEF AND ARGUMENT

OF DEFENDANT IN ERROR.

D. S. FRACKELTON and CHAS. S. CAREINS,
Attorneys for Defendant in Error.

FLOUR CITY PRINTING CO., Minneapolis, Minn.

MOTION.

And now comes the said defendant in error and having caused a Transcript of Record to be filed herein, moves the said Honorable Court to dismiss the writ of error herein for want of jurisdiction to review the judgment herein.

STATEMENT.

This action is one for the recovery of license fees agreed to be paid under a contract of license with reference to a patent.

The sum involved (the judgement), is less than $5,000, and we contend that it is not a "case touching patent rights" under section 699 Revised Statutes U. S. That therefore this court has not jurisdiction and the writ should be dismissed.

FACTS.

Stated more in detail, it is an action at law brought by William Starling, a citizen of the State of Nebraska, defendant in error, against the St. Paul Plow Works, a corporation of the State of Minnesota. The citizenship of the parties gave jurisdiction to the Circuit Court. It is brought to recover damages for the violation of a contract executed by both parties, being exhibit A attached to the complaint. (See Transcript of Record page 3). By this contract Starling granted to the corporation a license to make and sell the Starling Sulky Plow under patent number 154,293 dated August 18th, 1874, in specified territory, and the corporation agreed "to make said Sulky Plows in a good and workmanlike manner and advertise and sell them in the usual manner * * * and render an account on the first day of January and July of each year of all plows sold prior to those dates on which the royalty has not been paid, and to pay * * two and fifty one-hundredths dollars for each and every plow sold."

The complaint alleges a breach of each one of these stipulations to be performed by the corporation, and specially that defendant has made and sold many of the Sulky Plows for which it has paid no royalty, (page 2) and asks for damages in the sum of $10,000.00.

The answer admits the making of the contract of license under said patent granted to Starling (page 7) and alleges that defendant "has fully kept and performed all the provisions and terms of said contract."

It sets up a notice to plaintiff, given him after the license was granted, that it renounced the license contract, but it is not pretended that plaintiff acceeded to this (page 9). He elected to proceed upon the contract instead of treating defendant as an infringer. It further alleges want of novelty in the Starling patent, setting up certain patents as anticipating it, (pages 6-7). On the trial, it was contended by Starling, plaintiff, that such would not be a defense against payment of royalty for plows actually made and sold, and that defendant was estopped by taking a license from disputing the validity of the patent against his licensor when sued for rent or royalty agreed to be paid. Nevertheless, this matter was gone into on the trial, but resolved in favor of plaintiff, (see opinion pages 14 to 18).

Plaintiff having filed a reply and a jury having been waived by written stipulation, the cause is tried by the Court (pages 10 to 13). The Court construed the contract of license, and found that defendant had made and sold 1,310 plows for which it had not paid the royalty of $2.50 as provided in the contract, and ordered judgment for Starling, plaintiff, for $3,275 (page 18).

Defendant then petitioned for a new trial, (pages 19 to 21), which was heard and the Court filed his opinion thereon (pages 22 to 24) The motion was denied, and judgment was entered for the above sum and interest and costs to be taxed, October 10th, 1887 (pages 24-25).

Thereupon defendant sued out this writ of error, (pages 25 to 28) and Starling, defendant in error,

causes a Transcript of Record to be filed in this court and printed for the purpose of making this motion to dismiss the writ, to prevent "needless and oppressive delay."

BRIEF.

The court has held this proper practice,

Clark *vs.* Hancock, 94 U. S. 493,
Thomas *vs.* Woodridge 23 Wall. 283.

Section 700 R. S. U. S. is the only act providing for the review here of a civil cause where an issue of fact has been tried in the Circuit Court otherwise than by a jury.

Boogher *vs.* Insurance Co., 103 U. S. 90,
Kearney *vs.* Case, 12 Wall. 275.

Unless the case at bar also comes under section 699 providing for appeals without regard to amount in controversy, there is no jurisdiction in this case. The provisions of section 691 limiting appeals in *other* cases to those where the matter in dispute exceeds $5,000. apply to writs of error and appeals under section 700.

Elgin *vs.* Marshall 106 U. S. 578,
Zeigler *vs.* Hopkins 117 U. S. 686.

The provision in section 699 giving the right of appeal or writ of error in cases "*touching patent rights*," doubtless means the same as the language of

section 629 giving the Circuit Courts original jurisdiction, "of all suits at law or in equity *arising under the patent or copyright laws of the United States.*"

"Touching" does not here refer to a remote or collateral contact. Such construction would give an appeal without regard to the sum in controversy in every case of suit on a note given in purchase of a patent, or on a contract which related in the remotest degree to a patent, where the citizenship of the parties gave the Circuit Court jurisdiction.

It means such contact as results from the action *"arising under the patent laws."*

An action on a contract to recover license fees agreed to be paid for the use of a patent is not a case "touching patent rights" or "arising under the patent or copyright laws of the United States."

Brown *vs.* Shannon 20 How. 55.
Albright *vs.* Teas 106 U. S. 613.
Wilson *vs.* Sandford 10 How. 99.
Hartell *vs.* Tilghman 99 U. S. 547 (1878).
Sizer *vs.* Many 16 How. 97 (1853).
Burr *vs.* Gregory 2 Paine 426 (1827).
Blandhard *vs.* Sprague 1 Cliff. 288 (1859).
Hill *vs.* Whitcomb 1 Holmes 317 (1874).
Goodyear *vs.* Union India Rubber Co. 4 Blatch 63.
Merserole *vs.* Union Paper Collar Co.6 Blatch 356
Goodyear *vs.* Day 1 Blatch 565.
Brooks *vs.* Stolley 3 McLean 523 (1845).
Pulte *vs.* Derby 5 McLean 328.
Curtis on Patents Sec. 496.
Walker on Patents Sec. 388.

In Brown *vs.* Shannon above 20 How. 55. The Bill was so framed that there was doubt whether complainants sought to prohibit the infringement of a patent right, or to enforce the specific execution of two contracts with reference to patents.

One of these contracts (made with a portion of complainants) gave defendant Brown the right to use 5 patented machines, and no more in one establishment within specified territory.

By the other of said contracts Brown granted to others (the remaining complainants) all his right to use these machines, which right he had derived from the first contract.

Brown nevertheless continued to use the five machines in his establishment, and the action was brought to prevent the same.

The Court says:

"And the first question, therefore, for this court to determine is upon which of these two grounds does the bill seek for relief. The jurisdiction of the Circuit Court in the one case is materially different from its jurisdiction in the other; and while this court can exercise no appellate power in a case arising under contracts like those exhibited, unless the amount or value of the matter in controversy exceeds two thousand dollars [now $5,000.] it may yet lawfully exercise its appellate jurisdiction when a far less amount is in dispute if the party is proceeding either at law or in equity for the infringement of a patentright to which he claims to be entitled, upon looking, however, carefully into the

bill, we think it must be regarded and treated as a proceeding to enforce the specific execution of the contracts referred to, and not as one to protect the complainants in the exclusive enjoyment of a patent-right. * * * It is to prevent the fraudulent violation of these contracts, therefore, that the complainants seek the aid of the court and ask for an injunction."

The court further found that the amount in controversy was less than that required by the statute and dissmissed the appeal.

The case at bar is a much clearer one of want of jurisdiction than that just cited.

Albright *vs.* Teas, 106 U. S. 613, was an action brought in a state court in equity, for a discovery on account of the sums due the complainant for royalties under a contract as to patents, and for a decree therefor against two of the defendants, A. & C.

By the contract plaintiff had agreed to assign certain patents to A. & C. and the latter agreed, among other things, to pay specified royalties. The patents were assigned. The answer of A. & C. alleged full performance of the terms of the contract. There was a dispute as to whether certain articles were made under the plaintiff's patents or under other patents, and hence as to whether royalty should be paid thereon. Thereupon, defendants removed the cause to the United States Circuit Court.

Upon final hearing complainant moved to remand the cause for want of jurisdiction, which the court did, and from this order the defendants appealed.

Appellants contended that it was a case "arising under the * * * laws of the United States," and removable to the Circuit Court under the Act of March 3, 1875, C. 137.

The Court says:

"It is clear from an inspection of the bill and answer that the case is founded upon the agreement." * * *

"The appellants insist, however, that evidence was taken in the cause by the appellee for the purpose of proving that they were using his patented improvements in the manufacture of goods for which they paid him no royalty, and which they contended did not embody the improvements covered by his patents; that the testimony developed a controversy on the question whether the goods which they manufactured under other patents owned by them were, or were not, infringements on his patents; consequently, the question of infringement and of construction of the claims of his patent were necessarily involved in the case, and, therefore, it was one arising under the patent laws of the United States.

"We search the bill of complaint in vain to find any averments raising these questions. It makes no issue touching the construction of the patents granted the appellee, or their validity, or their infringement. The only complaint made in the bill is that the appellants were fraudulently excluding the appellee from an inspection of their books of account, and refusing to pay him the sum due for royalties under his contract. And the prayer of the bill was for a discovery, an account of what was due the appellee under his contract,

and a decree for the amount found to be due him.

"On the face of the bill, therefore, the case is not one arising under the patent laws of the United States."

The court says further, as to ascertaining the amount of royalty due, "It of course became necessary to inquire what goods were manufactured by the appellants under the patents of the appellee. In prosecuting this inquiry an incidental question might arise, namely: what goods were manufactured by the appellant under other patents of which they were the owners, or licensees? But this incidental and collateral inquiry does not change the nature of the litigation. The fact that Albright and Cahoone had licenses to use other patents under which they were manufacturing goods, does not give them the right to litigate their cause in the United States courts because certain goods, which they asserted were made under other patents, the appellee asserted were really made under his. The suit, notwithstanding the collateral inquiry, still remains a suit on the contract to recover royalties, and not a suit upon the letters-patent. It arises solely upon the contract, and not upon the patent laws of the United States.

"In fact, it does not appear that there is any dispute whatever between the parties in reference to the construction of the patents of the appellee. The controversy between them, as stated by the appellants themselves, is whether certain goods manufactured by them embody the invention covered by the appellee's patents. This does not necessarily involve a construction of the patents. Both parties may agree as

to what the patented invention is, and yet disagree on the question whether the invention is employed in the manufacture of certain specified goods. The controversy between the parties in this case is clearly of the latter kind."

"The case cannot, therefore, be said to be one which grows out of the legislation of congress. Neither party asserts any right, privilege, claim, protection, or defense founded, in whole or in part, on any law of the United States."

"We are, therefore of opinion that, even if we go outside the pleadings and look into the testimony, the case is not one arising under the laws of the United States, and, consequently, that the court of the United States had no jurisdiction to entertain it."

Likewise in the case at bar defendant claims that certain plows admitted to have been made by it, were made under another patent than plaintiff's, to-wit: a patent to one Berthiaume later than plaintiff's patent.

The only point of difference between the case at bar and that of Albright *vs.* Teas above is that defendant in his answer attempts to impeach the validity of the plaintiff's patent.

Such circumstance makes no difference.

First, Because it is still within the reason of the rule of that case. If defendant were not estopped from disputing the validity of the patent, it was still a mere "collateral inquiry" and the action "still remains a

suit on the contract to recover royalties and not a suit upon the letters-patent."

Second, Because if such collateral issue as to the validity of the patent calls in question a "right * * under the Constitution, or any * * statute of * * the United States," under Sec. 709 R. S., U. S., granting writs of error and appeals to the Supreme Court; yet the decision was not "against * * the right claimed." The decision was for such right, and sustained the validity of the patent. Whether there would be an appeal on the part of the party claiming under the patent, in case a State Court, on such collateral issue, held the patent invalid, is another question.

Third, Because to say that an appeal lies in the case at bar, is to say that where a defendant, sued on a contract of license for license fees, sets up invalidity of the patent, as a defense, the answer changes the character of the case so that it becomes one "touching patent-rights," and "arising under the patent * * laws of the United States."

If two litigants then, resided in the same state, and plaintiff sued in the State Court for the royalty agreed to be paid, defendant would only need to set up in his answer that the patent was invalid, and the State Court would no longer have jurisdiction. He would then be entitled to have the case dismissed.

When sued in the Federal Court, he would need only to omit to dispute the validity of the patent, and that court would have no jurisdiction. Or he might

enter a special appearance without answering and move to have the case dismissed for want of jurisdiction. Thus the plaintiff would be left remediless.

The case of Wilson *vs.* Sandford, 10 Howard, 99, was an action in which it was sought to set aside a contract made by the appellant with the appellees, by which he had granted them permission to use, or vend to others to be used, one of Woodworth's planing machines, in the cities of New Orleans and Lafayette; and also to obtain an injunction against the further use of the machine, upon the ground that it was an infringement upon his patent rights. It was claimed that the contract of license had been forfeited by the refusal to comply with its conditions.

The amount in controversy was less than two thousand dollars, and the appellants claimed that this case came under the provisions of the act of 1836, granting an appeal in "actions, suits and controversies on cases arising under any law of the United States, granting or confirming to inventors the exclusive right to their inventions and discoveries."

The Court says: "The peculiar privilege given to this class of cases was intended to secure uniformity of decision in the construction of the act of congress in the relation to patents. Now the dispute in this case does not arise under any act of congress, providing for or regulating contracts of this kind. The rights of the parties depend altogether upon common law and equity principles. The object of the bill is to have this contract set aside and declared to be forfeited; and the

prayer is 'that the appellant's re-investiture of title to the licenses granted to the appellees, by reason of the forfeiture of the contract, may be sanctioned by the court,' and for an injunction. But the injunction he asks for is to be the consequence of the decree of the court sanctioning the forfeiture, * * and wherever a contract is made in relation to them [patent rights] which is not provided for and regulated by congress, the parties, if any dispute arises, stand upon the same ground with other litigants, as to the right of appeal; and the decree of the Circuit Court cannot be revised here, unless the matter in dispute exceeds two thousand dollars."

The appeal was dismissed for want of jurisdiction.

Hartell *vs.* Tilghman, above, 99 U. S. 547, was an action in equity in which complainant sought to enjoin the use of the patent, and for an account of profits and damages. The defendants were licensees, but plaintiff alleged breaches of the parol contract of license, on which he claimed the right to rescind the same.

The majority of the court held, that a right of recission under the circumstances and on the ground claimed was inequitable. That the case came within that of Brown *vs.* Shannon, above. That the contract governed the rights of the parties in the use of complainant's process, and must be the foundation of any relief given, and that such a case is not cognizable in a court of the United States, by reason of its subject matter.

The Court reviews the prior cases on the question.

The above case is much nearer the line of jurisdiction than the one at bar.

(1) There the complainant was attempting to proceed against defendant as for infringement, and seeking an injunction.

This is an action on the contract.

(2) There the complainant asserted all right under the contract had ceased, and he was remitted to his original rights under the patent.

Here the action proceeds on the contract only and the court found it to be in force and the measure of the rights of the parties.

In the last case a dissenting opinion was filed. Although we should regard that as laying down the law as applied to that case, it supports this motion with equal force.

The only point of difference between the majority and the minority of the court in that case, seems to be, whether in fact the action was one in which the rights of the parties depended on a contract. This the majority held to be the case, but the minority held that the allegations in the Bill, with reference to the contract between the parties, were by way of anticipating a defense which might be set up to the action for infringement, and that "This anticipation of the defense does not change the nature of the suit;" saying further, "Perhaps he need not have anticipated the defense, but might have left the defendants to develop it in their answer. Certainly in that case the character of the defense would not have ousted the

court of its jurisdiction. If a cause of action is cognizable by the United States Court, the defendant cannot oust that jurisdiction by his defence to the action. He may defeat the action, but he cannot destroy the jurisdiction."

So it may be said in the case at bar. Plaintiff might have brought his action on this contract in a state court, and defendant could not, by his answer, oust that court of jurisdiction.

The minority, in their opinion, further say:

"It is perfectly well settled, I admit, that where a suit is brought on a contract of which a patent is the subject matter, either to enforce such contract, or to annul it, the case arises on the contract, or out of the contract, and not under the patent laws."

In Sizer *vs.* Many, 16 How. 97 (1853), the Court holds, that under the Act of 1836, in an action for the infringement of a patent, where, after a writ of error to Supreme Court from the judgment, recovered by plaintiff and affirmance of the same, with a mandate accordingly to the Circuit Court, costs are taxed below at a sum less than $2,000, and a second writ of error thereon is allowed, it does not come under the provision with reference to appeals in patent cases.

The Court says:

"The discretionary power in this respect vested in the circuit courts, by the Act of July 4, 1836, Sec. 17, is evidently confined to cases which involve the

construction of the patent laws, and the claims and rights of patentees under them."

The appeal was dismissed for want of jurisdiction.

Blanchard *vs.* Sprague, 1 Cliff. 288 (1859), was an action by a licensor against a licensee to recover an additional license fee over that paid by defendant, under the provisions of a license providing for an increase of the license fee on notice.

Judge Clifford held that the dispute arose entirely out of the agreement, express or implied, for a license, and did not depend upon any act of Congress respecting patent rights. That "whenever a contract is made in relation to patent rights which is not provided for and regulated by an act of Congress, the parties, if any dispute arises, stand upon the same ground as other litigants in respect to jurisdiction of the court. Both parties were citizens of the same state and the Bill was dismissed.

In Hill *vs.* Whitcomb, 1 Holmes, 317 (1874), Shepley, J., held, where the patentee, or his assignee of letters patent for an invention, sells to a person a machine embodying the patented invention, with a covenant that the vendee and licensee shall be the exclusive licensee, and have the sole right to use the patented invention within a described territory, and thereafter sells to another a patented machine in violation of his contract, to be used in the described territory, such second vendee having notice of the first contract, the licensee cannot enforce his rights in the Federal Courts

without regard to the citizenship of the parties, under the jurisdiction conferred upon those courts by the patent act. (Act of July 8, 1870.)

Complainant, the licensee, sought to enforce his rights both against his licensors and the second vendee of a machine.

The Court says:

"Is the case supposed a case or controversy arising under the patent laws of the United States? I feel compelled to come to the conclusion that it is not. It is a case arising under a contract in relation to a machine embodying in its organization three or more patent inventions. But it is a case arising out of the contract and the relation of the parties under the contract, and not under the patent laws of the United States. If the Allen Manufacturing Company were the sole manufacturers of a certain description of printing-presses not patented, and should sell one of such presses to the complainants, with a covenant that they would not sell any like press to any other person, to be used in the same territory to compete with the complainants, and afterwards should sell to another person, who had notice of the contract, a like printing-press, to be used in the same territory in competition with the first vendees, it would present a case furnishing precisely the same ground for equitable jurisdiction as that claimed to exist in the present case. It would present a case cognizable in a court of equity in the state of which the parties were citizens, if the court should be of opinion that there was not a full, adequate, and complete remedy at law. It would, in my opinion,

present a case for equitable relief in this court, if, by reason of the parties being citizens of different states, this court had jurisdiction of the case. But it would not be, and this case is not, a bill to prevent the violation of a right secured by patent, but a right secured by contract. The machine purchased by the Whitcombs of the patentees had passed out of the monopoly and from under the protection of the laws of the United States, and was, like other property, subject only to the operation of the laws of the state."

The case of Brooks *vs.* Stolley, 3 McLean, 523 (1845), is criticised by the majority of this court in Hartell *vs.* Tilghman, 99 U. S., 547, being in some respects opposed to the authorities there cited, as "standing alone" and "not supported by the better reason." But it is not in conflict with the present motion, it supports it.

It was an action by a licensor of a patent against the licensee, seeking *an injunction* against the use of the patented planing machine, on the ground that the licensee had broken the contract of license, and refused to be bound by it and could not longer justify such use under the license.

Judge McLean says:

"It is suggested, that, as the whole controversy in the case arises under the contract of license, the parties to which being citizens of this state, the Federal Court cannot take jurisdiction. This objection would be unanswerable, if no right were involved in the controversy, except what arises out of the contract: as,

for instance, the Circuit Court could take no jurisdiction under the contract, of an action, merely to recover the sums agreed to be paid by the defendant; but, in the present aspect of the case, it is not limited to the contract. The complainants set up their right under the patent, and allege that the defendant is infringeing that right; that the license affords no justification whatever to the defendant. The right then of the complainants to an injunction, is not founded by them on the contract, but on the assignment of the patent. If the object of the bill were merely to enforce a specific execution of the contract, the Circuit Court of the United States could exercise no jurisdiction in the case."

It may be added that the action at bar is one "merely to recover the sums agreed to be paid by the defendant."

In the case of Pulte *vs.* Derby, 5 McLean, 329, complainant had given defendant the right to print two editions of a copyrighted work. Complainant claimed that defendant was printing a third edition, contrary to his wishes and desires, and in fraud of his rights, and prayed for an injunction to prevent further printing, publishing, or selling, the alleged third edition.

The court held, the acts done by defendant were within the scope of the contract, and, as to jurisdiction, that the Circuit Court had none, because the rights of the parties depended simply on the contract.

Referring here to the case in 3 McLean, 523, the Court says:

"In the case of Wilson *vs.* Stolley, at chambers,

where a question somewhat similar was presented, I stated that where the controversy grew out of the license or contract, the Circuit Court had no jurisdiction. In that case, however, Stolley having forfeited his contract by refusing to make the payments required, it was held that Wilson's right under the patent was a ground for jurisdiction."

It will be noticed then that Judge McLean recognized a different rule, as to jurisdiction, where a licensee, defendant, has forfeited his license by his conduct, and plaintiff *insists* upon such forfeiture and proceeds upon the theory that there is no longer any contract subsisting, and seeks injunction; than where a suit is upon a contract and against a licensee who has violated it, but where the plaintiff, not insisting upon any forfeiture, proceeds upon the theory that the license is still binding, to compel obedience to its terms, or damages for breach thereof.

The latter is the character of the case at bar.

In Goodyear *vs.* Day, 1 Blatch, 565, Nelson, J., says: "It was attempted to sustain the jurisdiction on the ground that the suit was brought under the patent act, where jurisdiction depends on the subject matter, without reference to citizenship or residence; and that the *gravamen* laid was the infringement of patent rights. But there is no foundation for this position. The bill is not constructed for the purpose of presenting a question of the infringement of a patent; but is brought for the violation of a contract. We can regard it in no other light."

II.

The writ of error cannot be sustained on the ground that the Court went into the question of the validity of the patent.

The Court, on the trial of the case at bar, was in doubt whether defendant was estopped to deny the validity of the patent, and went into the question, as he says, with hesitation, and because the contract contained no recital that plaintiff had invented the plow, and because the plaintiff had not pleaded an estoppel. [See Opinion, Page 15 of Record.]

In his opinion on the motion for a new trial, he says: (Page 23, Record) "If error was committed, it was in allowing the defendant to show want of novelty and patentability of the plaintiff's plow."

If this question was not a proper issue in the court below, it could not in any view of the case change the character of the suit so as to give a right of appeal, at least where it was so resolved, as in this case, that no injury to either party arose from the error in going into it.

It might be said, that while no estoppel was pleaded by plaintiff by way of recital, that the matter was intended to be invoked as such, yet the facts relied upon to constitute such estoppel were set forth, viz.: The license contract and the exercise by defendant

of the right thereby conferred by making sulky plows.

We do not regard it necessary to the decision of this motion to go into this question of estoppel, but add a citation of the cases, supporting, as we believe, by the weight of authority our views thereon, and that such invalidity would not constitute a defense to the suit:

Kinsman *vs.* Parkhurst, 18 How. 289.
White *vs.* Lee, 14 Fed. 789.
Rogers *vs.* Piessuer, 30 Fed. 525.
Bartlett *vs.* Holbrook, 1 Gray, 114.
Marston *vs.* Sweet, 66 N. Y. 206.
" " " 82 N. Y. 526.
Burr *vs.* Duryee, 2 Fisher, 285.
Baltimore Car Co. *vs.* North Balt., 21 Fed. 50.
Walker on Patents, Sec. 307.

But the fact that the question of validity of a patent arises collaterally in an action on a contract, does not oust a state court of jurisdiction.

The case of Merserole *vs.* Union Paper Collar Co., 6 Blatch, 356 (1869), was an action in equity, brought by licensees against the licensors, to have the contract of license cancelled on the ground that the patent was void, for want of novelty, having been fraudulently represented to be valid. The citizenship of the parties did not give the court jurisdiction.

In deciding the case Blatchford, J., said:

"If the license and the agreement of the plaintiffs are void, because the patents are void, the fact that the plaintiffs must show that the patents are void, in order

to get rid of the license and the agreement, does not make the case one arising under the patent act, so as to give to this Court jurisdiction of it. A State Court has jurisdiction to decree the license and agreement to be void and inoperative for fraud, or any other adequate reason; and the fact that, in the investigation, the State Court will be obliged to inquire whether there was any thing new in the patents which could operate as a consideration for the license and the agreement, cannot deprive the State Court of jurisdiction or confer it on this Court. It is true, that a State Court cannot take cognizance of a suit brought for the infringement of a patent, nor of a direct suit brought to decree a patent to be void; but, as is well said by Chief Justice Williams, in Rich *vs.* Atwater (16 Conn., 409-414): 'That the validity of patent rights is a subject peculiarly within the jurisdiction of the courts of the United States, is true. But, it is equally true, that, when they come in question collaterally, their validity must become a subject of inquiry in the State Courts. Thus, in a suit upon a note, if it is claimed that the note was given for a patent right, and the patent is invalid, and so there is no consideration for the note, the State Courts constantly exercise jurisdiction.'"

A long line of decisions of the highest courts of the states might be added, but is deemed unnecessary.

The Court has decided two cases at the present term which are in point:

Dale Tile Mfg. Co, *vs.* Hyatt, 8 Sup. Ct. Rep.

Feliz *vs.* Scharnweber, 8 Sup. Ct. Rep.

In Dale Tile Mfg. Co. vs. Hyatt, the State Court had not passed upon the question of validity of the patent, although it was raised in the case.

The Supreme Court Says:

"Whether that Court was right in its suggestion, that it would have no jurisdiction to determine the validity of such re-issue if incidentally drawn in question in an action upon an agreement between the parties, we need not consider, in as much as it expressly declined to pass upon any such question, because it held, that in this action to recover royalties due under agreement, the defendant, while continuing to enjoy privileges of license, was estopped to deny the validity of the patent, or any re-issue thereof."

If it should be held that the case at bar properly involved the validity of the Starling patent, as a collateral question, then it is necessary to decide whether such is a federal question.

If decided to be a *federal question*, then there are two distinct characters of federal questions,—which is it?

(1) Of the one, State courts have concurrent jurisdiction with the Federal courts to pass upon them, with the right of appeal under R. S. U. S. section 709 to this court from a final judgement or decree of "the highest *court of a State* in which a decision of the suit could be had;" provided "the decision is *against* the title right privilege or immunity specially set up or claimed * * under such constitution * statute * or authority,"namely, of the United States.

~~When arising collaterally~~, if it be this character of "federal question," there is no appeal, unless the decision be *against* the "right," etc. But the decision was *for* the right claimed, holding patent valid. Nor in any event is there an appeal from a Circuit Court of the U. S., where *such* federal question was decided, unless the amount in dispute exceed $5,000. This section provides only for appeals from State courts.

(2) Of the other character of "federal question," the United States courts have *exclusive* jurisdiction. Such are "all *suits* at law or in equity *arising under* the patent or copyright laws of the United States."

But this court has repeatedly held, as we have seen, that an action on a contract relating to a patent is not such suit. And we have seen that it leads to an absurdity to hold, if defendant in his answer raise the question of validity of the patent, so that it becomes involved collaterally, such fact changes the character of the suit so that it is one "arising under the patent laws." Where litigants reside in the same state, the licensor would be at the mercy of his licensee. (See *Ante*, page 12.)

Hence we are forced to the conclusion, that in no view of this case can a writ of error lie to this Court, and the same should be dismissed.

Respectfully Submitted,

CHAS. S. CAREINS and
D. S. FRACKELTON,
Counsel for Defendant in Error.

Office Supreme Court U. S.
FILED.
APR 17 1891
JAMES H. McKENNEY.
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SUPREME COURT

of the United States

OCTOBER TERM, 1890.

No. 329.

ST. PAUL PLOW WORKS,

Plaintiff in Error,

vs.

WILLIAM STARLING,

Defendant in Error.

BRIEF FOR DEFENDANT IN ERROR.

CHARLES S. CAIRNS,

Attorney for Defendant in Error.

GOODRICH & CO., PRINTERS, MINNEAPOLIS.

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BRIEF FOR DEFENDANT IN ERROR.

STATEMENT.

This is an action at law for breach of a contract. The contract is set forth on page 3 of the record. By its terms, Starling grants to the St. Paul Plow Works the right to make and sell the Starling sulky plow under patent number 154,293 dated August 18th, 1874, and the Plow Works, among other things, in consideration thereof, agrees to pay $2.50 to Starling for each plow it sells.

Starling, plaintiff below, brought suit and the citizenship of the parties gave jurisdiction to the circuit court. The complaint alleges a breach of the several undertakings of the Plow Works and seeks to recover damages therefor and especially the $2.50 royalty on plows sold. The answer admits the contract, but denies the breaches. It sets up further a notice given to Starling after it had operated under the contract for a time, to the effect that it renounced the license.

It also alleges want of novelty in the Starling patent and sets up six certain patents as anticipating it, viz.: the patents set forth in the records excepting those to Berthiaume and Haslup.

HISTORY OF THE CASE.

When the Starling sulky plow came upon the market, it proved eminently successful, as attested by the testimony of a dozen witnesses in the case who had used the plow for years and others who had manufactured and sold it. It overcame difficulties which others had not been able to meet. (Record page 101.)

The St. Paul Plow Works in December, 1877, sought and procured a license to make and sell it. After the contract had been in force for a year, the plow works gave notice that it would make no more of these plows; claiming as a reason therefor that the construction of the plow was unsatisfactory and useless.

Upon this point it was contended by Starling that the plow gave the fullest satisfaction when made by other plow companies. That if those of defendant below did not, it was because of defective workmanship. That the defective workmanship was either designed to furnish a supposed excuse to avoid paying rent, or was the result of want of skill or appliances for making the same (page 101).

Thereupon without any interim the plow works, under direction of its foreman, one Berthiaume, having modified slightly the workmanship and certain details in the make up of the plow as theretofore made by it, continued to make and sell the same, now under the name of "Star" instead of "Starling." Up to this time the plow works had made and sold thirty-five to forty plows (page 14) and paid royalty on twenty-seven (27) all told (page 32). It refused to pay any further royalty.

About 15 months after this change, said foreman of its shops, Berthiaume, procured to be issued to himself a patent No. 225,207 dated March 9th, 1880, for certain details in the manner of constructing plows after the Starling model (page 161). Of these several details patented by Berthiaume, but a single feature was employed in the so called "Star" or "Berthiaume" plows

made by the Plow Works, and that feature related to the foot lever for depressing the point of the plow by downward pressure on the front part of the beam.

Hence it should be borne in mind that the plow exhibited in the Berthiaume Patent, is not the so called "Star" or "Berthiaume" plow, of which the court found that defendant below had made 960. (Page 14.)

In process of time, Berthiaume as foreman or superintendent of the Plow Works shop, was succeeded by one Harris. He, a second time, modified slightly the plow, and for convenience again, as before, the plow is given the superintendent's name and is designated the "Harris Plow." (Page 14.) Of these, defendant below made and sold 350. (Page 14.) Starling having refused to consent to a termination of the contract and the Plow Works having refused to pay rent for the grant held in possession by it, the issues are joined, a jury is waived and the cause tried by the court. The court finds for the plaintiff in the sum of $3,275, being royalty on 1310 plows at $2.50.

Plaintiff in error then made a motion for a new trial upon four grounds, (page 22), one being newly discovered evidence consisting of the Haslup patent. (Page 165.) The court denied the motion for a new trial. His opinion thereon is set forth at page 22. Judgment was entered and plaintiff in error sued out this writ thereon.

Afterwards, defendant in error moved this court to dismiss the writ on the ground that $5000 was not involved and the case was not one "touching patent rights" under section 699 revised statates U. S. This court refused the motion on the ground that it was a case in which the validity and the infringement of a patent had been controverted, and that such is a case "touching patent rights." The opinion of this court will be found in 127 U. S. 376 (8 S. C. Reporter 1327).

BRIEF.

This cause having been tried by the court, is reviewable only under section 700 R. S. U. S. in connection with section 699. Section 700 is the only act providing for the review here of a civil cause where an issue of fact has been tried in the circuit court otherwise than by a jury.

Boogher vs. Insurance Co., 103 *U. S.* 90.
Kearney vs. Case, 12 *Wall.* 275.
Elgin vs. Marshall, 106 *U. S.* 578.
Zeigler vs. Hopkins, 117 *U. S.* 686.

Section 700 then is the measure of what is reviewable here, and authorizes two things:

1st.—The review of "the rulings of the court in the progress of the trial of the cause, if excepted to at the time."

2nd.—"The determination of the sufficiency of the facts found to support the judgment."

The second is allowable only where there are special findings.

The finding in this case is general, and hence the rulings of the court only may be reviewed. The opinion of the court below is not a sufficient special finding of the facts within the statute.

Dickinson vs. Planter, 16 *Wall.* 250.
Cooper vs. Omohundro, 19 *Wall.* 65.
Insurance Co. vs. Tweed, 7 *Wall.* 44.
Insurance Co. vs. Boone, 95 *U. S.* 117.
Phillips U. S. S. C. Practice pp. 230, 237.

But if there were special findings, there is no assignment of error to cover a review under the 2nd branch above of section 700.

Section 997 *R. S. U. S.*

THE ASSIGNMENTS OF ERROR.

Plaintiff in error makes 20 assignments of error (page 168). These may be grouped broadly in two classes.

1st.—General findings of the court and conclusions embodied in the same.

2nd.—Rulings of the court.

The 1st group includes assignments 1, 2, 4, 6, 7, 8, 9, 10, 11, 12, 13. These are not proper assignments. When the finding is general, nothing is open to review except the *rulings of the court in the progress of the trial.* This phrase does not include the general finding of the court, nor its conclusions embodied in such general finding.

Cooper vs. Omohundro, 19 *Wall.* 69.
Martinton vs. Fairbanks, 112 *U. S.* 670.
Santa Anna vs. Frank, 113 *U. S.* 339.
Phillips U. S. S. C. Practice 225.

The first alleged error is the order for and entry of judgment, and the second is that the court found that Starling was entitled to royalty on 1310 plows. These are mere conclusions based on facts found by the court from the evidence adduced in the trial. Error cannot be predicated of them unless there was some error back of them, and the latter when appearing in a ruling must be assigned as error.

The 4th alleged error is that the court held or found that the plows made by the plaintiff in error infringed the first claim of the Starling patent. The ultimate fact which the court was seeking, was what plows were embraced by the contract. He proceeded on the theory that a plow which would constitute an *infringement* of the patent, must fall within the contract to pay royalty. Hence the use of the term "infringed." Upon consideration of the plow exhibits and testimony before him, the court found as a fact in his opinion that the so called "Star" or "Berthiaume" plows and "Harris" plows infringed. This is a finding of fact and undoubtedly supports the judgment on this branch of the case.

The question of infringement is a question of fact.

Walker on Patents, Sec. 540 *and* 657.

The court below found infringement as an ultimate fact. His description of the "Berthiaume and Harris plows so designated" is confined to a few suggestions (page 141). It is error to suppose that the Berthiume patent issued in 1880, shows and describes the plow made by defendant below. The court nowhere so states, and such is not the fact. The setting up of that patent as the one under which defendant below was operating is claimed by defendant in error to have been a mere ruse. As the court below says, infringement by these plows of the Starling patent was manifest.

Errors 6 to 11 inclusive are that the court held or found that the several patents named do not anticipate the Starling patent. The question was that of novelty of the Starling patent and is again a question of fact found by the court. It supports the judgment and is not reviewable.

Jennison vs. Leonard, 21 *Wall.* 307.

"Anticipation is a question of fact and therefore not reviewable," nor can it "be brought up by objection to a ruling allowing evidence whose competency depends upon the non-existance of such anticipation."

Bischof vs. Wetherhed, 9 *Wall.* 812.

Curtis on Patents, Sec. 446.

Walker on Patents, Sec. 75.

But if the solution of the question of novelty could be brought here for determination, there is no exception upon which it can be based. No exception to any ruling of the court in the progress of the trial is taken upon that ground or that raises that question. These alleged "rulings" were made by the court in his opinion, concluding with an order for judgment. They are not "rulings" nor were they "in the progress of the trial" within the meaning of the statute. They belong to a period when *the progress of the trial* has ceased.

The case is submitted to the court and taken under advisement, and afterwards at his leisure, he privately

prepares his opinion, concluding with an order for judgment. This appears the fact by the record in this case (page 13). The trial is concluded, and case submitted January 25th and the opinion filed February 8th. The alleged rulings belong to a period when the court is performing the office of a jury, which is incapable of evolving "rulings" and can only find facts.

This court has said in a case tried below without a jury; "In ordering judgment for the plaintiff, certain propositions of law are announced by the judge as having been held by him. These are important only as they necessarily and of themselves affect the question, whether the facts found are sufficient to support the judgment, and they are no more important than if they had not been thus announced. *No specific exception is, or can be taken to them.*"

Jennisons vs. Leonard, 21 *Wall.*, 307.

See also Cooper vs. Omohundro, 19 *Wall.*, 65.

QUESTION OF VALIDITY OF STARLING PATENT.

There are further cogent reasons why the court ought not and cannot fairly review the question of the valadity of the Starling patent.

1st.—The alleged anticipating matter is contained in prior patents and depends on what is the outward embodiment of the terms and drawings contained in them. That is evolved by testimony and the testimony is conflicting. The court below was aided, too, by plow specimens at hand and by following the testimony of the witnesses before him in connection therewith. Returning voluminous evidence on the question of novelty can't convert this case into a chancery appeal.

Graham vs. Bayne, 18 *How.*, 62.

Boogher vs. Insurance Co., 103 *U. S.*, 97.

1 *Sanders Pleading and Evidence*, 640.

Parsons vs. Bedford, 3 *Peters*, 448.

The Abbotsford, 98 *U. S.*, 444, 445.

Saulet vs. Shepherd, 4 *Wall.*, 502.
Norris vs. Jackson, 9 *Wall.*, 127.
Dickinson vs. Planter, 16 *Wall.*, 250.

2nd.—The court in his opinion briefly mentions some of the differences in construction and mode of operation between the Starling and the other patents, but does not mention or purport to mention all of them, or all that controlled him in his determination.

3rd.—The court found as follows: "Neither of these patents have the combination of the plaintiff for the purposes described in his patent and do not anticipate the invention" (page 144). If the court went back of this finding of fact and reversed the same, it would have to find from the evidence the *fact* that the information contained in the prior patents "is full enough and precise enough to enable any person skilled in the art to which it relates to make the thing covered by the patent sought to be anticipated." The court's opinion below does not embody such a finding. When this court had stepped out of its province to find that fact, it could return within the sphere given it by the statute and find the patent is not novel.

Seymour vs. Osborne, 11 *Wall.*, 516.
Walker on Patents, *Sec.* 57.

4th.—The burden of proof of a want of novelty rests upon him who avers it, and every reasonable doubt should be resolved against him. Under this rule, a patent enjoys the same presumption of novelty, that an unconvicted prisoner does of innocence.

Coffin vs. Ogden, 18 *Wall.*, 120.
Walker on Patents, *Sec.* 76, *and cases there cited.*

5th.—To negative the novelty of Starling's combination, the prior patent must be capable of the functions and the mode of operation possessed by his combination. The court below finds the contrary.

Morey vs. Lockwood, 8 *Wall.*, 230.
Bates vs. Coe, 98 *U. S.*, 48.
Imhaeuser vs. Burke, 101 *U. S.*. 660.
Parks vs. Booth, 102 *U. S.*, 104.
Winens vs. Denmead, 15 *How.*, 330.

6th.—The court below has not found, nor could this court on review appreciate to what extent the improvements made by Starling enhance the utility of a sulky plow. The bill of exceptions does not contain nor purport to contain the testimony on the score of utility. This has a proper bearing upon the validity of a patent.

Loom Co. vs. Higgins, 105 *U. S.*, 580.
Clough vs. Barker, 106 *U. S.*, 166.
Clough vs. Mfg. Co., 106 *U. S.*, 178.
Seymour vs. Osborne, 11 *Wall.*, 516.
Cantrell vs. Wallick, 117 U. S., 689.
Seymour vs Osborne, 11 *Wall.*, 516.

7th.—The question of invention is distinct from that of novelty. The record does not purport to bring that question up. The case is not one where the court can take judicial notice of facts supposed to void the patent on that score, nor one in which the patent is void on its face. Invention is a question of fact.

Poppenhusen vs. Folke, 5 *Blatch.* 49.

8th.—It could not be reviewed here in any case without all the testimony bearing upon that question, including that as to utility of the particular combinations patented.

Smith vs. Vulcanite Co., 93 *U. S.* 495.
Hall vs. Wiles, 2 *Blatch.* 194.

9th.—The court below went into the question of novelty of the Starling patent because there was no recital or admission in the contract of license that plaintiff had invented this improvement and because the

plaintiff "joined issue on the defense of want of novelty set up in the answer" and did "not plead an estoppel." On the motion to dismiss, this court held the case was one "touching patent rights," because "the question whether that patent was valid, and whether it had been infringed, were put in issue by the pleadings and decided by the circuit court." But this court refrained from any decision whether under the *facts* in this case an estoppel upon defendant below to deny the validity of the patent existed and whether such estoppel was available under the pleadings. The matter of estoppel was little more than suggested in the briefs on that motion, with no attempt to present it fully. We now urge that this court cannot consider the question of validity of the Starling patent, because the consideration of that question below was error. (See record, page 45.) Plaintiff in error cannot base a ground of interfering with the judgment upon what was erroneously gone into on the trial.

10th.—We desire to make 3 points on this question of invalidity of the Starling patent.

a. The question of invalidity raised did not constitute a defense to the cause of action set forth in the complaint.

b. This matter is available under the pleadings in favor of the plaintiff below.

c. This is not affected by the alleged renunciation o the license.

(A.) INVALIDITY NO DEFENSE.

There are many cases in the circuit and state courts so holding. Colt J. in the district of Mass. in a recent case says: "The rule is now well established that the mere invalidity of the patent is not a sufficient defense to the payment of royalties under a license because the licensee may still continue to enjoy all the benefits of a valid patent. * * In other words, it is not enough for a licensee to prove that the patent is void, but he

must also show that he has been deprived of the benefits secured to him under his license."

McKay vs. Smith, 39 *Fed.* 557.

In the above case, Judge Colt refers to a number of cases, among others, to an opinion of Lowell C. J., in which the latter very carefully reviews the authorities. Judge Lowell's conclusion is that the mere invalidity of the patent is not a sufficient defense, but "that something corresponding to eviction must be proved, if a licensee would defend against an action for royalties."

White vs. Lee, 14 *Fed.* 789.

In some of the cases where invalidity of the patent has been sought to be interposed as a defense to a suit on a license contract for royalties, the ground upon which it is rejected has been spoken of as "estoppel," and in others that the matter in law *does not constitute a defense*. While these are different grounds, we would submit that both are correct. They present a double reason why the defense is not available. This court has recognized the double ground.

Kingsman vs. Parkhurst, 18 *How.* 293.

Where rights in a patent are conveyed to another and the latter agrees to pay a stipulated sum for each specimen made and sold, or made and used, "the invalidity of the patent would not afford a bar to the complainant's right to an account."

Kinsman vs. Parkhurst, 18 *How.* 289 (292).
Opinion by Justice Curtis.

Bartlett vs. Holbrook, 1 *Gray* 114.

Holding that a licensee in defense to a suit for accrued royalty on sales cannot deny the validity of the patents are—

Hyatt vs. Ingalls, 49 *Sup. Ct. N.Y.* 375.
Jones vs. Burnham, 67 *Me.* 93.
Marston vs. Sweet, 66 *N. Y.* 206.
Marsh vs. Dodge, 4 *Hun.* (*N. Y.*) 278.
Hall Mfg. Co. vs. American etc., 48 *Mich.* 331.

(12 *N. W.* 205).

Wilder vs. Adams, 2 *Wood & M.* 329.

That a licensee is estopped to deny validity of a patent by taking a license and operating under it for a time. And that there is no implied covenant by a licensor to protect a licensee from infringers.

National Rubber Co. vs. Boston etc., 41 *Fed* 48, (*Dist. of Mass.*).

That it is no defense to such a suit, that plaintiff is not the true inventor.

Birdsell vs. Perego, 5 *Blatch.* 251.

That a licensee while receiving benefits under an apparently valid patent is obliged to pay his royalties, and the invalidity of the patent is no defense.

McKay vs. Smith, 39 *Fed.* 556, (*D. Mass.*).

Covell vs. Bostwick, 39 *Fed.* 421. (*S. D. of N. Y.*)

March vs Harris Mfg. Co. 62 *Wis.* 276. (22 *N. W.* 516.)

Hyatt vs. Ingalls, 49 *Sup. Ct. N. Y.* 375.

Patterson's Appeal, 99 *Pa. St.* 521.

Angier vs. Eaton, etc. 98 *Pa. St.* 594.

Laver vs. Dennett, 109 *U. S.* 90.

Davis vs. Gray, 17 *Ohio St.* 330.

That the licensee cannot deny the validity of the patent, nor the title of the patentee while he is not interfered with.

Jones vs. Burnham, 67 *Me.* 93. (*See this case as to authority of Sexton vs. Dodge*, 57 *Barb.* 88.)

That where no fraud is practiced, one who agrees with full knowledge to pay royalty under a patent cannot afterwards deny its validity.

Eureka Co. vs. Baily Co., 11 *Wall.* 488.

That royalties on sales are due and collectable, although the patent is actually invalid, since benefit therefrom has accrued the licensee.

Smith vs. Stardand Laundry Co., 11 *Daly* (*N. Y.*) 154.

Marston vs. Sweet, 66 *N. Y.* 213.

Maston vs. Sweet, 82 *N. Y.* 526.

(*That Marston vs. Sweet above is erroneous on one point, see Walker on Patents, Sec.* 307.)

Although a patent may not be good for all it claims, a licensee having the benefit of it cannot take advantage of its invalidity in a suit for royalties.

Milligan vs. Lance etc., 21 *Fed.* 570. (*S. D. N. Y.*)

Although a patent may have been found invalid, that is no defense to a suit for royalty for the use of a machine, where defendant has used the machine and has not been evicted.

McKay vs. Jackman, 17 *Fed.* 641 (*S. D. N. Y.*).

That where an licensor sues the licensee for fees, the licensee cannot attack the patent unless he can prove eviction.

Rogers vs. Reissner, 30 *Fed.* 525 (*S. D. N. Y.*).

Where the licensor affirms the contract and is pursuing his remedies under it, the licensee is estopped from denying the validity of the patent.

Baltimore Car Co. vs. North Balt., 21 *Fed.* 50 (*D. of Md.*).

Burr vs. Duryee, 2 *Fisher* 283.

Forncrook Mfg. Co. vs. Barnum etc., 54 *Mich.* 552.

It is equally the English doctrine that the invalidity of the patent is no defense to an action to recover license fees.

Lawes vs. Purse, 88 *E. C. L.* 930.

Smith vs. Neale, 89 *E. C. L.* 67, 89.

Norton vs. Brooks, 7 *H. & N.* 499.

Hall vs. Conder, 89 *E. C. L.* 22.

Baird vs. Neilson, 8 *Cl. & Fin.* 726.

Trotman vs. Wood, 16 *C. B.* (*N. S.*) 479.

Taylor vs. Hare, 4 *B. & P.* 260.

Adie vs. Clark, 2 *Law Rep. App. Cas.* 423.

"That no warranty of validity of the letters patent is

implied in any license given thereunder." Also on the general subject see:

Walker on Patents, Sec. 307.
Robinson on Patents, Sec. 1252.

By above cases it appears that invalidity of the Starling patent was not a defense. That there must have been something equivalent to eviction, which was not true, nor was it pleaded. That the reason of the rule is that a licensee otherwise gets the benefit of what he contracted for, and a license contract does not imply any warranty that the patent is valid. That neither the rule nor its reason depends on any stipulation in the license not to dispute its validity or any recital that it is valid.

In some cases the licensor and licensee are considered as in the analogous position of landlord and tenant, and the principle of estoppel is applied, which may be held concurrently with the above view.

"It has sometimes been said that if the patent of the licensor is void, there can be no consideration for the contract, since a void patent creates no monopoly, and where there is no monopoly there can be no actual immunity. This position is, however, incorrect, for while the patent remains unimpugned by a decree of invalidity, the ability of the patentee to enforce it, and consequently the immunity from its prohibitions enjoyed by the licensee, are presumed to be legitimate and real. Hence it has been held in other and better considered cases, that if the patent is apparently valid, the licensee, under its assumed protection has enjoyed advantages of which, without the license, he would have been deprived, and that his obligations under the license continue until he is disturbed in his enjoyment by a superior patent, or until the patent under which he acts has been declared invalid or annulled.

Robinson on Patents, Sec. 1251.

(B.) IT IS AVAILABLE FOR PLAINTIFF BELOW.

If, as appears by above cases, invalidity of the patent is no defense to a suit for royalties agreed to be paid, then no *defense* on that score was pleaded by defendant below. If issue was taken on it, as pleaded, it was not a material issue, and the issue is immaterial here.

If we adopt the second ground, that a licensee is estopped to deny the validity, then this in no way invalidates the other ground, nor is the estoppel waived by joining issue in the reply, instead of "pleading an estoppel."

The pleading was under the code of Minnesota, which does not require matters of law, nor conclusions from facts to be pleaded, but facts only.

Statutes Minn. 1878, *Chap.* 66, *Title* 6.

The facts out of which the estoppel arose were pleaded, viz: the license contract, set forth in the complaint and admitted in the answer, and the making and selling of the plows by defendant below. (Pages 2, 3 and 7.) This is all that is required at most.

The complaint alleged that plaintiff "being the original and first inventor of a new and useful improvement" &c., that the Starling patent was issued to him, (page 1.) By the answer, "defendant denies that the said plaintiff was the original and first inventor of any new or useful improvement," &c. If this had been the only defense set up, the answer would have been bad on demurrer, without any pleading of estoppel. It is not "new matter" and calls for no reply.

Stat. Minn. 1878, *Chap.* 66, §100, *as amended Laws* 1879, *Chap.* 15, §1.

If it be treated as "new matter," in the answer, then the statute permits the pleading in the reply of "*any new matter, not inconsistent with the complaint, constituting a defense to such new matter in the answer.*" *But the facts "constituting a defense to such new matter in the answer" had already been pleaded in the com-*

plaint, viz: the relationship of licensor and licensee, and plaintiff could but repeat at most, the facts he had already pleaded. This he did in the words, "Wherefore plaintiff reaffirming his said complaint, asks judgment as in said complaint prayed for." (Record page 10.) To have added further to the reply "and defendant is estopped by the facts set forth in said complaint to deny the validity of said patent granted to "Starling," would have been pleading a mere conclusion of law, and would be bad pleading.

By the law of Minnesota, which controls the matters of pleading in this case, (Revised Statutes U. S., sec. 914.) facts which are to be invoked by way of estoppel, do not have to be set out as such. You do not have to attach a card to each fact pleaded: "This fact is to be invoked by way of estoppel," or "This fact is to be established by other facts creating an estoppel."

Caldwell vs. Auger, 4 *Minn*, 156 (217).

Coleman vs. Pearce, 26 *Minn.* 123.

In *Caldwell vs. Auger*, the court says:

"It is claimed by the counsel for the respondents, that under the code an estoppel *in pais* should be pleaded, in order that it may be given in evidence. It is not claimed, nor is it true, that this was necessary under the old system of pleading. Nor do I find, either on principle or authority, that such pleading is required under the code. The principles of pleading under both systems are the same. The facts upon which the parties relied, were not less required to be pleaded under the old system than under the new."

In *Coleman vs. Pearce*, the court says:

"In answer to the first point made by the defendant in support of the order, it is sufficient to say that in *Caldwell vs. Auger*, 4 Minn. 156, (217) it was expressly decided that matter constituting an estoppel *in pais* need not be pleaded as such, to enable a party to take advantage of the estoppel on the trial, and this rule has

never since been questioned in this court." Such remains the law of Minnesota and establishes a rule stronger than is necessary for this case.

Take the matter this way for instance; The complaint alleges that Starling was the first inventor of the patented plow and that it was new. The answer denies these facts. (Page 6.) *Under the law of Minnesota those facts are established against defendant, even contrary to the truth, by any facts constituting an estoppel, without pleading the latter facts. These cases hold that ownership of property and conversion of property respectively may be proved by estoppel by simply alleging ownership or conversion in the complaint and no more.* But in the case at bar, plaintiff below went much farther, and alleged in his complaint the facts which constitute the estoppel in law, *and reaffirmed them in his reply.*

Caldwell vs. Auger, 4 *Minn.* 156 (217.)
Coleman vs. Pearce, 26 *Minn.* 123.

The matter of invalidity of the Starling patent was gone into on the trial, against the objection of defendant in error.

(See record page 45.)

(c.) THE RENUNCIATION ALLEGED DON'T AVOID ESTOPPEL.

There is nothing in the alleged renunciation of the license by defendant below to change the rule binding it on this question of validity of the Starling patent. There is no claim that the Starling patent is invalid as a ground upon which it was renounced, or that defendant below purposed to manufacture in hostility to it, or that it had been compelled to pay tribute to a prior patentee, or that it had been in any manner evicted. If it had been evicted from what it bargained for, it perhaps, could have given notice that it renounced the license and would thereafter make in hostility to the patent.

Then if the patent turned out invalid, it might have escaped from subsequent royalties but not from prior royalties.

But the ground of the alleged renunciation (page 9) is quite the opposite and is simply and solely that the construction of said sulky plow under plaintiff's patent was "unsatisfactory and useless," and it, "*at the same time gave notice that said defendant corporation would thereafter manufacture a sulky plow of its own design and renounce its license and all claim of right to construct plows in accordance with the patent.*" (See answer on page 9 and bill of exceptions, page 29.)

This amounted to a continuing recognition of the validity of the Starling patent, for in connection with its renunciation of the license it also says it renounced "all claim of right to construct plows in accordance with" that patent. It had no intention of assuming a position hostilie to Starling's patent, it said, but would make a different plow. Then it proceeded to make a plow so near identical with what it made before, that the court below finds it was a "manifest" infringement, and that the Starling plow is not useless as alleged. Evidently it had blundered at first in the manner of making them, if its statements are true, and was just finding out how.

We will have something to say upon the right of defendant below to annul the contract, by this renunciation, in considering the 3rd error assigned. But assuming for the present that the contract remained in force, such alleged renunciation could not prevent the application of estoppel, or the rule that invalidity was no defense.

The foregoing is not to be understood as a confession that Starling's patent is anticipated by the patents set up or invalid. We affirm the contrary, with the force of positive conviction, but decline to dis-

cuss a question so manifestly beyond the rulings falling under this writ of error.

LICENSE RENOUNCED.

Errors III, XVII and XVIII.

(Pages 168 and 172.)

Plaintiff in error claims that it had the right to terminate the license contract by a notice, and if was error for the court to rule that the defendant below could not terminate the license without the consent of Starling.

Answer page 9.

Bill of exceptions, page 29.

Opinion of Court, page 141.

The contract has no provision for its termination or for renunciation. The Plow Works distinctly bound itself to do several things:

1st.—"To make said sulky plows in a good and workmanlike manner."

2nd.—To "advertise" them, "in the usual manner."

3rd.—To "sell" them in the usual manner.

4th.—To render accounts and to pay royalties.

(Contract page 3.)

It agreed to do this in consideration of the license given it under the Starling plow patent, and also in consideration of a license given it under another patent to Starling, No. 151,804 for whiffletrees, by the same instrument, which in no manner has been attempted to be impeached. On the ground by which it sought to renounce the contract, the court below has found against it. The court finds that the Starling plow is useful and that it is not true that its construction is "unsatisfactory and useless." When made by others it had been satisfactory and useful to a marked degree as appeared by the proof.

The plow works continued without interruption after the alleged renunciation to make the plow in almost

identically the same from. These it admits were satisfactory and useful.

The ground of this alleged renunciation then, must have been either a huge blunder, or else one known by the Plow Works to be false and a pretense to avoid doing what it had agreed to do.

If one party to the license contract could terminate it, then the other could; and the same shoe put upon the other foot might have pinched very hard.

The position of plaintiff in error seems to be that a mere license grants no continuing rights and is revocable at will and may be abandoned at pleasure. True, "a mere license" may grant no continuing right. But a contract of license under a patent is more than a mere license that is revocable at will.

A licensee is granted certain privileges under the license contract and assumes certain liabilities in return therefor. He is not then allowed after he has enjoyed the privileges to throw off his contract liabilities and stand in the position of one never possessing any of those privileges.

A license is not revocable except by mutual consent or by fault of the parties unless it contains a stipulation providing for revocation.

Kelly vs. Porter, 17 *Fed.* 519.
National Rubber Co., vs. Boston &c., 41 *Fed.* 48.
Marsh vs. Harris, 62 *Wis.* 276 (22 *N. W. Rep.* 516).

A license unlimited as to time runs for the entire term of the patent.

Kelly vs. Porter, 17 *Fed.* 522.
Hodge vs. H. R. R. R., 6 *Blatch.* 165.
Pattersons Appeal, 99 *Penn. St.* 524.
Paper Bag Cases, 105 *U. S.* 771.

When a license is forfeited by the act of a licensee as by repudiating the same or other act effecting such result, and the licensee continues to make specimens of

the article covered thereby the licensor has an option to sue him as an infringer or to sue him for promised royalties.

Woodworth vs. Weed, 1 *Blatch.* 166.
Cohn vs. Rubber Co., 3 *Bann. and Ard.* 572.
Union Mfg. Co. vs. Lounsbury, 42 *Barb.* (*N. Y.*) 125.
Union Mfg. Co. vs. Lounsbury. 41 *N. Y.* 363.
Walker on Patents, 309.
Union Paper Co. vs. Nixon, 105 *U. S.* 771.
Patterson's Appeal, 99 *Penn. St.* 524.

In *Woodworth vs. Weed*, by the terms of the license it became forfeited on failure to pay any note given for the license at maturity. Such failure having occurred and the licenses forfeited, Nelson J. held "it was optional with plaintiff to resort to his remedy at common law to enforce the collection of the notes, or to treat the rights of defendant as forfeited," and proceed as for infringement, seeking an injunction.

Woodworth vs. Weed, 1 *Blatch.* 166.

In *Cohn vs. National Rubber Co.*, the defendant's licensees had refused to perform on their part and had repudiated the license. Judge Clifford held, that in such case, "they may be treated by the owner of the patent at his election, as infringers. He may have his remedy by suit upon the license, in case they have repudiated the license, or he may elect to treat them in future as infringers of his exclusive rights under the patent.

3 *Bann. & Ard.* 568.

Union Mfg. Co. vs. Lounsbury, was a case where the licensors served upon the licensees a notice alleging a breach of the license by the licensees, and forbidding the defendants to use or exercise the right granted by the license for any purpose whatever.

The defendants licensees, thereupon refused to pay royalty, but continued to make and claimed that right free of their contract to pay royalty. The plaintiffs

licensors, took no step afterwards towards rescinding the agreement under which the tariff or royalty occurred. There seemed to have been no mutual agreed rescission of the license. The court maintained the action on the license contract, against the objection of defendant.

Union Mfg. Co. vs. Lounsbury, 42 *Barb.* (*N. Y.*) 125.

No recission of a license should take effect, as against both parties, until judicially declared, except in accordance with the express terms of the license itself, or by mutual consent. Where one party attempts to rescind, then the other may acquiesce therein and thus effect such recission; but if he do not see fit to acquiesce, we cannot, on principle, see why a party to a license contract should be coerced by the act of the other party to terminate that contract, any more than to terminate a contract by which land is leased to another. On any supposed ground for terminating the contract, as fraud and misrepresentation &c., the party so claiming ought to be required to bring his action to have it judicially determined before he should be permitted to say that his subsequent acts are not done under the contract. If a licensee continues to make and sell a machine which is covered by the license, after he has said he will make no more and has renounced his license, on a suit for the royalty, the licensor should not be required to try collaterally whether there was a right to make free of the license and in his own right, any more than a landlord who sues a tenant for rent, when the latter claims the right to occupy free, and in his own right, should be required to try the latter claim in a suit for rent.

In the case at bar the Plow Works had, on the ground that the plow was unsatisfactory and unsaleable, *given notice it would make no more*, and renounced the license. (Answer paragraph 7th, page 9.) That is, it said it would move off the land it had been occupying. But it

did not. It continued in possession. It run a simple open ditch from a pond of water so as to drain it and then said "all is satisfactory and lovely now, but this is my land, and everybody's land." The law says "Hold on, you can't say that. There is a contract of letting which you signed, accepted and occupied under." "True," says the tenant, "but that it all gone. I told you I was going to move off because the land was too wet." "Yes," says the landlord, "but you didn't move off. You continued to occupy and use that land right along." The tenant can answer only, "The ditch has been in there ever since, anyway, and I have been calling it the 'Star' farm instead of the 'Starling.'"

No lawyer could contend, that such a notice followed by such conduct and continued use of the property, would give a tenant any right to set up title in himself or others. No more can the licensee under a patent *prima facie* valid, who so conducts himself.

In this illustration we have stated the case most favorably for the Plow Works. For the moment we have conceeded that there was something unsatisfactory in the Starling plows as at first attempted to be used by it, but which could be and was remedied by using simple and obvious means. But the facts are the contrary. The court found that exact construction operative and useful. Witnesses who had used some of those first plows made before the notice was given, were on the stand and testified that the plows worked well, and did good work, only they were not well finished, and seemed carelessly put up. There was no basis of truth then for the alleged "renunciation" it made. It was not shown that the Plow Works ever claimed to anybody that it was not making these plows under the Starling patent. *The fact is that it did not renounce its license. The court simply found that it "gave notice"* that it renounced its license. The fact which the court finds is a naked *notice*. That is true, and is quite different from an ac-

tual, accomplished renunciation. There is all the difference there was between the two sons in doing the will of their father, to work in his vineyard. The Plow Works is like the one who said, "I go sir," and went not. It is the tenant of land saying, "I will move and live on another piece of land, and renounce my lease," but not moving. Such conduct can be the basis of no change in the contract relations of the parties. *The court below finds no fact as the basis of a right to renounce the contract, nor that it was in fact renounced, but simply that a naked notice was given followed by opposite conduct. The contract continues, and with it all its force and effect, including estoppel and obligation to pay the promised compensation. The contract is a unit, and its living principles cannot be torn assunder while it has life.*

LICENSE NOT EXCLUSIVE.

It was contended below that there was a difference in the law applicable to this case, because the license is not exclusive. We do not find such a distinction made in the cases, nor on principle sound. A patent represents an exclusive monopoly. A licensee not exclusive gets a share of this; an exclusive licensee gets nothing different. He only gets more of the identical same substance. One is a sole tenant and the other is tenant in common with others, who may exercise the rights protected by the patent. The latter can no more terminate his contract of lease at his option, or dispute his lessors right, than such a tenant of land or a sole tenant of land. Cases of parol licenses as to land do not apply. It is the policy of the law as to conveyances of lands or interests therein, that it must be done by instruments in writing and usually under seal. Hence a *parol* license to make use of lands for any purpose, is given effect only as long as

the owner sees fit. But the same privileges duly given by deed in writing upon consideration, would be irrevocable. Nor does it turn upon the question of the exclusive character of the privileges given. A privilege as to land exclusive in character, given by parol, is equally revocable with one not exclusive.

Johnson vs. Stillman, 29 *Minn.* 95.

In a case of a license exactly as the present, *not exclusive*, the licensor was restrained by injunction from attempting to declare the license terminated or revoked.

Baker Mfg. Co., vs. Washburn & Moen, 18 *Fed.* 172, *by McCrary, J.*

This court has refused to permit a licensee, under a license *exactly like the one in question*, to terminate it.

Laver vs. Dennett, 109 *U. S.* 90.

And it is held that licenses *not exclusive*, under letters patent, are not revocable except by mutual consent, or by fault of the parties.

Cases above cited.

Kelly vs. Porter, 17 *Fed.* 519.

National Rubber Co., vs. Boston, 41 *Fed.* 48.

Marsh vs. Harris, 62 *Wis.* 276.

We add other cases, heretofore cited, in which the license was *not exclusive*, and this fact made no different rule on the question of estoppel to deny the validity of the patent or of the right to terminate the license.

Union Mfg. Co. vs. Lounsbury, 42 *Barb.* (*N. Y.*) 125.

McKay vs. Jackman, 17 *Fed.* 641.

Eureka Co., vs. Baily Co., 11 *Wall.* 488.

Jones vs. Burnham, 67 *Me.* 93.

MaKay vs. Smith, 39 *Fed.* 556.

National Rubber Co., vs. Boston, 41 *Fed.* 48.

White vs. Lee, 14 *Fed.* 789.

BERTHIAUME PATENT.

Error XII.

If the court below had found that Starling's patent anticipated Berthiaume's later patent, it would have been a finding of fact and not reviewable and also immaterial. Such finding is the error assigned, but he made no such finding. This patent is an interloper in this case. *It does not show or describe any one of the* 1310 *plows made by defendant.* It is one of the ear marks of the false and fraudulent design to pretend to make another plow. It was born because its life was wanted to give a supposed standing before the public or some unsuspecting court in case they were called upon to pay for the so-called "other plows," which had the failing of not being "other plows."

The so-called "Berthiaume" plows obtain that name as the "Harris" do in this case, not from any patent, but the name of the foreman or superintendent in the St. Paul Plow Works shops, who designed the so-called changes, and as a mere matter of convenience. There is no finding of the court that any of the 1310 plows are like that patent. These "Berthiaume" plows were sold under the name of "Star" plows. (Answer, paragraph 5, p. 8. Opinion, pg. 14.)

A licensee, when sued on the license, cannot defend by setting up rights under a subsequent patent to justify his non-performance of duty or question the validity of plaintiff's patent, unless he shows fraud in the plaintiff.

Forncrook Mfg. Co., vs. Barnum etc., 54 *Mich.* 552. (20 *N. W.* 583) *by Cooley, C. J.*

HASLUP PATENT.

Error XIII (*Page* 165.)

It is claimed as error that the court found the Haslup patent does not anticipate Starling's. This patent has no right to be in the record. It first made its appearance

on the motion for a new trial below as newly discovered evidence. The court refused the motiou for a new trial, and in his opinion says it does not anticipate (page 24). This is not reviewable for many reasons. It is not a "ruling" nor in the "progress of the trial," nor has it been excepted to. Moreover the court could not review this without reviewing the refusal to grant a new trial.

But a refusal to grant a new trial is not subject to review by this court.

Cooper vs. Omohundro, 19 *Wall.* 65.

Such a review is not within the powers conferred by the act under which this appeal is authorized.

Section 700 *R. S. U. S.*

OFFER OF EVIDENCE AS TO PATENTS.

Error XIV (*Page* 139).

This is based on an exception to a ruling of the court refusing an offer of testimony. The testimony offered was further explanation of the patents set up in the answer, made late in the case.

When plaintiff below rested his opening case, these patents, except Starling's, had of course not been introduced (page 54). If we regard the validity of the Starling patent as at issue, proof on that point was made out by his letters patent, *prima facie*, and plaintiff rested. Then defendant below took up its defense, introduced the alleged anticipating patents against plaintiff's objection (page 45), and proceeded with an exhaustive expert explanation of their views of these patents—how they operated—how the different parts were related—why they were substantially the same as Starling's, in their opinion. In short went into their full case as to why they believed these to anticipate Starling, by three expert witnesses, Woodward, Haupt and Harris.

Record, pages 45 *to* 100.

Then plaintiff below went into the subject of these

patents by way of rebuttal, to show why they did not anticipate, using two witnesses, Gunckel and Starling, (pages 101 to 138). Then it was that defendant made their offer of further evidence to show why they were right and plaintiff below was wrong, in the testimony given. The court refused the offer "stating he had heard sufficient testimony to enable him to understand the action of the several devices" (page 139).

The trial had already consumed over 5 days (pages 11 to 13), during which much more time had been consumed on those patents by defendant than by plaintiff below. An examination of the testimony will show that the points proposed to be proved, had already been covered and gone over at the proper time by the three expert witnesses of defendant below, who claimed to find the same combinations working in the same way, (pages 45 to 100). But if the points had not been included or specifically mentioned in defendant's main case the time for defendant below to make out a case of invalidity, was before it rested its testimony on that matter. Thereafter it was discretionary with the court whether it permitted defendant below to go into the question.

Plummer vs. Mold, 22 *Minn.* 15.
Beaulieu vs. Parsons, 2 *Minn.* 37 (26, 30).
People vs. Mather, 4 *Wend.* (*N. Y.*) 229, 249.
Farmers Ins. Co., vs. Bair, 87 *Pa. St.* 124.
Thompson on Trials, *Sec.* 349.

Where a defendant has had the opportunity of introducing the same evidence in his case in chief, the court's refusal to permit him to put it in by way of surrebuttal is not error.

Asay vs. Hay, 89 *Pa. St.* 77.
Thayer vs. Davis, 38 *Vt.* 163.

The mode of conducting trial, the order of introduction of evidence &c. belong to the practice of the circuit courts and the supreme court will not interfere.

Phila. R. R. Co., vs. Stimpson, 14 *Pet.* 448.

Johnston vs. Jones, 1 *Black*, 209, 226.

The only remedy for surprise is a motion for a new trial, and its decision is not reviewable here.

Mulhall vs. Keenan, 18 *Wall.* 342.

After several days' testimony on the subject it may be fairly presumed the court was able to understand these patents, and no refinement should be resorted to to enforce a needless and wearisome lengthening out of the matter.

Moreover the position we take that invalidity of the Starling patent was no defense and defendant below was estopped to show it, disposes of this alleged error.

This tilting up of the point of the plow and locking the plow in the ground appears in plaintiff's opening case both direct and cross examination as follows: Record, marginal pages 70, 81, 84, 90. This was sufficient to apprise defendant below that it would be claimed that an alleged anticipating patent must possess these points and to warn it to make its proofs on those points when it reached its defense in chief.

This it proceeded to do but was anxious for another bout on surrebuttal. The following are some of the pages of the record where it appears defendant below had already gone into the specific points: Record, marginal pages 99, 105, 112, 113, 114, 122, 123, 128, 136, 137, 143, 144, 178, 180, 181. It would seem to have been pretty well elaborated by defendant below already.

EVIDENCE ON PRICE OF PLOWS.

Error XV (*Record Page* 139).

Defendant below offered to prove on surrebuttal that C. A. Carter in 1876 at Princeton, Ill., sold *"substantially"* the so called Berthiaume plow for $45, when a plow *"substantially"* the Starling plow had no sale in competition at the price of $25. The court sustained the objection of plaintiff below, that such evidence was immaterial. (Page 139.)

This offer is qualified by the word "*substantially.*" The court found and the fact is that the so called Berthiaume plow, is substantially the Starling plow. This offer then, amounted to one of proof that one party could sell a plow for $45 while another could not sell "substantially" the same plow for $25 which was immaterial.

But if they were different plows and one was made *exactly* as the 960 made by the Plow Works, and the other was the Starling plow *exactly*, such evidence would not tend to make out any issue in the case. It would not be proper evidence on the question of whether the Starling plow was useful as contended by plaintiff in error. That fact should be established by direct evidence of how the Starling plow operated in the field The party or parties who sold the Starling plow in competition may not have been competent salesmen and Carter may have been an extra good one. The party or parties who attempted to sell the Starling may have been of bad reputation or unpopular, so that the people of the community would not be willing to purchase of them even a good article, and Carter on the other hand may have been well known and popular. The court could not go into an inquiry as to all these matters to see whether any weight was to be attached to the circumstance.

Moreover it was too late in the case to insist on their right to further testimony on the question of utility of the Starling plow. Defendant below went into the question on their main case in defense, and it was now discretionary with the court to admit even proper testimony on that issue on defendant's surrebuttal.

See cases under error 14.

The court was in no way partial, for it refused to permit plaintiff below on rebuttal to go into matters belonging to his case in chief, as to the mode of operation of plaintiff's first claim. (Record page 138.)

EVIDENCE ON PRIOR USE OF LEVER.

Error XVI.

(Record page 101.)

Defendant offered to prove that the lever device shown in the Starling patent was used on two sulky plows prior to 1872. (Page 101.)

1st.—This in itself was immaterial if true. He did not offer to prove that it was combined with the same or substantially the same elements in such way that such combination operated in the same way for the same purposes as in the Starling first claim. The mere existence of that element in some other device with different relationships and associated parts or functions would not tend to make out anticipation.

2nd.—It was incompetent, because the fact was not pleaded in the answer, nor plaintiff otherwise notified. If validity of the Starling patent was a proper issue, plaintiff below had a right to know what matters would be set up to defeat his patent, so as to defend his rights, otherwise a licensor would be at the mercy of a licensee whom he sued for royalties. In case of actions at law or in equity for infringement, the manner in which the notice is to be given is provided for by section 4920 revised statutes U. S. This act does not create the right to such notice, but directs and regulates how it may be given. The right would subsist under any rational form of pleading, and since the code pleading is modeled on that of equity, we must look for it in the answer.

Of course where there are no averments to authorize proof offered, it is properly rejected.

Wilcox vs. Hunt, 13 *Pet.* 378.

In a suit on a license contract, novelty cannot be considered without "notice of the witnesses or other evidence" to be used to impeach the patent.

Evreka Co. vs. Bailey Co., 11 *Wall.* 492.

But strange to say this identical matter had thereto-

fore been brought out on cross and re-direct examination from the same witness and as to the identical same plows, Deere & Buford, now proposed to be testified about, and he testified, those levers did not work "the same" nor "substantially the same," but merely operated to engage a "wheel lift" or "horse lift." (Record page 98.)

HARRIS PLOW TESTIMONY.

Error XIX.

(Record page 44.)

It is alleged as error that the court refused to strike out the testimony of plaintiff below with reference to the Harris plow. This evidence was given for the purpose of showing that the Harris Plow, so called, fell within the license contract. Whether under the evidence it did, was a question of fact for the court to decide. In no view could it be error unless on the whole evidence it appeared that there was nothing tending to show that the Harris plow would constitute an infringement of the Starling patent.

But this court could not review this question without reviewing a question of fact, and in any event this record does not contain plaintiff's evidence with reference to the Harris plow. (See judge's certificate, record page 145.) Moreover the court in his opinion says, as the fact is, that the Harris was "*substantially the same*," as the Berthiaume so called, and both "*manifestly* infringed" the Starling. (Record page 141.)

EVIDENCE AS TO DATE OF INVENTION.

Error XX.

(Record page 139.)

It is contended it was error for the court below to permit plaintiff to introduce evidence of the date of the Starling invention on rebuttal. The court does not in

any way take account of this testimony in deciding the case, and the mere admission of erroneous testimony by the court when being tried without a jury would not be error, unless it appeared that such evidence influenced the result of the case. Otherwise it is presumed that the court laid it aside.

But it was not error to receive and consider such testimony. On the question whether a prior patent anticipates one sued on, it does not anticipate, although identical, unless it is prior to the date of reduction of the plaintiff device to working form, and the plaintiff is permitted to rebut the proof of anticipation by showing the date of invention.

Elizabeth vs. Pavement Co., 97 U. S. 130.

Loom Co. vs. Higgins, 105 U. S. 580, 592.

National Spring Co. vs. Union &c., 12 *Blatch.* 80, 96.

The plaintiff is not required to allege the date of his invention in order to introduce proof thereof when the circumstances call for it.

Wilder vs. McCormick, 2 *Blatch.* 33.

Byerly vs. Cleveland, 31 *Fed.* 73.

On principle this is correct, for the letters patent themselves pleaded apprise the defendant as to who claims to have been the inventor, and where he resided at the time of his application, so that defendant is directed to the means of discovering the date of invention and can prepare himself to prove the existence of anticipating matter prior to that date, if he sees fit to set up that defense. It is quite different as to pleading the defense of use of the patented machine *by others* prior to the invention thereof by the patentee. Unless this be pleaded fully or notice be given under the statute, plaintiff would have no means of preparation in advance.

In the case at bar, the present residence of the inventor was also given, and he is alleged to be the original and firs tinventor of a new apparatus. The latter is recom-

mended by Walker on patents as necessary in suits on patent rights. (Walker on Patents, Sec. 424). Plaintiff below then had a right to prove the fact he alleged; Proof on that fact, except as established *prima facie* by the patent, was immaterial, till defendants patents were introduced. Hence it properly belonged to plaintiff's rebuttal, subject to defendants right to follow by its evidence on that point. We claim that first invention was made out by estoppel, as against this defendant on plaintiff's opening case. But conceding for the moment that it belonged to plaintiff's opening case, wholly, and the court permitted later in the trial, then that was wholly discretionary with the court and not reviewable.

See cases cited above under error 14.

WHAT PLOWS ARE COVERED BY THE LICENSE.

In the consideration of this case below defendant asked to have the words "Starling Sulky Plow" in the contract of license so control it as to make it mean something else than the ordinary license under a patent.

We shall show:

First:—That such construction is not reasonable.

Second:—That defendants below themselves have admitted and construed it to be the ordinary license under a patent.

Third:—That in such case the contract of license calls for the payment of the stipulated royality as to every specimen which would otherwise be an infringement.

1st.—It is a common practice for the name of the inventor to be applied to the device covered by his patent. It is the "Bell Telephone" the "Edison Telephone," the "Worrall Plow," the "Starling Plow," and by the use of these terms parties mean simply to designate the particular device or form of machine shown in their respective patents. That is the common, ordinary meaning of such phrases.

Nor does the contract stop with this phrase. It proceeds to designate the patent, under which the license is given. With what show of fairness and good faith could Starling have thereafter claimed that he had not given defendant a full license under his patent?

Or if, for the sake of argument we should adopt the new position of defendant, and say it was a license to make the "Starling Sulky Plow" as made by the Princeton Manufacturing Co.—like the plow sent them; then we say that was a plow made in exact accordance with Starling's patent,--so conceded on all hands, and we are in the same position as before. If the expression "Starling Sulky Plow" in the contract meant a plow which was not constructed in all respects like the patent, there might be a slight difference as to the position in which defendants would be placed by the license. There is no difference whatever between the "Starling Sulky Plow" shown and described in the patent mentioned in the license, and the "Starling Sulky Plow" made at Princeton, and which defendants purchased. So the construction suggested by defendants could not change the case.

2nd.—But defendant below has always understood this license to mean the ordinary license under a patent. In the answer (see answer, paragraph 4th, page 7), with reference to the license, defendant "avers that the only contract effected between the parties was that the defendant should manufacture and sell some sulky plows *according to the plan of said plaintiff's patent* in a good workmanlike manner" &c. Not a word about its being according to the plan of some plow sent defendant, or some plow known to the public as the "Starling Sulky Plow." Again defendant expressly admits the plow of the patent, and the plow of the license to be identical in paragraph 5th of the answer, page 8.

The fact is that the purpose of defendant below in purchasing a specimen of the Princeton Manufacturing

Co. was to enable them to procure patterns from which to work under their license, with one tenth the cost, trouble and expense that would be required if they merely took the patent and worked these out for themselves. Starling in one of his letters in evidence said in substance that defendant ought fairly to allow the Princeton Co. some compensation for their free use of the patterns worked out by the Princeton Company.

3rd.—Counsel for defendant below said that defendant did not agree not to make other sulky plows. True, but it did agree to pay royalty on such plows as the license covered; and the license covered whatever would be an infringement of the Starling patent. Otherwise the license was not a license. The trouble with the so-called "other sulky plows" is that they were not "other sulky plows."

But defendant below claimed they were not Starling plows, because they did not contain all the three claims of the patent. That is, his proposition is this: "The contract of license does not relate to or cover any plows except such as contain the three claims." If this be true, then if defendant the next week after the license was given, had made and sold a plow to some farmer who did not wish any rolling coulter (the subject of Starling's 3rd claim),—a plow made in every respect as the Starling plow, only not provided with the coulter, plaintiff might at once have sued both the plow works and the farmer for infringement of his patent. It would have been useless for the farmer to say, "I bought my plow of a firm whom you licensed to make and sell plows containing every claim of your patent, containing every claim that I use."

Plaintiff's only answer would have to be, "You are greatly in error, sir; the greater does not include the less."

Now if the license gave defendants the right to make and sell plows containing but one or two of Starling's

claims, as well as those containing three, then defendant below agreed to pay license on all plows containing one or two of the claims. If defendant got the right, it must pay the compensation. The agreement of defendant is to pay $2.50 "for each and every plow sold."

There is but one royalty agreed to, and that is to be paid for "every plow sold," which defendant below had a right to make and sell under the license. If a plow given contained Starling's first claim, then defendant had a right to make and sell it under the license. If covered by the license, it became one in the list of "every plow sold" for which defendant was to pay $2.50 whether containing one or the three claims.

The royalty extends to "every plow sold" and "every plow sold" by the defendants had only the natural limitation that it should be a plow which the license covered, whether it contained one or more of the claims. The parties chose so to contract and not provide a different royalty for a case where a plow contained less than the three claims. If the parties had intended otherwise, they certainly would have so provided by the contract. But we do not understand this proposition is contested as to a suit on the license. A large proportion of the patents issued contain more then one claim, but we have never known a case of a license where any difference was made as to the royalty to be paid in case of including less than all the claims in any specimen.

We may add in this connection that the case cited by defendant's counsel below, *Burr vs. Duryee*, 2 *Fisher* 275, is in point as to what a license covers. There was this difference, that license was for *use* merely of a machine or rather of *two specimens of a patented machine and no more.* The court held that that contract of license was not violated by the use of any more machines unless such further machines infringed the patent under which the license was given. It turned entirely

upon the point whether such further machines did or did not infringe. Now if a license under a patent to use *two machines and no more*, means but two whether made like the patent exactly, or only so as to infringe it, *a license to make and sell plows, means a license to make and sell such plows as are exactly like the patent or such as would infringe it.*

The test of whether machines come under a license contract or not, is *whether they "contain matter covered by the patent."*

Eureka Co. vs. Baily Co., 11 *Wall.* 492.

4th.—Counsel contended also, that Starling should have been driven to an action for infringement to recover for these plows, because to sue under the contract would compel defendant below to pay too high a royalty unless it used all three claims in each specimen. If such a rate is too high, it may be a reason why the Plow Works should have made a different contract for the use of less than all the claims. It has no further force.

Put it this way; Defendant continued to use the claim or claims he regarded most valuable. Even a license fee established on a patent of more than one claim, is conceded to be a measure of damages in a suit for infringing *one*, where it appears that the latter is the one of prime importance which gives the patent its royalty value in the market. Starling granted a number of licenses besides the one in question, and there was an established royalty. If it were a material matter, then there would be no difference in recovery on a suit for infringement.

We ask that the judgment be affirmed, and that the writ of error be dismissed.

CHARLES S. CAIRNS,
Attorney for defendant in error.

Minneapolis, April 1st, 1891.

UNITED STATES CIRCUIT COURT FOR THE DISTRICT OF MINNESOTA.

WILLIAM STARLING,

Plaintiff,

vs.

ST. PAUL PLOW WORKS,

Defendant.

Testimony of Henry Robinson of Lennox, in the state of Iowa, taken before N. P. Nelson, a notary public, by the virtue of the stipulation, copy whereof is hereto attached as stated in the return thereto.

Int. 1. State your name, age, place of residence and occupation.

A. Henry Robinson, age 61 years, Conway Taylor Co., Iowa, keeping hotel.

Int. 2. How long and where have you been engaged in farming?

A. 12 years in the town of LaPrarie, Marshall county and state of Illinois.

Int. 3. How many years experience have you had in practical use of plows, if any?

A. 12 years.

Int. 4. Are you acquainted with William Starling, the plaintiff in this action?

A. I am.

Int. 5. State whether you are acquainted with the sulky plow for which Starling, plaintiff in this action, procured a patent from the United States about the 18th day of August, 1884, which plow is called and will be referred to in these interrogatories as the "Starling Plow."

A. I am, but my recollection now is that patent was issued in 1874, during the whole time he was inventing, perfecting his plow and obtaining patent for same, we were near neighbors.

Int. 6.—If you ever used the Starling sulky plow, state when and where it was.

A. In 1876, at La Prairie, Marshall county, Illinois.

Int. 7.—Where and by whom was the Starling plow which you used (if any) made?

A. At Peoria, Illinois, by the Peoria Plow Company.

Int. 8.—State whether you have a correct drawing, picture or representation of the said Starling plow used by you, and if so, you may hand it to the person or commissioner taking your testimony and have him annex it to your deposition, marking it Exhibit "A."

A. I have, and it is marked Exhibit "A" and herewith attached.

Int. 9. State whether the Exhibit "A" attached to your deposition is a true representation of the said Starling plow used by you, and if not, state in what way or particular it is different.

A. I should say that it was an exact representation.

Int. 10. Describe the character of ground and soil in which you used this Starling plow, and relate the facts which led to your using it?

A. In the fall of 1876, while living at La Prairie, Ills., I had a piece of ground to plow, that was wet in the spring and failed to make a crop, but a large growth of weeds grew on the ground which I desired to plow under in the fall; I was the owner of a Skinner gang and sulky plow, but could not do the work satisfactory with them, as the ground had become quite dry and hard and could not keep the plow in the ground. I borrowed a Starling sulky plow, and done the work in a good workmanlike manner, turning the weeds well under for the reason that the lever of the Starling firmly locked the plow in the ground so that the entire weight of the plow, the carriage and the plowman were all used in holding the plow in the ground, which was not the case with the Skinner plow, as the weight of the Skinner plow was all there was to hold it in the

ground, and was easily thrown out by a large growth of weeds or when the ground was unusually dry and hard.

Int. 11. What kind of work did this Starling plow which you used, do in the kind of ground and soil in which you used it?

A. It done good and satisfactory work.

Int. 12. If you ever used or saw said Starling plow used in ground where it was difficult to get a plow to scour, you may so state and state how it worked in such soil.

A. I never used it nor did I ever see it used in ground where it would not scour, it always worked well, in any and all kinds of soil as far as I ever knew.

Int. 13. What acquaintance have you with the working of other sulky plows, and state the names of other plows, with the workings of which you are acquainted, whether by using them yourself or seeing them used.

A. I never used any but the Skinner and Starling, but saw a number, names of all I could not state, but among them were the Furst & Bradley, manufactured at Chicago, Ill., one made at Moline, Ill., and I think another made at Peoria, Ill.

Int. 14. State how the working of said Starling plow compares with the working of the other sulky plows with which you are acquainted.

A. The working of the Starling sulky plow was the equal and in certain conditions of the ground it was the superior of any I ever used or knew, had I not owned the Skinner plow, would have bought a Starling in preference to any other.

Int. 15. State whether there is any respect in which said Starling plow did not work satisfactorily?

A. It always worked well and satisfactory as far as I ever knew.

Int. 16. State whether you ever knew of a sulky plow before the Starling plow was introduced and before August 18, 1874, having the axle, the crank-bar or

bail (which attaches the plow to the axle at either side), and the lever for raising the plow out of the ground and locking it in the ground, all these parts combined, formed and operating like, or substantially like those in said Starling plow, and if so state when and where?

A. I never did.

Int. 17. If any advantages in the working of a sulky plow are produced by the conbination of plow, crank-bar (or bail) axle, and lever meutioned in the last question (interrogatory 16) in said Starling plow, state what they are.

A. In the working of a sulky plow the advantages are all in favor of the crank-bar (or bail) for the reason that it would do good work where others failed, because the lever and crank-bar, firmly locked the plow in the ground and could not raise out, without litting the plow carriage and operator altogether, whereas the others that were in use before the Starling was invented, being hung on a pivot beam would easily tilt up and throw the plow out of the ground.

When it came in contact with an extra amount of rubbish or hard ground, and another reason is it has been adopted and now used by the manufacturers of all other sulky plows that I know of.

Int. 18. State how the amount of draft in using said Starling plow compares with that of other plows of equal size.

A. I never saw the draft tested by an instrument but have seen two horses operate the Starling sulky with apparently the same ease as three horses would, the same size of other Sulky plows.

Int. 19. Mention any good qualities that you have not named which your experience with the said Starling Plow has taught you it possesses.

A. The Starling Sulky being operated by a crank-bar (or bail) attached to the axle and raised and

lowered by a lever attached to the bail, raised the forward end of the beam where the whiffletrees are fastened as well as the end to which the plow is attached at the same time, thereby raising whiffletrees so as not to interfere with travel of the team.

The other makes of plows in use before Starling invented his hung on a pivot, the forward end of beam had to be lowered when not working so that the whiffletrees would be nearly on the ground, and would hit the horses heels, which was dangerous as the horses were liable to kick when so hit, and also by the use of the jointed foot lever attached to the forward end of the Starling plow beam the plow could be made to enter the ground much sooner than those that do not have that device.

Int. 20. State, if you know, the extent to which said Starling sulky plow has been used among the farmers in the community where you have resided.

A. It met with as ready sale and was as generally used as any and I should say more of them were in use in the community where I lived than any one other make.

Int. 21. State, if you know, what the reputation of said Starling plow is or was at the time of your acquaintance thereof, among the farmers in such communities where it was used for plowing.

A. The reputation of the Starling plow was far better than any of the plows that did not have his invention, viz: the crank bar (or bail) to operate it with, and was as good or better than any of those that had adopted the use of the bail. It had the reputation of being a lighter running plow than any other and much easier on the team and the operator.

CROSS-EXAMINATION.

X. Int. 1. If you answer in the affirmative the 5th interrogatory—then state the names of all the other

Letters patent number 143,147 dated September 23, 1873, to J. D. Harrison.

If you ever did, state when and where in each case.

A. I never saw any of them nor any copies.

X. Int. 7. State the names of each of the sulky plows with which you compare the Starling plow in answer to interrogatory 18, and then state how the draft of the Starling plow compares with each of them one by one.

A. The Skinner, Furst & Bradley, Wier and Deere, never saw any test with Dynamometer, only judge from the working of the team, the horses seem to handle the "Starling" much easier than any of the others of the same size.

X. Int. 8. State any qualities which any sulky plow you ever used or saw used has, which are in any respect superior to those of the Starling blow.

A. I could not state any.

X. Int. 9. State the names and place of residence of all the farmers whom you know have used the Starling plow and the times when each of them used it and the places where.

A. I can only remember the following: E. C. Root, Halleck, Ill., E. Stowell of Halleck, Ill., Calvin Stowell, Charles Stowell of Lawn Ridge, Ill., John Robinson of Cromwell, Ia., John King of La Prairie, Ill., Richard Davidson of LaPrairie Center, Ill., R. McCullough, Chillicothe, Ill., and Ed. Leigh of Sparland, Ill. The time was about 1875 and 1876 on their respective farms.

X. Int. 10. If in answer to interrogatory 21 you state the reputation of said Starling plow state the names and places of residence of every person who told you anything about the reputation of said plow and the times when they so told you and state all they said.

A. Cannot give names or repeat any conversation had in regard to the plow, don't remember.

(Signed) HENRY ROBINSON.

Subscribed and sworn to before me this 8th day of October, 1886.

[Notarial Seal.] N. P. NELSON,
Notary Public.

EXHIBIT "A."

[Return.]

UNITED STATES OF AMERICA. } ss.
DISTRICT OF MINNESOTA.

I, Oscar B. Hillis, clerk of the circuit court for the district of Minnesota, do hereby certify that the fore-

going is a copy of a deposition of Henry Robinson on file in the case therein named, that said deposition was read in evidence upon the trial of said cause, together with eight other depositions of witnesses taken in said cause upon the same interrogatories; which depositions are each on file in said cause and were also read in evidence at said trial; that I have carefully compared the foregoing copy with the original thereof, which is in my custody as such clerk and that such copy is a correct copy of such original and of the whole thereof in the case therein named.

Witness my hand as clerk and the seal of said court, done at my office in St. Paul, Minnesota, this 30th day of March, A. D. 1891.

OSCAR B. HILLIS,

[Court seal.] Clerk.

(Copy of deposition certified as above returned and filed in this court.)

SUPREME COURT

of the United States.

OCTOBER TERM, 1890.

No. 328.

ST. PAUL PLOW WORKS,

Plaintiff in Error,

vs.

WILLIAM STARLING,

Defendant in Error.

SUPPLEMENTAL BRIEF FOR DEFENDANT IN ERROR.

CHARLES S. CAIRNS,

Attorney for Defendant in Error.

Press of Judd & Detweiler, Washington, D. C.

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FILED
APR 20 1891
JAMES H. McKENNEY,
CLERK.

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SUPPLEMENT TO BRIEF FOR DEFENDANT IN ERROR.

Construction of the Claim.

(SUBJECT TO OBJECTION STATED BELOW.)

A. It is contended now, as in the motion for a new trial, that the court construed the Starling first claim wrongly. In our view of this case that question would be material only on the point of what plows fell within the license contract, or, in other words, infringed Starling's patent. It is objected that the court below did not properly construe this claim as to the element lever L. That he construed it to be *the kind of lever shown and described in the specification*, namely, a locking lever, a spring lever, instead of a lever *in the abstract*, existing only in

the mind of counsel. It is insisted that the court should shut its eyes to the specifications in construing claims, and give to the terms employed in the latter such meaning only as occurs to it when staring at vacant space.

We submit that when Starling in the specification calls the lever a "spring lever" (page 147), describes it as locking, that the *spring* feature is in order that it may spring laterally into notches to "*hold it in any position into which it may be adjusted;* "that this was sufficient to apprise the court and the world that he meant that kind of lever in his claim. He was not required to say in his claim the "*locking* lever L," or the "*spring* lever L," any more than to say the "*articulating* crank bar K." Omitting such word with reference to the crank bar is not pretended to cut out of it the feature by which it articulates upon journals at its forward ends. It is no more an essential feature of a literal crank bar that it shall itself articulate, than that a lever shall be a spring lever and lock. Indeed, the common office of a crank or crank bar is to turn something else to which it is rigidly attached without articulation itself. But when one is shown and described which does articulate, that is the kind which the law finds, and most reasonably is carried forward into the claim.

Nor would Starling be bound, in his claim, to expressly mention the notches into which his spring lever enters in order to insist that the lever of his claim is one pos sessing the spring or locking feature, any more than he is required to specifically claim the "bolt or pin attached to plate F," mentioned in the specification (see top page 147), without which the crank bar could not articulate or operate, in order that he may be privileged to say that his crank bar is an articulating crank bar. As the pin in the one case, so the notches in the other are incidental to the parts operating upon and within them in the living machine. They are fairly intended, when those parts of

which they are incidental are incorporated in the claim. Any other doctrine would lead to ridiculous results. Given such a crank bar as is described, or such a spring-locking lever as is described by Starling, it would at once occur to the mind of a mechanic that some means for holding the forward ends of the crank bar and permitting it to articulate thereon, and some means for locking the spring lever, was intended and required. Otherwise the plow would be inoperative, at least so far as the purposes and mode of operation set forth in the specification is concerned. (See testimony of expert, Gunckel, page 43, where it is evident that this is his meaning instead of as construed by Mr. Bond, page 44 brief, considering the question Mr. Gunckel was answering, the context, and how a witness is cut off in a rapid cross-examination before his meaning has sometimes been made entirely clear. Mr. Bond does not print the question in his brief.)

The construction of claims should be reasonable and liberal, with the view of covering the actual invention.

Winans v. *Denmead*, 15 How., 340.
Tondeur v. *Chambers*, 37 Fed., 333.

Citing *Turrill* v. *R. R. Co.*, 1 Wall., 491; *Klein* v. *Russell*, 19 Wall., 433.

Russell v. *Mallory*, 10 Blatch., 146.
Pitts v. *Edmunds*, 1 Bissell, 175.
Morris v. *Barrett*, 1 Bond, 256.
Ames v. *Howard*, 1 Sumner, 482.
Davoll v. *Brown*, 1 W. & M., 53.
Roller Mill Co. v. *Coombs*, 39 Fed., 25.

Above cases, we believe, fully illustrate the law on this point.

B. If the unreasonable construction contended for by counsel be allowed to stand, it would not avoid infringement. The Berthiaume and Harris plows fall under it,

whether we take the locking into account or not. The only difference, as the court says, "is only such mechanical change as increases the power of the lever from a single to a compound action, reversing its movement from a lever moving forward to one pulled toward the driver," page 141.

Woodward, expert for the plow works, admits the changes made from Starling to Berthiaume plows are mechanical.

The court asks—

"Q. You speak of that compound action in order to "make a pull instead of a push lever. That is nothing "more than a mere mechanical change that a mechanic "who was skillful, when he saw the operation of it, could "change without invention?

"A. I think that is so; yes, sir.

"Q. That is as to this first claim?

"A. Yes, sir."

(Marginal, p. 104.)

C. But there is nothing to raise in this court the question of construction of the claim. There is no ruling of the court on which an assignment of error is or could be made to apply, to raise it. If the case had been tried by a jury, it could arise on a charge or refusal to charge the jury as requested. Counsel should have asked the court to rule upon it in the progress of the trial, and noted an exception, which is not done.

The 12th assignment in the record can't raise it. The court never found, and could not find, in this case that Starling anticipated the Berthiaume patent. Moreover, Mr. Bond assumes that the so-called "Star" or "Berthiaume" plows are Berthiaume *patent* plows. Mr. Bond, not having been present at the trial below, probably accounts for the error. Starling's first claim would, in fact, anticipate the same claim in the later patent of Berthiaume, but the latter makes no such claim, although it contains those elements.

The 19th assignment can't raise it, because the court had the right to receive and consider the testimony with reference to the Harris plow on any construction of the claim. Both counsel for the plow works concede, and the court says, the Harris is substantially the same as the Berthiaume (page 141). We have seen that it is admitted that the changes from the Starling to the Berthiaume were only mechanical, and that it infringes the former on either construction contended for.

(Marginal, p. 104.)

Nor can it be raised on the assignments of errors 7 to 12, that the court found the several prior patents do not anticipate the Starling patent. This finding includes mixed questions of law and fact, and is conclusive as to both. On these assignments it is not necessary to add more than we have already said.

(Brief, pp. 5, 6, 7.)

And, in any event, it would be immaterial as to the construction of Starling's first claim on the question of anticipation, if anticipation is no defense, or the plow works is estopped to deny the validity of the patent.

(Brief, p. 10, etc.)

D. Mr. Bond assumes that a change of position was made by the plaintiff below as to the construction for this claim, outlined in the evidence, on opening case from that in the rebuttal. He assumes that counsel and experts for Starling had not examined the patents thrust under their noses months in advance by the answer; that they were caught and had to make a sudden change of base in rebuttal. Mr. Bond is too good a lawyer to be caught in such manner himself.

The claim is not true in any particular, and an examination of the evidence will show it. Let it be read in order as it came to the ear of the court below, and not by

any forced conjunction of parts not belonging together. Let it be read, too, in the light of the fact that the opening case of plaintiff below is taken up with testimony as to the so-called Berthiaume and Harris plows, and not the alleged anticipating patents. That testimony, given in open court, filled in with operation of plows as a part of the answer, is not designed to be so well understood by an appellate court as by the lower.

The matter of Starling's lever being a locking lever was distinctly brought out on opening case.

(Marginal, pp. 70, 81, 84, 90.)

But the record does not contain all the evidence on the question of infringement—not all of Starling's opening case.

(See Certificate, p. 145.)

Mr. Bond was not present at the trial, which accounts for his error in trying to spell out a difference with only half the letters to work with.

Anticipation again.

We have said, and still contend, that this court can not go into the question of anticipation, and what we append on that point is not to be understood as receding from the position, but subject to the objection, because we believe such is the law, and not because we fear the outcome on a full understanding of these patents, such as the court below was able to acquire.

(Brief, p. 7, etc.)

Mr. Bond takes up the several patents alleged to anticipate in detail. If this court holds that this is in substance a chancery appeal, then we submit that none of these patents anticipate, for the following among other reasons:

Hay & Freeman patent.

Patent, p. 148.
Testimony of plaintiff below.
Gunckel, pp. 101 to 103.
Starling, p. 127.

Mr. Bond says there are *only* two ways of getting plows out of the ground. One is to tip the plow sidewise so as to slide out on the share, as is common with walking plows, but impracticable with wheel plows. The second is to tip up the point so the horses may raise it out as they move forward, as in Starling's claim, p. 147. We submit a *third*, which is the only possible method of getting the Hay & Freeman out, viz., to lift it bodily. This is true, because the draft is on the tongue H, which is and must be attached rigidly to the frame F carrying the plows, so that the parts rise in a horizontal plain, as clearly shown by dotted lines in Fig. 1. There is no point of articulation between the rear end of the plows and the end of the tongue at the neck yoke of the horses. It really rises in an arc of a large circle, of which the ring at the neck yoke or front end of the tongue is the center, and the heel of the plow is on the circumference. This would make the *heel* rise a very little faster. By some clerical error, which was overlooked, the word "points" occurs in a question to Mr. Gunckel, page 102, where the word "*heel*" should be. That this is so, see the context. Mr. Bond, who was not at the trial below, alone notes this apparent inconsistency.

(Brief, p. 45.)

This plow has not a lever performing the functions of Starling's. There is no method of locking it in the ground. Mr. Sanborn makes the novel suggestion that it is locked by the weight of the plow and its beam. On the same principle any walking plow is "locked"—an obvious fallacy.

Worrell & Rynerson Patents (Patent, p. 160).

Gunckel testimony, pp. 103 to 108.
Starling testimony, pp. 127 to 130.

Here again the draft is on the tongue. Mr. Bond alone insists otherwise. On motion for new trial below, Mr. Sanborn so admitted in his brief. He claimed the point of the plow might rise because it would not be weighted by any whiffletrees. He said, quoting from his brief, "the forward end of the plow beam (Worrell & Rynerson) being light and *having no heavy whiffletrees or tackle upon it*, must, with the point of the plow, tilt upward in the same way Starling's is claimed to do, only more quickly and decidedly, because it is not held down by *any weight whatever on the end of the beam.*"

Mr. Bond contends (p. 17, brief) that the court below was in error in finding that the draft here is on the "*draft pole*" G, because the patent refers to prior ones procured by Worrell & Rynerson not contained in the record, and asks the court to look at these as essential to an understanding of the present specification. It does not refer to these former ones as explanatory of, or a part of mechanism now patented, but merely says this patent "*is intended to be an improvement upon* our patents of July 26, 1870, and March 28, 1871" (p. 161). Under such reference we know no rule of law that would import those specifications into the present one. Such reference calls attention to *improvements, to differences* between the present and former patented mechanisms, and not to similarities. It is fair to assume that, granting those former were plow-beam hitches, the change of hitch to a "draft-beam," which should also perform the office of a pole or tongue, is a part of the "improvements."

But if we further consider this as a chancery appeal, and an extraordinary one, by taking up matters in and out of the record, and take up all the patents of this man

Worrell, the correctness of the court below becomes incontrovertable. We find that in patents 105,849, July 26, 1870, and 113,234 and 113,235, March 28, 1871, to Worrell & Rynerson, where the draft is through the plow beam, *the part performing the office of a tongue is never called a "draft-beam," but simply "pole" and "tongue,"* while in the patent to the same man, John Worrell, of Clayton, Ind., issued after the three just mentioned, and a part of this record (p. 157), where the draft is clearly from the tongue, *that part is uniformly called the "draft pole," as in the patent under consideration it is called the "draft-beam."* In the patent, page 157, it is perfectly evident from inspection of the drawing that the draft is not and could not be from the plow beam. Worrell and Worrell & Rynerson made a change or supposed improvement to their plows as to the place of hitching, and, consistent with that change, thereafter uniformly applied the significant term "*draft*" to the pole or beam through which the draft of the team operates. If this is to be explained away, then terms mean nothing or anything. It is too uniform and consistent to be explained on the ground of mistake. Nor is it true that "*draft beam*" or "*draft pole*" is ever used where the *draft* does not operate upon and through that part. We challenge counsel for an instance.

The distinction drawn by Mr. Bond (brief, pp. 16 and 17) between a sulky plow and a sulky attachment for plows is not warranted by facts or custom. A sulky to which a walking plow is attached is as truly a sulky plow as if the plow had never been used out of a sulky. To many plows that are called sulky plows by common consent, a walking plow could be used for the corresponding part of the sulky plow. When put in, the clevis or hitch at the front end of the plow beam could be omitted and the draft applied through a draft pole or draft beam, which was also a tongue, as well as if the plow had not, as an incident to its life's history, done service with a

plowman plodding his "weary way" behind. The distinction sought to be drawn is too refined and technical. It is far fetched.

The court also understood the Worrell & Rynerson patent correctly as to the impossibility of tipping up the point of the plow by the foot lever so as to enable the horses to pull it out of the ground. The other Worrell and Worrell & Rynerson patents are equally incapable of this mode of operation, partly on account of the front plow beam lever. In 105,849 they say the lever H, corresponding to H^1 here, may be used to "aid in removing the plow from its furrow by pressing the front end of the beam downward," so that the heel may be turned back and up more readily by the foot lever. That is equally the only way H^1 here can be used for the purpose *while the plow is in motion*, when we consider how greatly the draft on the draft-pole G will cause a downward pulling on the part I when the plow is at work.

(Marginal, p. 218.)

This plow does not possess *any* combination to operate in the manner of Starling's first claim, nor the character of lever, nor any having the mode of operation of Starling's lever. Moreover, it is the law that nothing can anticipate by the fact that it might perform the function of a later patented device in some degree if such mode of operation is accidental or contrary to the law of the earlier mechanism.

Clough v. *Barker*, 106 U. S., 175.

First Owen's Patent (Patent, p. 150).

Gunckel testimony, pp. 108 to 110.
Starling, marginal, pp. 264 to 268.

This plow has no locking lever. The lever and ratchet can be used simply to raise the plow up, but not to lock

it in any desired depth in the ground, either as against upward or downward movement; that is, its hand lever is not the kind nor has it the mode of operation of Starling's.

As to the operation of the bar D^1 and stop d^1 at the front end of the plow beam, we are left in no doubt by the specification. Owen says: "*After the plow is fairly in the ground he removes his feet from the bar and allows it to rise until stop* d^1 *strikes the under side of the tongue.*"

Specification, p. 152.

Opinion of Court, p. 143.

It is of no consequence that the cut shows stop d^1 below the tongue, as the figure does not show the plow in the furrow at work, but upon the surface at rest with the plow beam at front end somewhat depressed. *When in operation* the inventor specifies its law to be that stop d^1 rests against "the under side of the tongue." This will effectually prevent any tipping up of the point by operating the lever, if the point of adjustment of the plow to the crank bar would admit it, which it does not. Clearly, then, any tipping up of the point would be accidental merely, *if it were possible*, and contrary to the law of the machine; and the case of Clough *v.* Barker, 106 U. S., 175, cited above, would apply.

The suggestion by Mr. Bond, page 22, that the swivel arrangement by which the bail is attached to the crank bar in Owen's first patent is the same as that of Berthiaume's patent, and that the latter, without knowing it, simply went back to the Owen patent, and if it does not anticipate Starling the 1,310 plows do not infringe Starling—is a most singular position. *None of the 1,310 plows have the swivel arrangement of Owen or Berthiaume. Every one of the 1,310 plows have the locking lever of Starling and the parts of his first claim so combined as to enable the horses to draw the plow out of the ground by tipping up the point,*

while the Owen's plow does not have a locking lever nor parts for tipping up the point of the plow so as to enable the horses to pull it out. Do these facts make no difference in the position of counsel?

Second Owens' Patent (Specification, p. 153).

Gunckel testimony, marginal pp. 223 to 226.
Starling testimony, marginal pp. 268 to 276.

This plow, on every question that might relate to anticipation, is confessedly the same as the first Owens' patent. It might be added, only, that the lever and ratchet arrangement described has the additional feature of permitting the plow to be locked so far as further *downward* motion is concerned, but can not be locked to prevent *upward* motion. That is, the weight of the axle wheels and driver can not be brought into play to insure the plow remaining in the ground and running steady, as to flying up. This feature, always important, is imperative where very hard ground is to be plowed or ground on which there is much trash, such as weeds or cornstalks. The rolling coulter, moreover, used on such plows, tends to lift the plow up in cutting thick weeds or heavy stocks. Owens' plow would not do efficient work in hard baked ground.

See our brief, page 40 (if we may be permitted), as to Mr. Henry Robinson's experience.

That we have stated the operation of second Owens' ratchet and lever correctly, see opinion of court, pages 17 and 18 (instead of page 144, which seems to be erroneously printed). The court is brief as to description, but evidently means only, for he says only, "the lever used will lock the plow so as to prevent it from *going deeper.*" (See top page 18). A study of the ratchet arrangement, as well as the language of the specification on marginal page 309 of the specification, will demonstrate that it can operate only as above set forth, and is so intended.

J. Worrell Patent (Patent, p. 157).

Gunckel testimony, marginal p. 227.
Starling testimony, marginal pp. 276, 277.

As we have seen above, the draft is upon the draft pole and tongue F^1, as in the other patent issued to this Worrell and one Rynerson. The specification calls F^1 the "draft pole" (p. 157), and the plow beam shown is not shown with any means to attach horses. It is not such a plow beam as is ever used for the application of the draft to it. Its vertical thickness is very slight, and this would render it unfit to receive at its front end the strain of the horses in pulling the plow through the furrow.

What we have said above as to the Worrell and Rynerson patent will equally apply here and need not be repeated. Whether the plow in fact has a front lever or not, is immaterial, as it would be no nearer approach to Starling than the Worrell and Ryverson then. It can't be locked through the bail by a locking lever, nor the point tilted up so as to assist the horses to pull it out of the ground.

It may be added here that it is proper to call a "draft-pole" or "draft-beam" a "tongue," because, in addition to receiving the draft strains it also performs the office of a tongue. But a tongue which does not receive the draft is never called a "draft-pole" or "draft-beam," for the obvious reason that it *does not perform the office of the latter.*

Harrison Patent (Patent, p. 158.)

Gunckel testimony marginal, pp. 228, 229.
Starling testimony marginal, pp. 277, 280.

This is a horse or wheel-lift plow, what Mr. Bond calls a lever, l, is called an "arm, l," in the patent, and

its office is simply and only to engage a pawl into action with a ratchet at the hub of the wheel. The specification says—

"By means of arm, l, the driver may throw the pawl. k, into action with the ratchet at his option, when the forward rotation of the wheel, A, will cause the elevation of the plow" (p. 159).

Such a lever has not the purpose, relation to parts, or mode of operation possessed by Starling's lifting and locking lever. That element of Starling's claim must be regarded as absent, and hence Harrison's patent can't anticipate.

What Mr. Bond suggests as to the front end of the beam rising through the action of the pawl and ratchet in lifting the plow from the ground, springs from his zeal for his cause and not from the Harrison patent. If immaterial when produced by different action of different parts it is none the less impossible.

Figure 2 of the patent represents the plow down in the furrow in operation, *with the front end of the plow beam up against the front cross bar c of the frame. This, of itself, would prevent the action suggested. Harrison suggests no such action.* The rolling of the plow upwards by the action of the wheel raises the *heel* of the plow first and fastest.

From the fact that there is no clevis shown on the plow beam it would seem that the forward end of the beam is attached to the cross bar c, as stated by expert Gunckel, page 113. Such an attachment seems to be indicated by small dotted lines in Fig. 2. The court below says this patent has "no hand or foot lever arrangement for raising the plough out of the ground." There is nothing to fix the depth of the furrow or lock the plow there.

All the patents.

Gunckel marginal, pp. 229 to 231.
Starling marginal, p. 280.

The court says—

"*Neither of these patents have the combination of the plaintiff for the purposes described in his patent, and do not anticipate the invention*" (p. 144).

Haslup Patent.

Counsel concede this is not properly in the case. We have already objected to it, and do not waive the objection herein.

Nevertheless, the court below has properly understood the patent. It was presented to him on lengthy affidavits, not in the record, by experts pro and con.

The position of the plow in the dotted lines gives no warrant for saying the point can tip up. The view is a "perspective" one, as stated in the specification, and the dotted lines show *the plow in an impossible position, viz., the beam above the axle H.* The view being perspective, when the figure is cast upon a plain surface, it helps to give the effect of an unnatural position.

The specifications say distinctly, not that the point of the plow turns up, as shown in dotted lines, nor that the beam is above the axle, but that "the front end of the "plow-beam is *held* by the brace R, as shown *in dotted "lines.*" The dotted lines show it *above the horizontal hook of brace R,* so as to hold it securely against rising or falling. This would render it impossible to tip the point. A correct side or rear view instead of the perspective should show the beam horizontal when so "*held*" by brace R. Any mechanic would so understand it. The word "*held*" is significant, not of a mere stop, but of a device catching and *holding "as shown in dotted lines.*"

So that under the *language of the specification*, it can not be objected that the position of the dotted lines with reference to R is an error of the draftsman, as in carrying the dotted lines *over* the axle instead of omitting them in crossing it, nor for the same reason can it be said that it is apparent, merely, as the tipping up of the point, produced by a perspective view. The *language* calls for the one; it does not call for the others.

If it be insisted that the point is turned up while the beam is "held" by R, then the plow would be inoperative until made over, and an inoperative mechanism could not anticipate.

Mr. Bond thinks the depth of furrow is regulated by the lever k, and that pin h operates in connection with lever k to fix the depth of the furrow, instead of in connection with lever O, as stated by the court below (p. 24).

The lever k is simply a *leveler* lever to adjust the wheel that runs in the furrow, *i. e.*, on lower ground, so that the plow will remain level and the axle horizontal. *It has nothing to do with the depth of furrow.* That must be controlled through the sleeve L, and is clearly shown to be done by inserting the pin h through holes in the circular plate P, so as to lock the sleeve. The specification says:

"*The depth to be plowed is regulated by a pin h, and pin-holes in the circular plate P.*"

For what the court below says of this plow, see opinion, pages 23, 24. We quote only his conclusion:

"The driver can not regulate the depth to be plowed "and lock the plow in the ground while it is in motion. "The pin prevents the plow being raised by the lever, "and it could not be operated while in motion, so as to "raise the point of the plow and make the horses pull it "out of the ground. *The Haslup plow does not have the "combination of the plaintiff for the purposes described in the "patent, and does not anticipate his invention.*"

He denies the motion for a new trial, because if this patent "had been offered under the ruling of the court at "the trial it could not have changed the result" (pp. 23, 24).

Experting.

Mr. Bond makes this head the occasion of criticism upon expert Gunckel, in which he clearly demonstrates how unfairly the zeal of a counsel may treat the testimony of a witness, whose testimony he did not hear, and does not now care to understand. We say this with all respect to counsel.

For instance, counsel prints, on bottom page 43, brief, a question and answer, without its context, leaving the impression that *all* of his testimony was based on the supposition that the patent of Starling was a foundation patent. The court and none at the trial so understood it. The point in hand, then, was *Starling's second claim only*, and what Gunckel had said about *it*. The foundation suggestion went no further.

Read cross-examination of Gunckel (marginal, pp. 87 to 89, inclusive), and this will appear lucidly.

It is suggested that "a plow can not be drawn from a point on the beam back of the plow point," and this court would be asked to infer in consequence that certain plows have a plow-beam hitch where none is shown, instead of a tongue or draft-pole hitch. We submit that with the forward end of the plow beam steadied by any suitable attachment there, such a hitch, as above specified, is practicable and operative.

Miscellaneous.

If it is to be claimed that Starling's plow is not a good one here, as Mr. Bond suggests, without the testimony of the case below all up, then we must point to the deposition of Mr. Robinson in our brief, pp. 39 to 48.

The opinion of the court below is assailed because he suggested the locking feature of the lever in connection with tipping up the point of Starling's plow, to have the horses pull it out of the ground. A moment's consideration will show that when the point is tipped up by a forward movement of the lever, the latter may be dropped into a notch and remain locked there, while the raising of the plow out of the ground is proceeded with by the team, to the extent determined by the point at which it is locked; and when that point is reached, the plow will have returned to a horizontal position. We understand the court to mean simply this in his first opinion. His way of putting it, on motion for new trial on this point, is not assailed, and shows he did not misunderstand the operation. (See p. 24.)

This supplemental brief is respectfully submitted in answer to the brief of Mr. Bond, which was filed April 17, 1891, after the time specified under the rules of the court. We insist on the points and objections made in our main brief.

CHAS. S. CAIRNS,
Attorney for Defendant in Error.

APRIL 18, 1891.

N. B.—Our references to assignments of error follow the numbers in the record, and not of Mr. Sanborn's brief.

Also, wherever we have used the words "Berthiaume plow," we mean the plow of the 960 found by the court to have been made by the plow works, *i. e.*, the "Star," and not the Berthiaume patent plow, unless the latter is clearly specified. The same is to be understood of the testimony of the witnesses in the record.

C. S. C.